SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1963

No. 106

COMPCO CORPORATION, PETITIONER,

vs.

DAY-BRITE LIGHTING, INC.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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[fol. A] [File endorsement omitted]

IN THE

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Appeal Nos. 13,699 and 13,700

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

Honorable Julius Miner, Judge Presiding.

DAY-BRITE LIGHTING, INC., Plaintiff-Appellant,

vs.

COMPCO CORPORATION, Defendant-Appellee.

Plaintiff's Appendix—Filed July 9, 1962

[fol. 1]

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION
Civil Action No. 58 C 1300

DAY-BRITE LIGHTING, INC., Plaintiff,

v.

COMPCO CORPORATION, Defendant.

STATEMENT REQUIRED UNDER RULE 12(c) OF THE RULES OF THE UNITED STATES COURT OF APPEALS

1. This suit was commenced on July 14, 1958.

2. The plaintiff is Day-Brite Lighting, Inc., a Missouri corporation. The defendant is Compco Corporation, an Illinois corporation.

3. The following pleadings have been filed in this action:

(a) Complaint filed on July 14, 1958.

(b) Answer and Counterclaim filed September 29, 1958.

(c) Answer to defendant's counterclaim filed November 4, 1958.

4. There were no arrests made, bail taken, or property attached.

5. Trial was had in this cause from October 3, 1960 through October 5, 1960, and was heard by the Honorable Julius H. Miner.

6. On February 6, 1962, the Honorable Julius H. Miner entered judgment holding Design Patent No. 176,367 invalid and dismissing the Complaint insofar as the charge of patent infringement was concerned; the Court found [fol. 2] that the defendant was guilty of unfair competition, entered an injunction enjoining defendant from such unfair

competition and continued generally the accounting ordered therefor.

7. On February 9, 1962, the Honorable Julius H. Miner amended the judgment of February 6, 1962 in paragraph 13 thereof and ordered the said February 6, 1962 judgment be entered as the Court's judgment as of February 9, 1962.

8. Notice of appeal of defendant, Compco Corporation, was filed March 1, 1962.

9. Notice of appeal of plaintiff, Day-Brite Lighting, Inc., filed March 7, 1962.

Respectfully submitted,

Ooms, Welsh and Bradway, By Edward M. Keating, One North LaSalle Street, Chicago 2, Illinois, Attorneys for Plaintiff.

Of Counsel, Gravely, Lieder & Woodruff, 705 Olive Street, St. Louis 1, Missouri.

[fol. 3]

IN THE UNITED STATES DISTRICT COURT

PLACITA

Pleas had at a regular term of the United States District Court for the Eastern Division of the Northern District of Illinois begun and held in the United States Court Rooms in the City of Chicago in the Division and District aforesaid on the first Monday of February, being the 5th day thereof, in the Year of Our Lord One Thousand Nine Hundred Sixty Two and of the Independence of the United States of America, the 186th Year.

Present: Honorable William J. Campbell, Chief District Judge, Honorable Michael L. Igoe, District Judge, Honorable J. Sam Perry, District Judge, Honorable Julius J. Hoffman, District Judge, Honorable Julius H. Miner, District Judge, Honorable Edwin A. Robson, District Judge, Honorable Richard B. Austin, District Judge, Honorable James B. Parson, District Judge, Honorable Hubert L. Will, District Judge, Honorable Walter J. La Buy, District Judge Retired.

Also Present: Honorable Albert B. Maris, Senior United States Circuit Judge for the Third Circuit sitting pursuant to designation.

Roy H. Johnson, Clerk.

Joseph N. Tierney, Marshal.

Tuesday, February 6, 1962.

Court met pursuant to adjournment.

Present: Honorable Julius H. Miner, Trial Judge.

[fol. 4]

IN THE UNITED STATES DISTRICT COURT

Civil Action No. 58 C 1300

Equitable Relief Sought

COMPLAINT—Filed July 14, 1958

For its complaint against Defendant, Plaintiff alleges:

COUNT I

1. Plaintiff, Day-Brite Lighting, Inc., is a corporation organized and existing under the laws of the State of Missouri, with its principal office at 5411 Bulwer Avenue, in the City of St. Louis.

2. Upon information and belief, Defendant, Compco Corporation, is a corporation organized and existing under the laws of the State of Illinois, with its principal office at 2247-63 West St. Paul Street, in the City of Chicago.

3. This Court has jurisdiction of this cause of action because the same arises under the patent laws of the United States, namely: 35 U.S.C. 281 and 289, and 28 U.S.C. 1338(a) and 1400(b).

4. Prior to January 17, 1955, Carl X. Meyer and Leo G. Stahlhut did invent a new and ornamental design for a Reflector for Tubular Lamp Lighting Fixtures and, being under the law entitled to a design patent for their invention, did on January 17, 1955 make application therefor, and pursuant to said application, United States Patent No. Des. 176,367 was on December 13, 1955 duly, lawfully and

regularly issued for a term of fourteen (14) years from the date of issue.

5. Carl X. Meyer and Leo G. Stahlhut on December 30, 1954 did assign to Plaintiff the whole right, title and inter-
[fol. 5] est in and to said invention and said application to be filed therefor and any and all Letters Patent to be issued thereon by an instrument of assignment subsequently recorded in the United States Patent Office on January 17, 1955 on Reel 006, Frames 131 and 132, and Plaintiff has retained the entire right, title and interest continuously thereafter, and still owns the same; a copy of said Patent No. Des. 176,367 is annexed hereto as Exhibit 1.

6. Mitchell Lighting Company, prior to the period when it was purchased by Defendant, and on or about June 195[illegible] without leave from Plaintiff and without authority in law, advertised, exposed and offered for sale a "Dynalite" reflector for industrial lighting fixtures having the design covered by said design patent No. 176,367, said infringing reflector being shown in Bulletin No. 798, a photostatic copy of the pages of said bulletin being attached hereto as Exhibit 2.

7. Plaintiff on or about December 21, 1955 gave Mitchell written notice of the issue of said design patent No. 176,367, Plaintiff's ownership thereof, and the infringement thereof by Mitchell's acts.

8. Plaintiff on or about March 30, 1956 and after the purchase by Defendant of Mitchell Lighting Company, gave Defendant, Compco Corporation, written notice of the issue of said design patent No. 176,367, Plaintiff's ownership thereof, and the infringement thereof by Defendant Compco in continuing to sell said "Dynalite" reflector.

9. Plaintiff's patent No. Des. 176,367 was on December 23, 1957 made the subject of a suit for infringement against another defendant within the jurisdiction of the United States District Court, Eastern District of Pennsylvania, Docket No. 23808 (Civil Action), due notice to the public being given in the Official Gazette of the United States
[fol. 6] Patent Office, Volume 727, No. 1 of February 4, 1958 (page 5), and said suit terminated on May 27, 1958 by a Consent Judgment, and an injunction was issued thereon perpetually enjoining the defendant from using or apply-

ing the design of said patent, and from advertising, exposing for sale, and selling any article of manufacture to which such design or colorable imitation has been applied.

10. Defendant, Compco, in complete disregard of said notice of infringement from Plaintiff, and in knowing, wanton, and deliberate disregard of the rights of Plaintiff, subsequently proceeded with the manufacture and sale of said industrial reflector and has been and still is manufacturing and selling said reflectors embodying said patented design, and has been and still is exposing for sale, and selling said reflectors in and about the City of Chicago, and elsewhere as is evident from the Defendant's advertisement appearing in the Electrical Construction and Maintenance publication, page 171 of the January 1958 issue, a copy of said page being annexed hereto as Exhibit 3.

COUNT II

11. Plaintiff, Day-Brite Lighting, Inc., is a corporation organized and existing under the laws of the State of Missouri, with its principal office at 5411 Bulwer Avenue, in the City of St. Louis.

12. Upon information and belief, Defendant, Compco Corporation, is a corporation organized and existing under the laws of the State of Illinois, with its principal office at 2247-63 St. Paul Street, in the City of Chicago.

13. This Court has jurisdiction of the cause of action because the same arises under the laws of the United States relating to unfair competition, namely: 28 U.S.C. 1338(b).

[fol. 7] 14. For more than three (3) years last past Plaintiff (or since on or about October 1954) has been the exclusive distributor throughout the United States of reflectors which were distinctive when first placed upon the market.

15. The Plaintiff's distinctive reflector design has been widely advertised repeatedly in trade publications, bulletins and magazines throughout the United States and has become and is widely and favorably known to the public, to architects, engineers and contractors, and particularly

to the trade as the exclusive design of Plaintiff: copies of Plaintiff's bulletin announcing the new Lifetime CFI-10 reflector, the Day-Briter for October 1954, and the Day-Briter for February 1955 are annexed hereto as Exhibits 4, 5 and 6 respectively.

16. By virtue of the widespread and substantial advertising of its distinctive reflector, and by reason of extensive sales thereof, Plaintiff's distinctive reflector is associated in the public mind and among customers and prospective customers, and architects, engineers, contractors and utilities men with Plaintiff and is well known as the Day-Brite C.F.I. reflector.

17. During the year 1955, Mitchell began to manufacture and sell and offer for sale in this jurisdiction and elsewhere lighting fixture reflectors which were copies of the Plaintiff's distinctive design.

18. Since March or April 1956, Defendant, Compco and its acquired company, Mitchell, have manufactured and sold and have offered for sale in this jurisdiction and elsewhere lighting fixture reflectors which are copies of Plaintiff's distinctive design; photographs of Defendant's reflector alongside Plaintiff's reflector are annexed hereto as Exhibits 7 and 8.

19. Defendant's conduct in knowingly copying Plaintiff's distinctive reflector was and is now calculated and [fol. 8] is likely to cause confusion and deception of the purchasers, and to pass off as a product of the Plaintiff the reflectors offered by Defendant and to unfairly compete and to divert to Defendant the benefits of Plaintiff's energy, skill, good reputation and good will.

20. Defendant has failed to discontinue the manufacture and sale of reflectors embodying the Plaintiff's distinctive design, and has continued to manufacture and expose and offer for sale reflectors which embody the distinctive appearance of Plaintiff's reflector.

21. Defendant's acts of continuing to manufacture and sell and offer for sale reflectors which embody Plaintiff's distinctive design appearance is in furtherance of a plan

and purpose to unfairly compete with Plaintiff, and to divert to Defendant the benefits of Plaintiff's energy, skill, good reputation and good will.

22. Defendant has refused to cease their unlawful acts and will continue the course of conduct unless restrained by this Court.

Wherefore, Plaintiff prays:

1. That Defendant, its officers, agents, employees, servants, and all others acting in privity with it, be enjoined, pendente lite and permanently thereafter, from manufacturing, selling, distributing or otherwise dealing in the making and selling of reflectors which simulate Plaintiff's distinctive design appearance, or are in colorable likeness thereof;

2. That Plaintiff's patent No. Des. 176,367 be adjudged valid and enforceable;

3. That Plaintiff's patent No. Des. 176,367 be adjudged to be infringed by the Defendant's reflectors heretofore and now being made and sold by it.

4. That Defendant be ordered to account to Plaintiff for the profits it has derived by reason of the infringement of Plaintiff's design patent, and by reason of the unlawful [fol. 9] and unfair acts pursued by it;

5. That Plaintiff be awarded the costs and expenses of this action.

6. That Plaintiff recover its attorneys fees; and

7. That this Court grant such other and further relief as may seem just and proper.

Day-Brite Lighting, Inc., By Owen J. Ooms, One North LaSalle Street, Chicago 2, Illinois; Joseph J. Gravely and Frederick M. Woodruff, 705 Olive Street, St. Louis, Missouri.

Ooms and Dominik, One North LaSalle St., Chicago, Illinois; Gravely, Lieder & Woodruff, 705 Olive Street, St. Louis, Missouri, Of Counsel.

United States Patent Office

Des. 176,367
Patented Dec. 13, 1955

176,367

REFLECTOR FOR TUBULAR LAMP LIGHTING FIXTURES

Carl X. Meyer, St. Louis County, and Lee G. Stahlhut, Kirkwood, Mo., assignors to Day-Brite Lighting, Inc., St. Louis, Mo., a corporation of Missouri

Application January 17, 1955, Serial No. 34,837

Term of patent 14 years

(Cl. D48—33)

FIG.1.

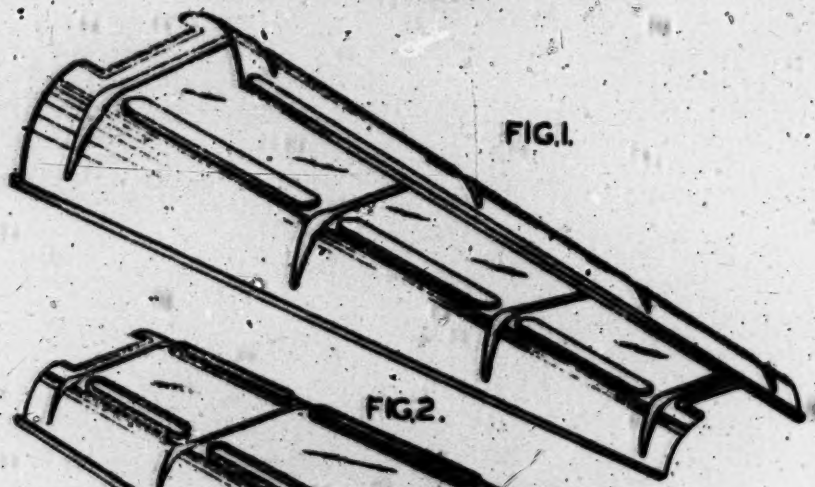


FIG.2.

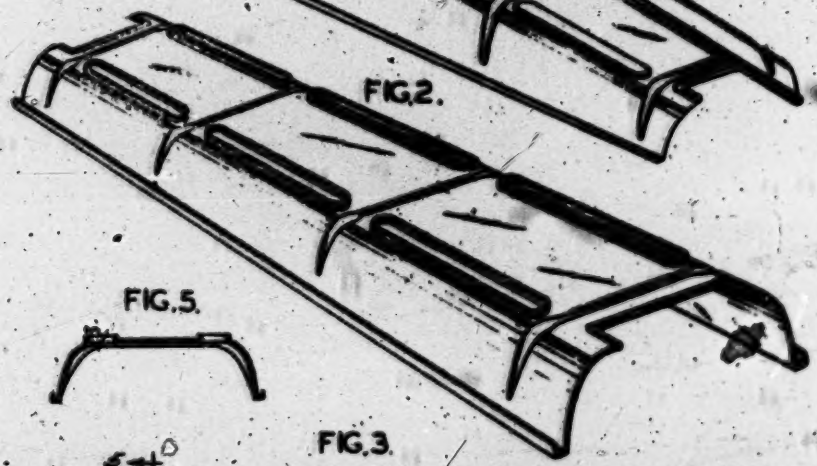


FIG.5.

FIG.3.

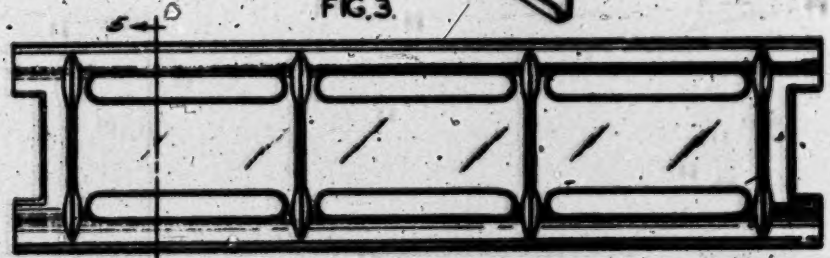
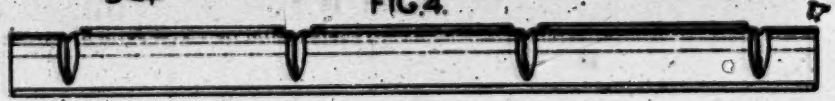


FIG.4.



[fol. 10]

PLAINTIFF'S EXHIBIT No. 1

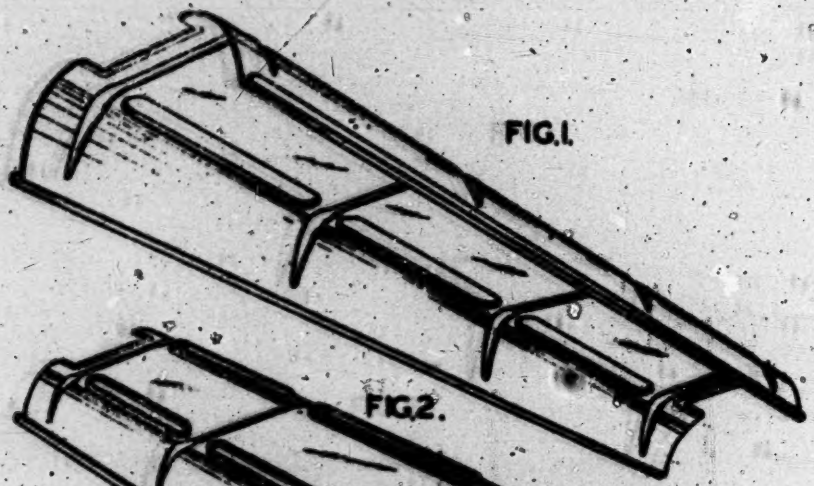


FIG. 1.

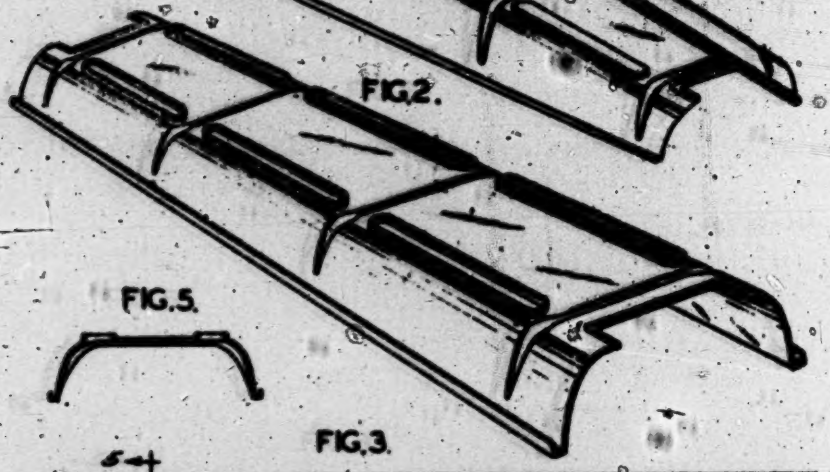


FIG. 2.

FIG. 5.

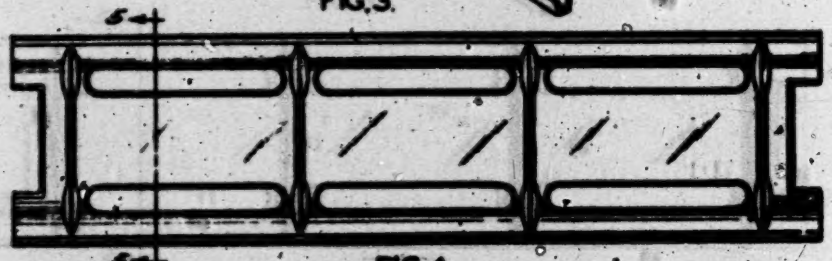


FIG. 3.

FIG. 4.

Fig. 1 is a perspective view, as seen from below, of the reflector for tubular lamp lighting fixtures, showing our new design,

Fig. 2 is a perspective view, as seen from the top, of the same,

Fig. 3 is a top plan view of the reflector shown in Fig. 1,

Fig. 4 is a side elevational view of the reflector, and

Fig. 5 is a sectional elevational view of the same as seen along line 5—5 in Fig. 3.

We claim:

The ornamental design for a reflector for tubular lamp lighting fixtures, substantially as shown.

References Cited in the file of this patent

UNITED STATES PATENTS

2,332,770 Abernathy ---------- Oct. 26, 1943

[fol. 10] PLAINTIFF'S EXHIBIT No. 1

[fol. 10] PLAINTIFF'S EXHIBIT No. 1

[fol. 11]

IN THE UNITED STATES DISTRICT COURT

Civil Action No. 58 C 1300

ANSWER—Filed September 29, 1958

Now Comes Defendant by their attorneys and in answer to the complaint filed herein says:

COUNT I

1. Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 1 Count 1, and therefore denies the same.

2. It admits the allegations of paragraph 2 of Count I excepting the street address of the principal office of defendant which correctly is 1800 North Spaulding Avenue.

3. It admits that this action arises under the Patent Laws of the United States, but denies all other averments of paragraph 3 of Count I.

4. It is without knowledge of the allegations contained in paragraph 4 of Count I and hence denies said allegations, save defendant admits having seen what purported to be a copy of Design Patent No. D-172,325 issued to Carl X. Meyer and Leo G. Stahlhut on an application purported to have been filed on January 17, 1955. Defendant specifically denies that said patent was duly, lawfully and regularly issued.

5. It is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 5 of Count I of the complaint and therefore denies the same.

[fol. 12] 6. It denies the allegations of paragraph 6 of Count I of the Complaint save defendant admits that Plaintiff's Exh. 2 comprises photostatic copies of pages of a bulletin on which the copyright owner is indicated as being Mitchell Mfg. Co. Defendants specifically deny that the lighting fixture identified as "Dynalite" as shown in Plaintiffs' said Complaint-Exhibit 2 infringes Design Patent No. 176,367.

7. Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 7 of Count I of the Complaint, save defendant admits having seen a letter from plaintiff to Mitchell dated December 21, 1955 pertaining to said design patent.

8. It denies the allegations of paragraph 8 of Count I of the Complaint, save Plaintiff admits receipt of a letter dated March 30, 1956 alleging infringement of said design patent No. 176,367 by a Mitchell lighting fixture. Defendant further affirmatively avers that it purchased from the Cory Corporation the Lighting Fixture Division of Mitchell Manufacturing Co.

9. Paragraph 9 of Count I of the Complaint does not constitute a proper allegation, failing to state a claim upon which relief can be granted and hence should be stricken. To the extent that this paragraph may be answered, defendant is without knowledge or information sufficient to form a belief as to the truth of said allegation and therefore denies the same.

10. Defendant denies each and every allegation of paragraph 10 of Count I of the Complaint.

COUNT II

11-13 inclusive. In Answer to paragraphs 11, 12 and 13 of Count II Defendant re-adopts and re-asserts the answers given to paragraphs 1-3 inclusive of Count I.

14. It is without knowledge of, and therefore denies the [fol. 13] allegations of paragraph 14 of Count II, and specifically denies that plaintiff's reflectors ever were distinctive.

15. It is without knowledge of and therefore denies the allegations of paragraph 15 of Count II of the complaint and specifically denies that plaintiff's reflector design has ever achieved any exclusiveness or distinctiveness.

16. It denies the allegations of paragraph 16.

17. Defendant denies the allegations of paragraph 17.

18. Defendant denies the allegations of paragraph 18.

19. Defendant denies each and every allegation of Paragraph 19.

20. It denies the allegation of paragraph 20.

21. It denies the allegations of paragraph 21.

22. It denies the allegations of paragraph 22.

Further affirmatively answering the complaint, Defendant alleges as follows:

23. Plaintiff is estopped from alleging infringement of its design patent No. 176,367 for the reason that it is guilty of Laches as indicated by its failure and refusal to take any positive action against Defendant during a period of more than two years following Defendant's denial of the allegations of infringement and averment of the invalidity of the patent as evidenced in Defendant's Reply dated April 9, 1956 attached hereto as Defendant's Exhibit A. Plaintiff's excessive delay of more than two years in taking the affirmative action induced defendant to materially change its position since the notice of infringement and denial occurred just as defendant was entering the lighting field by purchase of the Lighting Division of the Mitchell Manufacturing Company.

24. Plaintiff's Design Patent No. 176,367 is wholly invalid and void at law and of no legal effect for each of the following reasons:

[fol. 14] A. The alleged invention in an ornamental design of said design patent, was shown and described in printed publications in the United States and countries foreign to the United States before the alleged invention by the aforementioned patentees and/or more than one year prior to the filing of the application on which said patent issued as follows:

1. Illuminating and Engineering Society Lighting Handbook, 1947 edition, page N78.

2. Guth Lighting catalogue No. 44A, published 2/1/47; pages 31 and 32.

3. Benjamin General Catalogue issued 10/31/52, Sec. 13, page 299.

4. Wheeler Reflector Company catalogue C-200 dated July 14, 1952, pages 12-27 inclusive.

5. RLM Standard Specifications for Industrial Lighting units, 1955 edition effective October 1, 1954, pages 11-17 inclusive.

6. UNITED STATES PATENTS

Abernathy	2,332,770	October 26, 1943
Arras	1,946,465	February 13, 1934
Arras	1,950,380	March 13, 1934
Scribner	2,261,187	November 4, 1941
Glass	2,423,884	July 15, 1947
Westby	2,678,380	May 11, 1954
Kevorkian	2,686,254	August 10, 1954
Foulds	2,833,916	May 6, 1958
O'Neil	Des. 89,994	May 23, 1933
Herst	Des. 93,347	September 18, 1934
Beck	Des. 97,834	December 17, 1935
Mausshardt	Des. 130,745	December 16, 1941
Hass	Des. 131,195	January 27, 1942
Lazerson	Des. 156,014	November 15, 1949
Schwartz	Des. 175,800	October 11, 1955
Meyer	Des. 177,532	April 24, 1956

[fol. 15]

BRITISH PATENT

Iliffe	537,898	July 11, 1941

AUSTRALIAN PATENT

Iliffe	114,518	January 7, 1942

And others of which defendant is not at present advised, but begs leave to add hereto by proper amendment when information thereof has been obtained.

B. The alleged invention in an ornamental design of said design patent was known to and in use by others and in public use and/or on sale before the alleged invention

or discovery by the said patentees or more than one year prior to the patentees' application for Letters Patent therefor, as follows:

1. Day-Brite Lighting, Inc., of and at St. Louis, Missouri, and Toronto, Canada.

2. Guth Company, of and at St. Louis, Missouri.

3. Benjamin Electric Company, of and at Chicago, Illinois.

4. Wheeler Reflector Company, of and at Boston, Massachusetts.

And others of whom defendant is not at present advised but begs leave to add thereto by proper amendment when information thereof is obtained.

C. Said Carl X. Meyer and Leo G. Stahlhut are not the inventors of the alleged invention in an ornamental design of said patent.

D. The alleged invention of said patent is not ornamental and therefore is not patentable under the Patent laws and the Commissioner of Patents granted said patent unlawfully and without authority.

E. On information and belief said design Letters Patent No. 176,367 does not disclose or show any invention whatsoever in view of the state of the art of lighting fixtures and/or lighting reflectors which existed at and prior to the time that the said alleged inventors made the alleged invention set forth in said Letters Patent, and that in view of the state of the art said alleged improvements were not patentable; and defendant therefore avers upon information and belief that said patent is void and invalid in view of the state of the art.

[fol. 16]

F. The aforementioned patentees surreptitiously, unjustly and fraudulently obtained the issuance of said Design Patent 176,367 by wilfully and fraudulently withholding information from the Commissioner of Patents which, if known to him, would have prevented the issuance of the subject patent.

G. Said patent does not exhibit patentable invention and embodies no more than mere mechanical skill in an obvious adaptation of prior well-known designs.

H. The alleged dominant features of the design comprising the subject matter of the said design Letters Patent No. 176,367 are strictly functional and hence not the proper subject matter for a design patent.

I. The reflector comprising the subject of said Design Patent No. 176,367 is something less than a complete article of manufacture and hence not the proper subject matter for a design patent.

Defendant further denies that Plaintiff is entitled to any of the relief prayed for or to any relief, and therefore prays to be hence dismissed with its costs in this cause sustained.

COUNTERCLAIM

COUNT I

Defendant, Compco Corporation, hereby counterclaims as follows:

[fol. 17] 1. Compco Corporation is a corporation organized and existing under the laws of the State of Illinois, with its principal office at 1800 North Spaulding Avenue, Chicago, Illinois.

2. Upon information and belief Plaintiff is a Missouri corporation having its principal office in St. Louis, Missouri.

3. This Court has jurisdiction of this cause of action because the same arises under the patent laws of the United States, namely: 35 U.S.C. 281 and 289, and 28 U.S.C. 1338(a) and 1400(b). The matter in controversy exceeds the value of Three Thousand Dollars ($3000.00) exclusive of interest and cost, and jurisdiction of this Court further arises under Section 1332 of the Judicial Code of the United States by reason of the diversity of citizenship.

4. Upon information and belief Day-Brite Lighting, Inc., is the owner of Design Letters Patent of the United States No. D-176,367.

5. In March 1956 Compco Corporation purchased the Lighting Division of Mitchell Manufacturing Co., including the designs, blueprints, tools, dies and inventory pertaining to a lighting fixture designated by the trade mark "Dynalite", designed, engineered, manufactured and sold by said Mitchell Manufacturing Co., prior to the aforementioned purchase and now manufactured and sold by Compco Corporation; the reflector portion of said fixture now charged by Day-Brite Lighting Inc., as infringing Design Patent No. D-176,367. Compco Corporation alleges that the design of its aforementioned "Dynalite" lighting fixtures are completely different from the design disclosed and claimed in said Des. Patent 176,367 and that none of the fixtures made or sold by it embodies any invention or design owned by Day-Brite Lighting, Inc., or infringes any of its said patents.

[fol. 18] 6. Compco Corporation alleges that Day-Brite Lighting, Inc., Design Patent D-176,367 is invalid and void for the following reasons, to wit: Compco Corporation adopts and re-asserts the allegations of paragraphs 24-A-24I inclusive of its answer to the complaint.

COUNTERCLAIM II

Compco alleges as follows:

7. This is an action for unfair competition brought under 28USC1338 and jurisdiction of this Court further arises under Section 1332 of the Judicial Code of The United States by reason of the fact that the amount in controversy exceeds the value of Three Thousand Dollars ($3,000.00) exclusive of interest and cost and of the diversity of citizenship of the parties.

8. Compco re-alleges and incorporates the allegations of paragraphs 1, 2 and 4 inclusive of the first counterclaim.

9. Compco and Day-Brite are both manufacturers and sellers of lighting fixtures.

10. On information and belief Day-Brite holds itself out to be the largest manufacturer of lighting fixtures in the world and by virtue thereof has embarked upon a program calculated to stifle competition and enhance its position at the cost of others in the field of lighting fixture manufacture and sale.

11. Despite having manufactured and sold fixtures and reflectors having substantially the same design as the reflectors comprising the subject matter of design Patent No. 176,367 more than one year prior to January 17, 1955 (the filing date of the application for said design patent) and with full knowledge that others had designed, manufactured and sold lighting fixtures and reflectors of substantially the same aforementioned design; Day-Brite [fol. 19] fraudulently permitting its employees Carl X. Meyer and Leo G. Stahlhut to make false oath as to the novelty of said design and caused said application to be filed for Design Letters Patent. By reason of its deliberate failure to impart the aforementioned information concerning lack of novelty to the Patent Office, Design Patent No. 176,367 was finally issued.

12. The aforementioned design patent was obtained solely for the purpose of harassing the Lighting Fixture Industry. At the time that Day-Brite notified Compco that the design of Compco's reflector infringed Day-Brite's aforementioned design patent, Day-Brite knew that said charges were false and were made with malicious intent of injuring Compco's business and for the purpose of gaining for Day-Brite an unfair competitive advantage in the marketing of its fixtures and reflectors.

Said charges have injured Compco and if continued will cause further and irreparable damage to Compco.

Compco has no adequate remedy at law therefor and is informed and believes and, therefore, alleges that unless restrained by injunction of this Court, said Day-Brite will continue said acts of unfair competition and will continue to make false charges of infringement and to harass Compco and its customers and prospective customers to the further irreparable damage of Compco.

Wherefore, Counterclaimants ask the following relief:

A. That a Judgment be entered adjudging said design patent D-176,367 invalid and not infringed.

B. A Writ of Temporary Injunction pending the trial of this case, and a Writ of Permanent Injunction thereafter, be issued under the seal of this Court enjoining and restraining Day-Brite Lighting, Inc., its agents, servants, employees and all persons and corporations in active concert or participation with it from;

[fol. 20] (1) Uttering any further false or slanderous statements charging infringement of said Design Patent No. 176,367 by reason of the manufacture, use or sale of said reflectors by Compco.

(2) Uttering any further false or slanderous statements which would or might injure Compco in its business.

C. That Counterclaimants be awarded all damages they have suffered by reason of the unfair competition complained herein.

D. That the Court find that the acts of Day-Brite Lighting, Inc., of which complaint is made in this counterclaim, were performed wilfully and maliciously for the sole purpose of unlawfully injuring, counterclaimant in its business.

E. That Counterclaimant be awarded costs and attorneys fees in this Action.

F. That Counterclaimants have such other and further relief as to the Court may seem proper.

Silverman, Mullin & Cass, By Eli Mullin, Attorneys for Counterclaimant, 105 West Adams Street; Eli Mullin, 105 West Adams Street, Attorney for Counterclaimant; Sidney J. Goldstein, 134 North LaSalle Street, Attorney for Counterclaimant.

[fol. 21] Proof of Service (omitted in printing).

DEFENDANT'S EXHIBIT A

April 9, 1956

Gravely, Lieder, Woodruff & Wills
Attorneys at Law
705 Olive Street
St. Louis 1, Missouri

Re: Your Client: Day-Brite Lighting, Inc.
Allegation of Design Patent Infringement
My Client—Compco Corp.
My File—51955

Gentlemen:

Your letter of March 30, 1956, addressed to Compco Corp., and alleging infringement of Meyer Design Patent #176367 has been referred to me for investigation and reply.

After examining the results of the investigation by Cory's patent lawyer together with information supplied by my client, I have arrived at the same conclusion, namely that the Meyer Design Patent #176367 is invalid.

In addition to the reasons set forth in Mr. Kraus' letter of February 14 addressed to Mr. D. J. Biller, my opinion as to invalidity of the patent is based on the following facts:

1—Every element of the fixture designed is dictated either by the RLM standards for the industry or are strictly functional. In this connection it is important to note that RLM Standard #D-1 dictates the dimensions (Article II, [fol. 22] Item 3); the beading or flanging of the lower edge of the reflector (Article II, Item 2); and even the radius or contour of the reflector (Article III—A Shielding Angle and B—Contour).

2—The ribbed construction is obviously functional for the purpose of reinforcing the reflector to prevent buckling during the enamel baking process. As a matter of fact this is openly admitted by Day-Brite in its brochure announcing their CFI-10 fixture. In this brochure under the heading "New Rib Construction" the following appears:

"Reflectors are reinforced by dis-embossed ribs located between the apertures. Ribs add lateral stability to prevent the reflector from spreading, helps maintain straight fixture edges".

It is my further opinion that not only is the Meyer Design Patent invalid, but even more pertinent is the fact that the Mitchell Dynalite Fixture does not infringe the patent. In this connection I have been advised that the fixture comprises not only the reflector but also a channel or ballast housing. The two components are assembled and sold as a single unit, again in accordance with RLM standards. Since it is obvious that the Mitchell channel is completely different from the Day-Brite channel, the overall appearance of the two fixtures when compared as they actually appear in use, are completely different. Undoubtedly you are familiar with the basic well-known principle of Design Patent Law that the design must be judged from its appearance as a whole, and not from a comparison of individual elements thereof (In re: Peet 101 USPQ 202).

You are also no doubt familiar with the basic principle of Design Patent Law that in determining infringements the articles must be compared as they appear when in use (Bolte & Wayer Co. v. Knight Light Co., 180 F. 412, CCA 7).

[fol. 23] As a matter of fact, the validity of the Meyer Design Patent is also questionable for the same reason, since the reflector is never sold as a separate article of manufacture, but always in combination with the ballast channel, application for the design patent should have been for the entire fixture and not for the reflector alone. Had the Patent Office been advised that the reflector was merely a part of the fixture, it is most doubtful that the patent would have been granted. In the case of Ex Parte Northup, 26 USPQ 63, the design patent on the forward corner of an automobile body was refused "since it failed to cover a complete article of manufacture, the forward corner never being sold as a separate article of manufacture."

For the foregoing reasons, I am advising my client that it does not infringe the Meyer Patent and that the same is invalid.

Yours very truly,

Eli Mullin

EM/ce

Mr. S. J. Zagel

cc—Compco Corp.

IN THE UNITED STATES DISTRICT COURT

Civil Action No. 58 C 1300

Equitable Relief Sought

ANSWER TO DEFENDANT'S COUNTERCLAIMS—
Filed November 4, 1958

Now comes plaintiff, by its attorneys, and in answer to defendant's counterclaims alleges as follows:

1. Plaintiff admits the allegation of paragraph 1.

2. Plaintiff admits the allegation of paragraph 2.

3. Plaintiff admits the allegations of paragraph 3.

[fol. 24] 4. Plaintiff admits the allegation of paragraph 4.

5. Plaintiff is without information with respect to the allegations of the first sentence of paragraph 5 and therefore denies same and leaves defendant to its proof thereof. With respect to the second sentence of paragraph 5, plaintiff denies the allegation therein.

6. Plaintiff denies all the allegations of paragraph 6.

7. Plaintiff denies the allegations of paragraph 7 in that there are no grounds for any action for unfair competition against plaintiff, and, further, that the allegation thereof does not assert the necessary jurisdictional amount.

8. Plaintiff admits the allegations of paragraph 8.

9. Plaintiff admits the allegation of paragraph 9.

10. Plaintiff denies the allegations of paragraph 10 save that it believes itself to be the largest manufacturer of lighting fixtures in the United States.

11. Plaintiff denies each and every allegation of paragraph 11.

12. Plaintiff denies each and every allegation of paragraph 12, as well as any inferences to be drawn therefrom.

Wherefore, plaintiff prays that its prayer in its Complaint be granted and that counterclaimant's prayer for relief be denied in all respects.

Owen J. Ooms, Joseph J. Gravely, Frederick M. Woodruff, Attorneys for Plaintiff.

[fol. 25] Of Counsel:

Ooms and Dominik, One N. LaSalle St., Chicago 2, Illinois.

Gravely, Lieder & Woodruff, 705 Olive St., St. Louis, Mo.

Proof of Service (omitted in printing).

IN THE UNITED STATES DISTRICT COURT,
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION
No. 58 C 1300

DAY-BRITE LIGHTING, INC., a corporation, Plaintiff,

vs.

COMPCO CORPORATION, a corporation, Defendant.

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had in the above-entitled case before the Honorable Julius H. Miner, one of the Judges of said Court, in his courtroom in the United States Courthouse, at Chicago, Illinois, commencing on Monday, October 3, 1960, at 10:00 o'clock, a.m.

[fol. 26] APPEARANCES:

Messrs. Ooms, Welsh & Bradway, (Suite 2709, One North LaSalle Street, Chicago, Illinois), by Mr. Owen J. Ooms, and Mr. Malcolm S. Bradway

and

Messrs. Gravely, Lieder & Woodruff, (705 Olive Street, St. Louis, Missouri), by Mr. Frederick M. Woodruff, appeared on behalf of the Plaintiff;

Messrs. Silverman, Mullin & Cass, (Suite 2525, 105 West Adams Street, Chicago, Illinois), by Mr. Eli Mullin; Mr. Max R. Kraus, (Suite 1612, 105 West Adams Street, Chicago, Illinois), and Mr. Sidney J. Goldstein, (Suite 1818, 134 North LaSalle Street, Chicago, Illinois), appeared for the Defendant.

(Thereupon the following proceedings were had herein:)

The Clerk: No. 58 C 1300, Day-Brite Lighting, Inc., vs. Compco Corporation, on trial.

Mr. Ooms: Miss Reporter, will you please mark these as Plaintiff's Exhibits 1, 4, 5, and 6.

(The said document was thereupon marked Plaintiff's Exhibit 1 for identification, and said physical exhibits were marked Plaintiff's Exhibits 4, 5 and 6, respectively, for identification.)

[fol. 27]

THEREUPON MR. OOMS ADDRESSED THE COURT IN OPENING STATEMENT ON BEHALF OF THE PLAINTIFF, AS FOLLOWS:

By Mr. Ooms:

I will make a very short opening statement for the Plaintiff, your Honor.

This is a design patent case. A design patent, your Honor, is similar to a mechanical patent in that the Court does not have to be bothered with reading claims or words to find out whether the particular device that is accused finds any response in these words. This is a matter of aesthetics. It is subliminal in many respects.

However, there are certain criterion to determine whether a patent is valid or not. We expect to show the Court that the particular device which is here the physical embodiment (indicating), is a reflector for an industrial fixture and it is shown in United States design Patent 176,367, which we have had marked Plaintiff's Exhibit 1, which I will hand to the Court, which is all that is in the patent here.

The Court merely has to look at that design patent, look at the accused structure and if, in the over-all eye appearance it is the same, then the issue of infringement is met.

So that there won't be any confusion, your Honor, a design patent in some respects is similar to a copyright. It is an artist's conception of appearance, aestheticness. We have the same thing in the third dimension even in copyrights now. There are other places, of course, where there is no similarity.

As a matter of fact, one may today sometimes get a design patent and a copyright on the same object. We are only concerned here with a design patent. As such, it is similar to a mechanical patent in that invention must be present.

[fol. 28] Now, we say invention is present here. The Court will undoubtedly hear about some of the so-called prior art structures. The Court will then be required to look at these prior art structures, one of which is here, called a Guth

Mazelites and probably look at one of Plaintiff's former structures and some prior art patents and determine from that whether invention is present.

And then, if the Court finds that invention is present here, it will look at the accused structure and if it meets with the same over-all appearance, the infringement is found.

Now, getting back to invention, your Honor, the several criterion involved are, first of all: A design patent, like a mechanical patent, is presumed valid. The burden is upon the defendant to overcome this presumption.

Another very important point is determining whether this aestheticness is present to meet that quality called invention, is the commercial success of this patented structure. The courts say in close cases that commercial success may be used to tip the balance in favor of validity.

Another criterion is whether the Defendant copied it because there are many decisions which state that if the Defendant copied it that is as good evidence as the Court can find that there must have been something good, unique, inventive in the particular patented structure.

We have also charged unfair competition here in that they have put on the market an industrial reflector so similar as to permit others in the field to substitute that reflector for the reflector of the Plaintiff.

We will attempt to show by our evidence exactly each of these criteria to show invention. We will have an expert here to try and aid the Court as to the subtleties [fol. 29] involved in industrial styling, and so forth. Sometimes they are of no benefit to the Court and sometimes they are of great benefit, but we will have one available for the Court.

In that respect, in order to guide the Court in a design infringement case we, have prepared a very brief trial brief. In it we have put the propositions of law which should govern.

I might say to the Court at this time that the Federal Courts were loath to find validity in a design patent but I think the Court realizes as well as probably everyone today, that industrial styling has become of age ever since World War II, it has become more and more important.

In items which are functional, the thing that sells them is not only its function, which is important, but one must be able to look at that and that product must give an identification of a manufacturer.

That is what the Plaintiff has done in this case when it has come up with this over-all design—when people look at it they immediately think of the Plaintiff, Day-Brite Lighting Company, and recently, the last four or five years especially, design patents have been held valid in the Second Circuit.

In the Second Circuit a design patent on a spoon was held valid and in the Third Circuit on chocolate animals has been held valid, as well as on the heel of a stocking.

The Fourth Circuit also upheld a design patent recently on the heel of a stocking; the Fifth Circuit on a skirt hanger, and several years ago, the Ninth Circuit on a plate holder for automobile licenses. Just recently Judge Maris several months ago upheld a design patent on a panel that fits into lighting fixtures.

So the Courts are catching up with what the industrial [fol. 30] field is with respect to styling to aestheticness. It is the identification, the indicia by which a manufacturer can now be known in a field where there are literally hundreds and hundreds of manufacturers. It is like a trademark to his goods so that the public immediately identifies this particular product with that manufacturer.

Those are the basic issues present and we will endeavor by our witnesses to come forward with it. The burden of invalidity is, however, upon the defendant.

Thank you.

THEREUPON MR. MULLIN ADDRESSED THE COURT IN OPENING STATEMENT ON BEHALF OF THE DEFENDANT, AS FOLLOWS:

By Mr. Mullin:

Your Honor, I should correct counsel for the plaintiff immediately. I call to your attention that there is no presumption of validity here in this case in view of the prior art, and we shall show what the state of the prior art was and how infinitesimal, if anything, was the advance over the prior art.

We also, your Honor, have prepared a trial brief in which we have set forth very briefly the main points here involved, why this patent is invalid, why it lacks invention, why we are not infringing, and some of the basic law as it pertains to design patents.

The Seventh Circuit, your Honor, has not upheld a design patent in the last—I think it is twenty or twenty-five years. The last case on a design patent which was upheld by our own Circuit Court of Appeals was on a reflector, the Spaulding design—

The Court: You mean the patent was upheld?

Mr. Mullin: No, I meant it was not upheld.

The Court: How recently?

Mr. Mullin: This was decided last year. Since that [fol. 31] there has been another decision, the Amerock decision, just handed down a few months ago, in which the Court traced the whole design history and showed that in the last twenty-five decisions only two had been upheld.

I think it is important that the Court appreciate the distinction between a mechanical or a functional patent and a design patent. In our own circuit, our own Circuit Court of Appeals, has defined that, I think, very succinctly—

The Court: Aren't you arguing it now?

Mr. Mullin: I think it is important that you understand the distinction.

The Court: All right.

Mr. Mullin: It is very brief. In the case of Burgess Fibercraft vs. The Atkins Industries, our Circuit Court of Appeals said:

> "—as in the case of mechanical patents, the design must be the product of inventive faculty."

In that respect, your Honor, it is entirely different from copyrights because there is no invention required in copyrights; but in this respect it is exactly the same as a mechanical patent—there must be invention. I am reading from the key decision:

> "—in the one must appear creative novelty and utility—"

The Court: That is design?

Mr. Mullin: No, that is the mechanical utility, function.

"In design must appear creative originality and artistry."

And then in a number of other decisions the Court went on to hold that there must be something more than mere novelty. Mere novelty does not make invention in design cases as well as in mechanical cases. So that in the trial brief you will note, your Honor, how the distinction was [fol. 32] made, how it has been endorsed rigorously not only by our own Circuit Court of Appeals, but throughout the country and even by the Supreme Court.

Now, you will note that the Court emphasizes artistry, your Honor. This is a reflector, just the reflector portion of a complete fixture. (Indicating) Now, this is the reflector portion. This is a reflector attached to the balance of the fixture. The fixture is never sold completely assembled. This reflector is never sold alone.

So here we have an embodiment of the plaintiff's showing a complete reflector, a complete fixture with what they call a channel housing and which contains the electrical elements and the ballast, and so forth. That is the complete reflector, and that is the way it is sold.

This is our own reflector and complete fixture with a ballast housing, with the lamp sockets and with the reflector portion.

Now, you might ask yourself, "Why did the Patent Office grant a patent where there was no invention?" That we will prove. We will show the prior art, that there were reflectors which were made which had every element of this particular design, every element. There were reflectors having this same configuration, reflectors having these slots, which are called uplight slots, and are made so that a portion of the light can be reflected upward on the ceiling and then down.

There were reflectors having every element, including these bent metal portions, which the plaintiff refers to as ribs, cross-ribs. Every element is found in the prior art but not all of the prior art was before the Patent Office at the time that it granted this patent.

The Patent Office had only this one patent before it. This is a copy of the patent. That is called the Abernathy patent and this is merely an enlargement which shows the pictorial representation.

[fol. 33] Now, this is the only patent it had before it at the time that it granted the patent. It did not know about a number of other fixtures which were actually on the market and which showed a very similar design.

Why did the Patent Office not know about these? Because the plaintiffs fraudulently withheld giving this information to the Patent Office. Now, this is a copy of the first action from the Patent Office in which they cite that Abernathy patent and which they state that the prior art shows all of the elements, shows the configuration, shows these uplight slots. The only thing they did not find were these ribs, these cross-ribs, these indentations, and they argued that those indentations or cross-ribs were functional, they had to be put in there to stiffen, to strengthen, just as ribs have been put into everything since time immemorial, since they have been using ribs to strengthen, and, therefore, they refused the patent on the first action.

At that point the plaintiff should have told the court about this prior art which they knew about, and one of which was their very own fixture. This was the forerunner of the present fixture here involved and that is called the C.F.I. Day-Line.

The Court will notice that the fixture is identical and even has ribs across the top; ribs across the top here (indicating). They did not call that to the attention of the Patent Office nor did they call to the attention of the Patent Office a prior Westinghouse fixture having cross ribs, having slots, having the same configuration; nor did they call to the attention of the Patent Office a reflector known as the Guth Mazelite or a Day-Brite fixture that was identical, showing ribs this time extending down into the sides.

This is a blow-up of one of the catalog sheets of the Guth Mazelite. Incidentally, all of this prior art has been [fol. 34] stipulated as being prior art. Now, Guth is made by the Guth Lighting Company, which is a neighbor of the Day-Brite Company down in St. Louis. They knew

about this. They never told the Patent Office about it until some time later.

Now, at the same time that they applied for this design patent they also applied for a mechanical patent on the identical fixture. The Patent Office refused that but during the prosecution of that mechanical patent application they did call the attention of the Court to these, but that was not called to their attention until after the design patent has already issued.

The mechanical patent application was not only denied by the Patent Office but on appeal the Patent Office was affirmed and the denial was sustained.

We say, your Honor, that withholding this information from the Patent Office was fraud and that is why we are asking for attorneys' fees.

Now, another reason why we say that the patent is invalid, and we will prove it, is because the entire thing is functional. This is a functional reflector. It is called an industrial reflector and it is used in factories, and so forth. The entire reflector is functional and particularly on the point of novelty is it functional. These ridges are purely functional—and that statement is not my own statement, it is the statement made in the literature which was put out by the Plaintiff.

We will introduce evidence to show these catalog sheets, these advertisements, calling attention to the fact that these strengthening ribs are in there to strengthen to prevent warpage and to do that which ribs have done since time immemorial—strengthen the reflector.

Not only were those statements made in the advertisements and in the literature, but, they were made and not [fol. 35] only admitted, but urged and strongly argued by the plaintiff during the prosecution of this mechanical patent application.

Your Honor, I hand you copies of sheets taken from the actual file wrapper which we will introduce, in which such statements are made as:

> " . . . transverse stiffening means which take the form of flanges along the margin of the light emission openings and ribs directed across or transversely of the

reflector body so that stiffness and rigidity in both longitudinal and transverse directions of the reflector bodies may be obtained."

That was contained not only in the original application and in the claims, but also in arguments which were presented during the prosecution of the mechanical application.

We will also show that there are actual cases in this Circuit which hold that a rib is not valid, is not a valid subject matter for a design patent.

Now, as to commercial success, the plaintiff has mentioned that commercial success can be used in doubtful cases to sway the court in holding a patent valid. There are cases that have held that, but, every case that I know of has held that it cannot be used to fill the void to make an invalid patent valid, and, that is the situation here.

This case is so obviously invalid, we are here wasting the Court's time, in my opinion, on whether or not a little piece of bent metal is entitled to a design patent protection, United States patent protection.

Now, this argument as to functionality, again, is not my own argument. This was an admission made by the plaintiff, by the executive vice president of the plaintiff, Mr. James F. Whitehead in an affidavit made under oath [fol. 36] and filed during the prosecution of the mechanical patent application, in an attempt to sway the court in favor of granting the patent, and, in this affidavit, Mr. Whitehead pointed out that the prior reflector, that is, that C.F.I. "Day-Line" which they made and which is the forerunner of this (indicating), did not meet with commercial success and the reason it did not, was there was:

" . . . an excessive rate"—

This is that prior reflector (indicating) of the plaintiff. That is the prior art, identical, but showing the ribs only, going across, across the top.

Mr. Whitehead stated that the reason why this particular reflector did not meet with commercial success is because there was:

"... an excessive rate of factory rejects attributable to warpage of the reflector units during burning of the coating and chipping of this coating in the packages"—

pertaining to the coating means. This is a porcelain enamel coating which is baked on at high temperatures, and that is what is called burning.

Then he went on to say:

"... the sharp drop in industrial sales for the year 1954—"

he is talking about this CFI "Day-Line" fixture—

"is substantially due to the rise in factory rejects and customer rejectance.

"That the drop in business in 1954 in the industrial lighting fixture came at a time when the over-all business of Day-Brite increased five per cent over the year 1953."

And then he points out that when they introduced the new reflector with the ribs extended down into the sides, sales went up, they did meet commercial success.

[fol. 37] But he said:

"... which to Day-Brite indicated correction of the faults found in the 'Day-Line' units."

So that if there is any commercial success here, it is due not to the appearance or to the design, it is due to the fact that they have corrected the faults. This is the function that they have corrected and that would have been, if they could have gotten the mechanical patent application on it, that might have been a proper subject matter but, it is not subject matter for a design patent.

Mr. Ooms: Finish reading that sentence, will you, counsel?

Mr. Mullin: What sentence are you referring to, counsel?

Mr. Ooms: The one you were just reading to the Court.

Mr. Mullin: "... which, to Day-Brite indicated correction of the faults found in the 'Dayline' units and customer acceptance of the CFI."

Customer acceptance because there was no longer warping.

The Court: All right. We will recess until two o'clock.

Mr. Mullin: I am almost through.

The Court: All right. I will let you finish.

Mr. Mullin: It will take me about five minutes or so.

The Court may wondering why the Defendant in this case, Compco Corporation is making a fixture which they call the Mitchell fixture. Now, the reason for that is that this particular reflector, the one that is accused here, was introduced by the Mitchell Manufacturing Company in 1955. At that time, or some time after they had introduced it, the Plaintiff sent a letter, a notice of infringement to. Mitchell Manufacturing Company. Mitchell Manufacturing [fol. 38] Company replied, denying infringement and denying that the patent was valid.

Nothing further was done. Then Mitchell sold to a company called the Cory Corporation. They are the ones that make these coffee making machines. And then, the Defendant Compco Corporation bought from Cory. They bought certain of the assets and the right to manufacture these, including an inventory, dies, molds and so forth. That purchase was consummated, or, it was made around the early part of March, I think it was around March 9th of 1956.

On March 30th, the Plaintiff sent a letter to Compco Corporation again alleging infringement and on April 9th, it was about a week later, the Defendant Compco Corporation sent a letter back to the Plaintiff denying infringement, denying that the patent was valid.

There was never a reply received to that. This came, as you recall, at a time that they just purchased this business. Nothing was ever done until two and a half years later when this lawsuit was filed.

Now, these people were conversing. They met at trade shows and they knew each other. No word was ever mentioned about infringement. In fact, several months after we replied to their notice of infringement, another patent issue of the Day-Brite Company on a similar fixture and I obtained a copy of that and sent it to my client and in

my letter I called attention to the fact that since we had not heard from them, I presumed that the matter was closed. They went ahead. They went in to this business. They promoted it and they made a success of it. They were lulled into a sense of security by that two and a half year wait and I say, that is laches, your Honor.

Now, as for non-infringement, we will show, your Honor, that as we pointed out, all these features were old, every [fol. 39] feature is old. And, if there is any invention or if there is any claim of novelty, it is as to the specific shape of the ribs, the strengthening ribs. So that if there is infringement, then the ribs would have to be identical with the ribs here, but, that is not so.

Now, this is a drawing prepared to show the accused reflector and the patent in suit.

(Indicating) This is a top view. This shows the shape of the ribs. You will notice that in the patent in suit the ends of the ribs are kind of spoon-shaped with convex curves.

Now, that isn't true of the ribs of the Compco Corporation. Those ribs—it is almost a straight narrow rib at these very edges (indicating) at the points where it curves, you have a concave curve showing the entire difference and, that is even evident here in the fixtures themselves. (Indicating.)

You will notice how the fixture here comes out, curves out (indicating). Here you have this bulbous thing, this arcuate curve. Now, that isn't the only point of difference, although that would be sufficient to hold non-infringement.

But, the entire shape is different. Notice, these are cross-sections of the reflectors themselves (indicating). You will notice that in the patent in suit, there is a continuous, smooth curve at the corners. Not so in the reflector of the Defendant. It comes to a sharp point and then it is flat across. You can see that here in the reflectors. That isn't the only difference.

What about the particular shape of the rib itself? That is the cross-sectional piece. These are cross-sections taken through the ribs at these points (indicating) and you will see the difference in the contour of the rib. Ours, the

Compco ribs, are smooth with reverse curves. This is sharp [fol. 40] with straight sides. These drawings are taken directly from the production drawings of the patent of the Plaintiff and these are taken from the production drawings of the Defendant (indicating).

So, you can see, your Honor, that there is no infringement, there is no valid patent, there is no reason why we should be in this Court wasting the Court's time with something as simple as this which is so obviously non-infringing and which is obviously invalid.

The Court: All right. Two o'clock.

(Whereupon the trial of the above-entitled cause was recessed until 2:00 o'clock p.m. of the same day, Monday, October 3, 1960.)

* * * * * * *

Court convened pursuant to recess.

* * * * * * *

The Clerk: No. 58 C 1300, case on trial.

(Thereupon the following proceedings were had and taken, pursuant to recess:)

[fol. 41] The Court: I have been tied up with Judge Campbell. He was away for a time and we had to discuss a lot of things. Proceed.

STIPULATION TO FACTS, JURISDICTION, ETC.

Thereupon The Plaintiff, To Maintain The Issues On Its Part, Introduced The Following Evidence, To Wit:

Mr. Ooms: Counsel and I have stipulated as to a number of facts, the jurisdiction of this Court, ownership, testimony of certain witnesses who are going to be called and, I think, to save time, I would like to have the executed copy which I hand to your Honor, incorporated in the record, and I will give the reporter a copy.

The Court: Fine.

Mr. Ooms: I hand one to your Honor and your Honor can read it at your leisure.

The Court: Fine.

Mr. Ooms: Only one change should be made and that is in Paragraph vi., on Page 6. The sub-heading of Paragraph vi. refers to Exhibit A. That will be referred to as Exhibit 2, Plaintiff's Exhibit 2.

In Subparagraph vii., Exhibit "B" will be referred to as Plaintiff's Exhibit 3.

The Court: All right.

(Said stipulation being in words and figures as follows:)

"STIPULATION

The parties of the above-entitled action, by their attorneys, do hereby stipulate and agree, for the purposes of this action only, as follows:

1. Plaintiff, Day-Brite Lighting, Inc., is a corporation organized and existing under the laws of the State of Missouri, with its principal office at 5411 Bulwer Avenue, in the City of St. Louis.

[fol. 42] 2. Defendant, Compco Corporation, is a corporation organized and existing under the laws of the State of Illinois, with its principal office at 1800 North Spaulding Avenue, in the City of Chicago.

3. This Court has jurisdiction of the parties to the above-entitled action and the subject matter of the action.

4. Subject to proof and correction, if error as to authenticity of reproduction or other error should appear, copies of patents, letters, publications, and all other documents may be used at the trial of this cause in lieu of originals.

5. United States Patent No. Des. 176,367 was issued on December 13, 1955, by the Commissioner of Patents for a term of fourteen (14) years from the date of issue, on an application for a new and ornamental design for a Reflector for Tubular Lamp Lighting Fixtures which was filed in the Patent Office on January 17, 1955, and which bore the names Carl X. Meyer and Leo G. Stahlhut as the inventors of the design disclosed in the application.

6. Carl X. Meyer and Leo G. Stahlhut on December 30, 1954, did assign to Plaintiff the whole right, title and interest in and to said invention and said application to be filed therefor and any and all Letters Patent to be issued thereon by an instrument of assignment subsequently recorded in the United States Patent Office on January 17, 1955, on Reel 006, Frames 131 and 132, and Plaintiff has retained the entire right, title and interest continuously thereafter, and still owns the same.

7. Plaintiff commenced manufacturing, advertising and selling lighting fixtures having reflectors of the same appearance shown in Design Patent No. 176,367 on or about October, 1954.

[fol. 43] 8. Plaintiff sells its reflectors for lighting fixtures embodying the appearance of Design Patent No. 176,367 under the name CFI-10.

9. Defendant Compco Corporation, acquired certain of the assets of the Mitchell Lighting Division of Cory Manufacturing Company on or about March 9, 1956, including fixtures, jigs, engineering drawings, sales literature, and other material together with the good will of the lighting business of the Mitchell Lighting Division.

10. Plaintiff on or about December 31, 1955, gave Cory Manufacturing Company written notice of the issue of said Design Patent No. 176,367, Plaintiff's ownership thereof, and the infringement thereof by Mitchell's acts, and first gave a written notice to Defendant, Compco Corporation, of the issue of said Design Patent No. 176,367, Plaintiff's ownership thereof, and the infringement thereof by Defendant on or about March 30, 1956. In a letter dated April 9, 1956, Defendant denied infringement and the validity of Plaintiff's patent. Plaintiff did not respond to this letter.

11. After acquiring the assets and good will of Mitchell Lighting Division of Cory Manufacturing Company, Defendant manufactured, advertised and sold reflectors for industrial lighting fixtures under the names of 'Mitchell' and 'Dynalite', and is still manufacturing, advertising and selling such reflectors under such names.

12. Photographs of Plaintiff, Day-Brite Lighting Inc.'s CFI-10 reflector and the Mitchell 'Dynalite' reflector advertised, manufactured and sold by Defendant, Compco Corporation, as aforesaid, are attached to Plaintiff's complaint as Plaintiff's Exhibits 7 and 8 and are labeled 'Day-Brite' and 'Mitchell' in these photographs.

13. Defendant, Compco Corporation, has continued to [fol. 44] distribute advertising material, catalogs, and other promotional material under the names 'Mitchell' and 'Dynalite' and in connection with the sale of reflectors of the type labeled 'Mitchell' and shown in the photographic exhibits 7 and 8 attached to the bill of complaint since acquiring the assets and good will of the lighting business of Mitchell Lighting Division of Cory up to the present date.

14. Defendant's first sale of the aforesaid Mitchell 'Dynalite' reflectors as aforesaid took place after March 9, 1956, and defendant has continued selling such reflectors to the present time.

15. The Mitchell Lighting Division of Cory Manufacturing Company first sold reflectors of the type labeled 'Mitchell' and shown in the photographic exhibits attached to the bill of complaint prior to the acquisition of the aforesaid assets of Cory Manufacturing Company by Compco Corporation.

16. Plaintiff's patent No. Design 176,367 was on December 23, 1957, made the subject of an infringement suit in the United States District Court, Eastern District of Pennsylvania, Docket No. 23,808 (Civil Action), due notice to the public being given in the Official Gazette of the United States Patent Office, Volume 727, No. 1, of February 4, 1958 (page 5), and said suit against Planned Lighting, Inc. was terminated on May 27, 1958, by a consent judgment and an injunction was issued thereon perpetually enjoining Defendant, Planned Lighting, Inc.,

> 'from using or applying the design of United States Design Patent No. 176,367, issued December 13, 1955, or any colorable imitation thereof, with or to any article of manufacture for the purpose of sale, and

from advertising, exposing for sale, and selling any [fol. 45] article of manufacture to which such design or colorable imitation has been applied, including specifically, but without limitation thereto Defendant's reflector identified by Defendant as its Lifetime-301 porcelain industrial ribbed reflector,'

the said judgment and injunction being entered without a trial on the issues of validity and infringement.

17. The following testimony would have been given had the below-named persons' depositions been taken as notice by plaintiff to opposing counsel for June 9, 1959:

If Mr. W. W. Garey had been called to testify, he would have testified as follows:

i. He is publisher of the 'Electrical Construction and Maintenance' publication and the 'Electrical Wholesaling' publication, both division of McGraw-Hill Publishing Company, a corporation of the State of New York.

ii. The 'Electrical Construction and Maintenance' publication is published for and distributed to the electrical manufacturing industry.

iii. The 'Electrical Wholesaling' publication is distributed to electrical distributors.

iv. Plaintiff's Exhibit 2 attached hereto and made a part hereof, is the 'Twelfth Biennial Brand Preference Study' which was compiled during the year 1959 as a result of questionnaires mailed on January 15, 1959.

v. This survey or brand preference study has been conducted bi-ennially continuously since 1936.

vi. Plaintiff's Exhibit 2 is a copy of the study or survey taken in the normal course of business for McGraw-Hill and represents a compilation of the answers received to the questionnaires as indicated in said study.

[fol. 46] vii. The McGraw-Hill Publishing Company has a division known as Advertising Research Department, which conducted a survey on lighting fixtures known as 'Lighting Fixture Survey Among Electrical Distributors', which was published during the year 1958 and made available to subscribers of 'Electrical Wholesaling'. Plaintiff's Exhibit 3, attached hereto and made a part hereof, is the compilation of the answers turned over to deponent's division by the Advertising Research Department.

viii. At deponent's request, as has been done in earlier surveys among electrical distributors, certain portions of the answers to questions are blacked out, and such blacked out portions hereby indicate remarks of a derogatory nature. The 'Lighting Fixture Survey Among Electrical Distributors' has been made by the 'Electrical Wholesaling' publication through the research division of McGraw-Hill and is made available to subscribers to 'Electrical Wholesaling' upon their request.

If Mr. Charles B. Shaw had been called to testify by deposition, he would have testified as follows:

i. He is Sales Manager of the publication 'Electrical Construction and Maintenance', a McGraw-Hill publication.

ii. At the request of his publisher, Mr. W. W. Garey, he had his office mail out questionnaires, over Mr. Garey's signature, to subscribers to the 'Electrical Construction and Maintenance' publication by the method indicated on page two of Plaintiff's Exhibit 2 and answers to said questionnaire are outlined in Plaintiff's Exhibit 2.

iii. Similar surveys have been conducted bi-ennially since deponent has been an employee of the 'Electrical [fol. 47] Construction and Maintenance' publication.

If Mr. Sim Kolliner had been called to testify by deposition, he would have testified to the following facts:

i. He is Associate Director of Research for the publications division of McGraw-Hill Publishing Company and has been with that division since 1946.

ii. Deponent, with others in the Advertising Research Department, prepared questionnaires for the field advertisers and salesmen for the 'Electrical Wholesaling' publication who were then to interview electrical distributors. The answers to the questionnaires given to its field advertising and salesmen were then compiled and tabulated under deponent's direction in his regular course of business, the results of which are shown in Plaintiff's Exhibit 3.

iii. The survey was taken in the principal cities of eight major trading areas in the United States.

iv. At the request of the publisher of 'Electrical Wholesaling' publication, derogatory portions were blacked out and Plaintiff's Exhibit 3 was then made available to the personnel of 'Electrical Wholesaling' for distribution.

18. In the depositions of Hodges and Iven Meyer taken at Belleville, Illinois, on Wednesday, May 25, 1960, the following references to exhibits are in error and should appear as follows:

(a) Defendant's Stahlhut Exhibit 11 should be Defendant's Stahlhut Exhibit 13 and is drawing No. PI-30436-A;

(b) Defendant's Stahlhut Exhibit 12 should appear as Defendant's Stahlhut Exhibit 17 and is drawing No. TD-33251-A;

[fol. 48] (c) Defendant's Stahlhut Exhibit 12-a should appear as Defendant's Stahlhut Exhibit 18 and is drawing No. TD-33251-B; and

(d) Defendant's Stahlhut Exhibit 13 should appear as Defendant's Stahlhut Exhibit 19 and is drawing No. PI-30990.

19. Pages 47 through 50 submitted by defendant to plaintiff with a request for admissions on May 6, 1960, comprise a true and accurate transcript of the testimony of Bernard J. Geerling, one of plaintiff's administrative employees, given under oath on February 4, 1960.

20. Plaintiff will produce for use at the trial a Day-Brite Day-Line fixture, a Guth Mazalite fixture, and a Day-Brite CFI-10 fixture.

21. Defendant may amend the jurisdictional amounts in both counts of its counterclaims to show the minimum amounts as $10,000, rather than $3,000.

22. Foreign patents introduced into evidence were published on the dates shown on copies thereof pursuant to paragraph 4 hereof; and the dates shown by the United States Patent Office stamp, appearing on such copies of foreign letters patent, shall be accepted as proof that in the case of each such patent a copy thereof was received by the United States Patent Office and deposited in the library thereof on said stamp date. The foregoing is subject to correction should error be made to appear.

23. The printed dates appearing on publications or magazines shall be prima facie proof of the date of publication of such issues and such pages, subject to correction should error appear.

24. The dates of applications for United States Letters Patent as they appear upon copies thereof shall be received as prima facie proof of such dates.

[fol. 49] 25. The following documents or copies thereof under Paragraph 4 hereof may be introduced into evidence without further proof thereof, subject to objection as to relevancy or materiality by either party to this stipulation:

(a) Letter dated 3/30/56 from Plaintiff's attorneys to Defendant charging infringement.

(b) Copy of letter dated April 9, 1956, from Defendant's attorney to Plaintiff's attorneys denying infringement.

(c) Copy of letter dated June 7, 1956, from Defendant's attorney to Defendant.

(d) Guth Lighting Catalog No. 44A, published 2/1/47, pp. 31 and 32, showing the Guth 'Quick-Lite' and 'Mazelite'.

(e) Guth Lighting Catalog No. 44, published 1944, pp. 31 and 32, showing the Guth 'Quick-Liter' and 'mazelite'.

(f), (g), (h) and (i) Copies of Guth shipping invoices dated 1944 and 1947.

(j) Guth engineering drawing dated October 4, 1945-November 3, 1948.

(k) Illuminating Engineering, November 1954.

(l) Illuminating Engineering September 1954.

(m) Illuminating and Engineering Society Lighting Handbook, 1947 Edition.

(n) Benjamin General Catalog dated September 19, 1949.

(o) Wheeler Reflector Company Catalog C-200 dated July 14, 1952.

(p), (q), (r) and (s) Day-Brite Engineering Drawings, (Defendant's Stahlhut Deposition Exhibits 12-15, March 28, 1960.)

(t) Group of eight (8) Day-Brite Engineering Draw-[fol. 50] ings (Defendant's Stahlhut Deposition Exhibit 16).

(u), (v), (w), (x), (y) and (z) Engineering Drawings of Day-Brite (Defendant's Stahlhut Deposition Exhibits 17-22).

(aa) Day-Brite DayLine Engineering drawing (defendant's Falk Deposition Exhibit 23).

(bb) File wrapper and contents of design patent in suit, D-176,367, whether certified or not.

(ee) File wrapper and contents of mechanical patent application by Klingsick and Stahlhut filed January 11, 1955, Serial No. 482,242.

(dd) October 1956 'Day-Briter'.

(ee) April 1953 'Day-Briter'.

(ff) CFl-10 Day-Brite advertisements in 'Business Week' 10/23/54.

(gg) Guth catalog sheet (Defendant's Guth Deposition Exhibit 7) showing Guth 'Mazelite'.

(hh) Day-Brite Circular (Defendant's Klingsick Deposition Exhibit 9) showing CFl Day-Line fixture.

(ii) October 1954 'The New Lifetime CFl series' showing CFl-10 and 20 Day-Brite advertisement.

(jj) 'Twelfth Biennial Brand Preference Study' which is attached hereto as Plaintiff's Exhibit 2.

(kk) 'Lighting Fixture Survey Among Electrical Distributors' which is attached hereto as Plaintiff's Exhibit 3.

(ll) Westinghouse Catalog Section 61-230, pp. 11-14 dated September 1, 1953.

(mm) Defendant's Drawing No. 20M-2576 & 20M-2584 dated February 22, 1956.

26. The Guth Lighting Catalog No. 44A, pp. 31 and 32, published 2/1/47 and the Guth Catalog No. 44 published about 1944 comprises prior art not cited by the [fol. 51] Patent Office during the prosecution of the patent in suit, and were used in connection with the advertising and sale of Guth Industrial Quick-Liter and Mazelite fixtures.

27. The Day-Brite CFl Day-Line fixture illustrated on the cover of 'The DayBriter' April 1952, manufactured and sold by Day-Brite beginning in about 1951, comprises

prior art not cited by the Patent Office during the prosecution of the patent in suit.

/s/ Ooms, Welsh & Bradway
Ooms, Welsh and Bradway
(Attorneys for Plaintiff)

Dated: Sept. 30, 1960

/s/ Silverman, Mullin & Cass
Silverman, Mullin & Cass
(Attorneys for Defendant)

Dated: October 3, 1960."

Mr. Ooms: Mr. Whitehead, will you please take the stand?

JAMES FOOD WHITEHEAD, JR., called as a witness on behalf of the Plaintiff, having been first duly sworn, was examined and testified as follows:

Direct examination

By Mr. Ooms:

Q. Will you state your name and address, please?

A. My name is James Food Whitehead, Jr. I live at 514 Wilcox—

The Court: A little louder, please.

The Witness: I live at 514 Wilcox in Kirkwood, Missouri.

By Mr. Ooms:

Q. What is your occupation?

A. I am President of Day-Brite Lighting.

[fol. 52] Q. How long have you been with Day-Brite Lighting?

A. Since 1945.

Q. Will you, very briefly, tell us in what capacity?

A. I started in 1945 as a sales representative in Atlanta. I was transferred to St. Louis in 1948 as the general sales manager. I was made a Vice-President in charge of sales in 1953.

In 1956 I was Executive Vice-President and, on July 1st of this year I was made President.

Q. What is the business of Day-Brite Lighting?

A. Day-Brite Lighting's business is the manufacture and sale of commercial and industrial supply of fixtures.

Q. How long has that company been in business?

A. The company was originally incorporated in 1923.

Q. It was doing that type of business at that time?

A. It started out making showcase reflectors and then it expanded its line to include commercial and industrial, as the years went on.

Q. Are you a college graduate?

A. No, I am not.

Q. What is your educational level?

A. I graduated from high school in Athens, Georgia, my home. I went to George Tech for two years. I have taken several correspondence courses. I have taken night courses and post-graduate work at Washington University but I am not a college graduate.

Q. Are you a member of any societies in the electrical field?

A. Yes. I am a member of the Illuminating Engineering Society.

Q. Are you a member of a society known as NEMA?

A. I am the company representative to NEMA and I am a member of the Board of Governors of NEMA.

[fol. 53] Q. What is NEMA?

A. NEMA is the National Electric Manufacturers Association.

Q. What does NEMA do in the field?

A. The principal object of NEMA is to work with the American Standards Association and see that there are standards so far as certain electrical equipment is concerned.

Q. Does NEMA gather information on the general electrical field?

A. Yes. It is divided into a number of sections and each section does gather certain statistical information regarding that particular phase of the electrical industry.

Q. Does that include about the number of electrical manufacturers so far as the lighting field is concerned?

A. No. It is just a very small number of the lighting fixture manufacturers that are members of NEMA.

Q. But, does it gather information as to how many there are?

A. Yes, it does market research work.

Q. Can you tell me, about at the close of World War II, about how many electrical manufacturers there were in the lighting field?

A. I do not know the number at the close of World War II. The only number that I recall was the 1954 census report which indicated that there were over 1,200 manufacturers in the commercial and industrial lighting field.

Q. Now, Mr. Whitehead, has your company come to any firm decision with respect to the design of its products? If so, tell us what it is.

A. Yes. Right after the war that you speak of, World War II, there were a number of manufacturers that got [fol. 54] into the commercial and industrial field and, we have adopted a policy of trying to design our equipment so that it does have some distinctive design features. There is little brand preference in our industry and this is one of the problems that we feel confronts our industry.

Q. And as a result of that, what can you say has been the policy of your company?

A. It has been our policy to design fixtures that are distinctively Day-Brite, that they can be known in the electrical field as Day-Brite fixtures.

Q. Now, did you have or was there anything put out in the electrical field to support your expression here that you just gave with respect to design in the field?

A. From time to time there has been numerous brand preference surveys issued that indicate that in the lighting field there is little brand recognition. This differs greatly from other segments of the electrical industry.

These brand preference surveys have been put out periodically by—some are McGraw-Hill publications.

Q. I have here a green covered booklet marked, "Confidential—12th Biennial Brand Preference Study," which is marked Plaintiff's Exhibit 2 for identification. Is that one of such surveys that you were referring to?

A. Yes. This is put out each two years by Electrical Con-

struction and Maintenance, which is the magazine that principally goes to the electrical contracting field.

Q. Can you refer to anything in the booklet to conserve time which supports what you have just been talking about? I refer you specifically to page 6.

A. There is a statement or a sentence talking about the fluorescent field, which I will just read the last sentence of:

[fol. 55] "To insure the future healthy development of this industry, it is clearly evident that good manufacturers must de-emphasize price and concentrate their efforts on outstanding design and styling better distribution, strong sales promotion," et cetera.

Mr. Ooms: So that your Honor will be fully familiar with it, the stipulation which we have agreed to sets forth what witnesses have testified as to the gathering of this type of statistical material.

By Mr. Ooms:

Q. Now, I am going to call your attention to a white booklet entitled "Lighting Fixture Survey Among Electrical Distributors," which has been marked Plaintiff's Exhibit 3 for identification.

I ask you to tell me what that booklet is.

The Court: What bearing does all this have on the patentability of an article?

Mr. Ooms: What bearing does it have, your Honor?

The Court: Yes.

Mr. Ooms: This will show that what has been taking place-

The Court: I will take it for granted that the design or attractive display has the advantages you say in every product, not only in your line, but in every other line, that design is important. If you are capable of attracting the consumer's or customer's eye, that is so, but whether or not it has any bearing on the patentability is something else altogether.

Mr. Ooms: I am appreciative of hearing that. That will shorten the testimony up considerably. I was trying to get the proper background into the record here so that it might be of some benefit to your Honor.

The Court: I will concede there is no question about it, that an improvement in design or more attractive appearance is desirable and beneficial in the sale of everything. [fol. 56] Mr. Ooms: Very good, your Honor.

Mr. Kraus: As your Honor has suggested, we don't think that this is material to the issues, but we did not want to raise any objection because we thought we would waste more time if we did.

The Court: Well, I am not raising any objections, I am merely asking what bearing it has on the patentability.

Mr. Ooms: Just to give the proper background and perspective, your Honor.

By Mr. Ooms:

Q. Now, Mr. Whitehead, you are familiar with the industrial products of the plaintiff, are you not?

A. Yes.

Q. You are familiar with the product here that I hold in my hand, which has been marked Plaintiff's Exhibit 12? (Indicating)

A. Yes.

Q. What can you tell us about that product?

A. This is a model of our industrial reflector that we made in the early 50's. It was known as the CFI Day-Line.

Q. And it antedated the CFI-10?

A. That is correct.

Q. And we refer here to the CFI-10 which is the one covered by the design in the patent in suit?

A. That is right.

Q. And that is Plaintiff's Exhibit 4?

A. That is correct.

Q. Are you familiar with the accused structure, the Mitchell Dynalite?

A. I have seen the reflector.

Mr. Ooms: Would you agree with me or stipulate that this is that reflector, counsel? (Indicating.)

Mr. Mullin: Oh, yes.

[fol. 57] Mr. Ooms: That is Plaintiff's Exhibit 5 for identification.

By Mr. Ooms:

Q. Were you familiar with a Guth Mazelite fixture on the market prior to the CFI-10?

A. Yes.

Q. And is this that structure—

Mr. Ooms: And may we stipulate that that is, counsel, Plaintiff's Exhibit 6?

Mr. Mullin: We will stipulate that it is a Guth fixture. I am not prepared to stipulate whether that is the Guth Mazelite or the Guth Quick-liter as shown in their catalog No. 44. You have a blow-up of that. That is this picture here. (Indicating.)

Mr. Ooms: That is the one you spoke about this morning.

Mr. Mullin: That is right.

Mr. Ooms: We do not contest that this is prior to our CFI-10, your Honor. There is no question about it.

By Mr. Ooms:

Q. For convenience we have marked here two photographs as Plaintiff's Exhibits 7 and 8, and I will ask you to tell me what these two photographs show.

A. Plaintiff's Exhibit 7 shows the outside of the Day-Brite reflector and the outside of the Mitchell reflector.

Q. Do you want to hand it to his Honor.

A. Yes.

Plaintiff's Exhibit 8 shows the inside reflecting surface of both the Day-Brite and the Mitchell reflector.

Q. I hand you a pamphlet reading, "The New Lifetime CFI-10" which has been marked Plaintiff's Exhibit 9 for identification, and ask you what that is.

A. This is a piece of our advertising literature that came out in late '54.

[fol. 58] Q. And that made the announcement of the CFI-10, is that correct?

A. That is correct.

Q. And we have a Day-Briter dated October, 1954, marked Plaintiff's Exhibit 10 for identification, and another Day-Briter dated February, 1955, marked Plaintiff's

Exhibit 11 for identification. Will you tell us what those are?

A. These are publications that we make ourselves and send to all of the people on our mailing list, which includes not only our field sales organization but architects and engineers, electrical contractors, and so forth.

Q. And that is the house organ of the plaintiff?

A. That is right.

Q. Now, after the fixture similar or identical to Plaintiff's Exhibit 5 was called to Day-Brite's attention, what, if anything, did the plaintiff do?

Mr. Mullin: I am sorry, may I have that question read?

Mr. Ooms: Please read the question.

(Question read.)

By the Witness:

A. Is Exhibit 5 the plaintiff's fixture again?

By Mr. Ooms:

Q. No, this has been stipulated as the defendant's fixture.

A. Oh. It is my understanding that the management of our company notified first the Mitchell Company and then the Cory Company and then the Compco Company.

Q. Was anyone in the plaintiff company placed in charge of handling patent matters?

A. Yes, Mr. Stahlhut handled the patent matters for the company. He works with our attorneys.

The Court: Can't we stipulate to the correspondence on that? Both sides agreed to it.

[fol. 59] Mr. Ooms: Yes, it is in the record, your Honor.

The Court: Both sides agreed to it, so just identify it and that is all.

Mr. Ooms: Right. It has been identified already your Honor.

By Mr. Ooms:

Q. Did you have any sales and shipments of—

The Court: Let me ask a question, if I may—

Mr. Ooms: Yes, sir.

The Court: I understand the crux of this litigation is the patentability and prior art of the—you call it what, design?

Mr. Ooms: Design patent.

The Court: How much time would be saved if we tried that issue alone?

Mr. Ooms: I think that is what the primary issue will be in this case and I think perhaps practically all our time will be directed to that.

The Court: All right.

Mr. Ooms: We understand, of course, without patentability there cannot be any infringement.

The Court: That is right.

By Mr. Ooms:

Q. Now, did you have sales and shipments figures compiled for industrial fixtures?

A. Yes; Mr. Stahlhut has done that.

Q. And does Day-Brite make industrial fixtures other than this CFI-10?

A. Yes.

Q. And has been for the last six years?

A. Yes.

Mr. Ooms: I have no further questions.

Mr. Mullin: This is just a point of information: Do I understand you have not introduced these into evidence (indicating)?

[fol. 60] Mr. Ooms: I have not offered any of these exhibits as yet. I have just marked them.

The Court: Do you want these, Counsel?

Mr. Mullin: No, he has not introduced any of them, so—

The Court: Well, he identified them.

Mr. Mullin: He identified them, yes.

The Court: And he referred to them.

Cross examination.

By Mr. Mullin:

Q. Mr. Whitehead, this Plaintiff's Exhibit 9, which is this CFI-10 folder, when was that published?

A. Late 1954.

Q. Late 1954?

A. In the last quarter, I believe, of '54.

Q. This is a photostat of Illuminating Engineering and contains an advertisement of the CFI-10 and CFI-25 reflectors—

The Court: Isn't it identified with a certain marking?

Mr. Mullin: This has not yet been identified, your Honor. We can identify that as—in the stipulation I believe it is identified as 25-K. All right, we can mark that Defendant's Exhibit 25-K for identification.

(The document was thereupon marked Defendant's Exhibit 25-K for identification.)

By Mr. Mullin:

Q. You say this was put out in 1954?

A. I think that is correct, sir.

Q. And this was put out also in 1954? (Indicating.) I am talking about the Illuminating Engineer, marked November, 1954.

A. Yes, if this is the ad that appeared in 1954, that is correct, November, 1954.

[fol. 61] Q. Well, isn't it a fact that this was put out quite some time after 1954—and I am referring to Plaintiff's Exhibit 9—and that this actually is the advertisement that you put out in 1954, in which it states in talking about the new rib construction:

"... reflectors reinforced by die embossed ribs between apertures; ribs add lateral stability prevent spreading, maintain straight fixture edges ..."?

A. Well, isn't this the same fixture as that CFI-10 on the right-hand side of the ad that you have?

Q. Yes, yes. It advertises the same one but it does not use the same language, does it?

A. No, it is in different copy on both ads.

Q. All right.

A. With different pictures.

Q. Now, I think you testified as to some sales figures. What were those figures again?

A. Mr. Stahlhut has the figures.

Q. Oh, you are not going to testify as to any figures?

A. No.

Q. Are you the same James F. Whitehead who filed an affidavit in the Patent Office in connection with the prosecution of a mechanical patent application covering the identical fixture, on or about May 17th, 1954?

Mr. Ooms: Your Honor, this exceeds the direct testimony.

The Court: The objection is sustained. It is improper cross examination.

Mr. Mullin: I have nothing further.

The Court: Unless it has a tendency to impeach something he testified to. If it has, you are on proper ground, but if it hasn't then you cannot go into it.

Mr. Mullin: Well, I won't yet, your Honor.

The Court: All right.

[fol. 62] OFFERS IN EVIDENCE

Mr. Ooms: I now move to offer Plaintiff's Exhibits 1 through 12.

Mr. Mullin: I will object to 1 and 2—.

Mr. Ooms: 1 is the patent in suit.

Mr. Mullin: Then what number was that? Well, I will object to these two photographs. What is involved here is not necessarily the fixture, but the patent in suit and, therefore, the representation may or may not be the same as the patent in suit.

I have no objection to the accused device going in.

The Court: The objection will be overruled. It may be received in evidence.

(Said documents, so offered and received in evidence, were marked Plaintiff's Exhibits 1, 4, 5, 7, 8, 9, 10, 11 and 12.)

Mr. Mullin: I will object to 2 and 3, these Biennial Preference Studies. What is involved here is infringement

of a patent. There are no figures in here, there is nothing in here identifying this particular patent and—

The Court: I will sustain the objection.

Mr. Ooms: May I make one statement here before the Court rules? The reason these were put in was because of the disparaging remarks that counsel for defendant made with respect to the Plaintiff here. The record will show in these particular surveys that the Plaintiff is considered one of the outstanding members in its field and leads its field in design, quality and in other respects, and that is why they were offered, your Honor.

The Court: It is an improper way of proving it even if it were admissible; objection sustained.

(Witness excused.)

Mr. Mullin: We are objecting, your Honor, to Plaintiff's Exhibit 6 unless it is more properly identified than it is. [fol. 63] It is not the same as the Guth Mazelites or the Guth Quick-liter which are the prior art which we have stipulated to and they show four ridges, cross ribs. This one (indicating) only shows two.

Mr. Ooms: If the Court please, counsel for the Defendant took the deposition of the President, I believe, of the Guth Company, at which time they showed the catalog which Defendant is waving now and then.

On cross examination we asked him to produce that particular type of fixture shown in that catalog and this is what he produced and this witness, unfortunately is not a proper witness for showing it, but we have a receipt and everything from the company to prove up exactly what we asked for at his deposition.

Mr. Mullin: Your Honor, he also testified that there have been changes made and they have taken out some of the ribs. Now, I have no objection to their introducing this as a Guth fixture, but not as a Guth Mazelite or the Guth Quick-liter which show, actually show, four ribs. This only shows two.

The Court: It may be received. You can explain that by your testimony or by your argument.

(Thereupon said document previously marked Plaintiff's Exhibit 6 was received in evidence.)

The Court: Call your next witness.

E. George Hiscos, called as a witness on behalf of the Plaintiff, having been first duly sworn, was examined and testified as follows:

Direct examination.

By Mr. Ooms:

Q. Will you state your name and address, please?
A. The initial E, George Hiscos.

[fol. 64] The Reporter: Will you please spell your last name?

The Witness: H-i-s-c-o-s. 132 Butler Street, in Michigan City, Indiana.

By Mr. Ooms:

Q. What is your occupation?
A. My occupation at the moment is, I am working for Dunham Bush in the heat air conditioning field.
Q. Did you, at one time, work for the predecessor of the Compco Corporation known as the Mitchell Manufacturing Company?
A. I did.
Q. When did you work for that company?
A. I left Mitchell in the fall of 1955.
Q. How had you been with them prior to that?
A. Approximately two and a half years.
Q. Had the Mitchell Company produced a reflector called the Mitchell Dynalite at that time and sold it, commercially?
A. As far as sales go, I don't know. They had produced the reflector in the model shop.
Q. Can you tell me, did you observe the production of this particular fixture in the model shop?
A. During the various stages I had watched it. I had also procured, for Mitchell, the copy—the Day-Brite fixture.
Q. Are you referring to the fixture here marked as Plaintiff's Exhibit 4?
A. Just using a lighting—

Mr. Ooms: It has been stipulated that this is the CFI-10 Day-Brite.

By the Witness:

A. (Continuing) That or one or very similar to it. I can tell by the latches.

By Mr. Ooms:

[fol. 65] Q. What, if anything, was done with that fixture after you procured it for Mitchell?

A. That was basically placed back in the drafting room, in the engineering room, at which time it was laid on a draftsman's desk.

Q. Did anyone at Mitchell query you about any of the features of that particular Day-Brite reflector?

A. Having worked for Day-Brite—not Day-Brite, but for Chet Thorsen, the Chicago representative of the Day-Brite for the previous five years, and having quite a bit of asking by various people on the dies, how they were forming it, such as where they turn up on the reflector.

Q. This portion here (indicating)?

A. That portion in there, yes.

Q. Any other place?

A. And the ribbing.

Q. Are you referring to this cross ribbing?

A. Cross ribbing for structural strains.

Q. Did you see Mitchell present or offer to the public a reflector at a convention in 1955?

A. It was an industrial show. I did not have too much to do with the show. However, I was down at the show one evening and there was this sample which was down at the show. Now, whether it was a production sample or not, or the one made in the model shop, I don't know.

Q. Did anyone query you on that particular sample at that time?

A. Yes, Ralph Ferneau of Day-Brite.

Q. What did you say or what did he say?

A. He made the statement that it looked very much like a Day-Brite fixture.

Q. And what did you say?

A. I told him that if we were going to copy, we might as well copy the best.

Mr. Ooms: No further questions.

[fol. 66] Cross examination.

By Mr. Mullin:

Q. You say you worked for both Day-Brite and for Compco?

A. No. I worked for Day-Brite Lighting, for Chet Thorsen. I did not work for Day-Brite. I worked for Chet Thorsen.

Q. Day-Brite Lighting?

A. No; Chet Thorsen, the representative of Day-Brite Lighting.

Q. Oh, he was the representative of Day-Brite Lighting?

A. Correct.

Q. I see. You also worked for Compco Corporation?

A. No. I worked for Mitchell Manufacturing Company.

Q. Oh, you worked for Mitchell Manufacturing?

A. Prior to Mitchell's sale.

Q. How long did you work for Mitchell Manufacturing?

A. Two and a half years.

Q. When did you leave Mitchell Manufacturing?

A. I left Mitchell in the fall of 1955.

Q. What is your present occupation?

A. I work for Dunham Bush.

Q. What type of work is that?

A. Application engineer.

Q. Did you work for Cory Corporation?

A. I never worked for Cory Corporation.

Q. Did you ever work for Compco Corporation?

A. I never worked for Compco Corporation, no.

Q. What were the circumstances of your leaving your employment at Mitchell Manufacturing?

A. Basically, I was offered another position and, through a friend of mine who was to New York quite often, he told me Mitchell was going to sell. Knowing the finan-

cial status of Mitchell, I thought it was best to accept this opportunity.

[fol. 67] Q. When were you contacted concerning your testimony today?

A. About a week ago.

Q. Who contacted you?

A. Mr. Leo Stahlhut.

Q. You hadn't been contacted before then?

A. I had not been contacted before then.

Q. Had you talked to Mr. Chet Thorsen recently?

A. I had not talked to Mr. Chet Thorsen since I had luncheon with him approximately a year and a half ago, at which time I was with Benjamin Electric.

Q. You were with Benjamin Electric?

A. I was with Benjamin Electric.

Q. After leaving Mitchell?

A. After leaving Mitchell, I went to work for Marvin Manufacturing, who I know you are familiar with, who was purchased by Progress and, after that, I went with Benjamin Electric, in the spring.

Q. And both of those companies, do they make industrial fixtures?

A. They do.

Q. Do they make fixtures of this general type?

A. Let me clarify it. No, Marvin does not. Marco does not make industrial fixtures.

Q. How about Benjamin Electric?

A. Benjamin Electric is well known for industrial fixtures.

Q. Do they make a fixture like this? (Indicating)

A. With an upward component.

Q. With an upward component?

A. Yes.

Q. I see, and with a slotted top?

A. With a slotted top, yes.

Q. What was the general configuration?

A. Rather than the round breaks, due to their die setup [fol. 68] and so forth, they are more of a square break.

Q. With sharp corners?

A. Definitely a sharp corner rather than the rounded corner.

Q. You say that you purchased a Day-Brite fixture?
A. I did not purchase it. I picked it up for them.
Q. You picked up one?
A. Yes.
Q. Where did you pick it up?
A. From an electrical wholesaler here in Chicago.
Q. On the open market?
A. On the open market.
Q. I see. And, did you have anything to do with the designing of the Mitchell fixture, Plaintiff's Exhibit 6?
A. None whatsoever. I was in the sales department working under the direction of Jack Neuhauser.
Q. After you delivered that fixture, you don't know what they did with it?
A. Other than it was delivered and laid there for several weeks longer than that, actually, in the drafting room, engineering department on the third floor.
Q. Were there any other fixtures that lay there, too?
A. Not at that time.
Q. Do you know that there were some later on?
A. Oh, there were.
Q. Well, prior to that?
A. It is standard practice that any manufacturer buys competitive fixtures on the open market.
Q. Do you know whether Benjamin Electric is still making an industrial fixture?
A. So far as I know.
Q. Similar to this?
A. Not similar; a very distinct differential between that.
[fol. 69] Q. With the uplight components?
A. It has the slots for the uplight component. They are not flanged up; nor does the reflector have the ribbing. That again, is for structural strength through the right angle bend—or, not the right angle bend but—
Q. You testified that the cross-ribs here were for structural strength, is that right (indicating)?

Mr. Ooms: I object.

The Witness: I don't know if they were for structural strength or not. I mean, I am not an engineer.

By Mr. Mullin:

Q. I am just repeating the words you used. You said cross-ribs that were for structural strength and I am just asking you if that is what you meant when you said that.

A. I would assume that they would be put there for structural strength.

Mr. Mullin: Thank you.

Redirect examination.

By Mr. Ooms:

Q. Just one question. It was after you delivered the Day-Brite fixture that Mitchell then came out with their particular industrial fixture?

A. It was after that.

Mr. Ooms: No further questions.

(Witness excused.)

Mr. Ooms: Mr. Ferneau, please.

Ralph Ferneau, called as a witness on behalf of the Plaintiff, having been first duly sworn, was examined and testified as follows:

Direct examination.

By Mr. Ooms:

Q. Will you state your name and address, please?

A. My name is Ralph Ferneau.

[fol. 70] The Reporter: Will you please spell your last name?

The Witness: F-e-r-n-e-a-u.

I reside at 110 Mount Aire Drive, East Peoria, Illinois.

By Mr. Ooms:

Q. What is your occupation, Mr. Ferneau?

A. I am a technical sales engineer representing Day Brite Lighting in the central Illinois area.

Q. And how long have you been in that capacity or in a similar capacity?

A. Ten years, approximately.

Q. Do you recall attending a show in Chicago during 1955 at the Conrad Hilton Hotel, wherein a Mitcheall Dynalite fixture of the type identified here as Plaintiff's Exhibit 5 was exhibited?

A. Yes, sir.

Q. Can you tell us the circumstances surrounding that?

A. I was, at the time, employed by Mr. Thorsen, the sales representative for Day-Brite Lighting in Chicago and, it was one of my duties to attend and make the booth at this convention.

While making this booth, of course, during some of the off-peak periods, I visited the other displays in the convention area. In the Mitchell booth the unit that you have your hand on as the Mitchell unit, was displayed. It is my knowledge and, I was told that that was a handmade sample at that time, and, it was such an exact duplicate of the Day-Brite unit that if you had put a Day-Brite label on it, it could have been sold as such.

Q. What if anything—

Mr. Mullin: I will object, your Honor, to that statement. This man is offering an opinion. It is not a fact.

The Court: A little louder, please.

Mr. Mullin: I will object to that. This man is making a statement of opinion and not of fact. Let him just testify to the facts.

[fol. 71] The Court: Some of it may stand. What was done by him may be stricken because he is giving neither conversation nor has he indicated any personal knowledge—unless he gives it as an opinion.

Mr. Ooms: That is right.

The Court: Purely as an opinion.

Mr. Mullin: He has not identified who was there, which parties.

The Witness: I can identify them.

The Court: He can testify to any conversations. He doesn't have to.

By Mr. Ooms:

Q. Now, when you examined this particular reflector, was there anyone in the booth of the Mitchell Company?

A. Yes, sir.

Q. Do you know who it was?

A. Yes, sir.

Q. Who was it?

A. Mr. E. George Hiscos, one of my former associates.

Q. What, if anything, was said between the two of you relative to that particular fixture?

A. Well, he and I had certainly been friendly when we worked together and I came over to the booth and kidded him about this fixture being so similar to the Day-Brite fixture that was already on the market and, his statement was that if you have to copy, you might as well copy the best.

Q. Now, you are located in Peoria now, is that correct?

A. That is correct. I mean, I live in East Peoria.

Q. Did you have anything to do with a lighting fixture job at the American Brass Company in Mattoon?

A. Yes, sir.

[fol. 72] Q. What did you have to do with it?

A. Well, at the time that the job was under construction I was, at that time, working for Mr. Thorsen, and, it was one of my duties to handle the—attempt to sell the fixtures to the contractor for installation into this job.

Q. Now, was there a particular type of fixture specified for that job?

A. Yes, sir.

Q. What was it?

A. Day-Brite Lighting fixture, CFI-10.

Q. And were Day-Brite Lighting fixtures supplied to that job?

A. A smaller number were supplied to that job.

Q. Were other fixtures supplied to that job?

A. Yes, sir.

Q. Whose were they?

The Court: Is he testifying personally? Who supplied them? How does he know about it? You can't just put in conclusions.

Mr. Ooms: These are not conclusions, your Honor. I think the record will adequately show, as soon as I tie it up.

The Court: All right, if there isn't any objection.

Mr. Mullin: Well, I object. I think he should definitely state the facts instead of making statements of opinion and not bringing out the exact sales.

Mr. Ooms: I expect to tie it up, your Honor.

The Court: You can't do it that way.

Mr. Ooms: Your Honor, he has not offered any opinion yet.

The Court: He has testified that there were a few that were delivered. How does he know?

Mr. Ooms: That is exactly how I intend to substantiate it.

[fol. 73] The Court: Let us go ahead with it then. Let us find out how he knows.

By Mr. Ooms:

Q. How do you know only a few Day-Brite fixtures were delivered?

A. Because I wrote the order for them.

Q. How do you know other fixtures were supplied?

A. Because I visited the plant.

Q. And what fixtures were there?

A. Mitchell fixtures.

Q. Now, how long ago was this, Mr. Fernean?

A. How long ago was that?

Q. That the deliveries of these fixtures were made to the American Brass Company at Mattoon?

Mr. Mullin: I will object. Which fixtures are you talking about?

By Mr. Ooms:

Q. Either the Day-Brite or the Mitchell fixtures.

A. Well, it was at the time that they were preparing to install them in the plant.

Q. Was that several years ago?

A. Yes.

Q. Now, has anything happened within the past—

Mr. Mullin: I object. That is indefinite. Now, what date was it? You said "several years ago." It could mean seven, ten years ago.

The Court: I think so. I think he ought to specify.

By Mr. Ooms:

Q. If you know, to the best of your recollection, specify.

A. I can only say that it was after the introduction of the Mitchell unit onto the market, after this mentioned trade show. As to the exact date, I would have to go into [fol. 74] Mr. Thorsen's office and actually look, because I worked for him, and I would have to examine his files. I am sure that this date could be gotten.

Mr. Mullin: I will object because there has been no showing they were not sales made by the predecessor and not by the defendant.

Mr. Ooms: Your Honor, I am not trying to tie it up to that. I have no objection to his objecting to it.

The Court: It may be stricken.

By Mr. Ooms:

Q. Have you, within the past year or so, had occasion to visit the American Brass Company again?

A. Yes, sir.

Q. Can you give us the circumstances surrounding that?

A. My distributor, Central Wholesale of Matteon, contacted me after having been himself contacted by American Brass Company to service some defective fixtures installed at the American Brass Company in Mattoon.

Mr. Mullin: I will object to that. This is a third party. This is hearsay. If he was there and he testifies, if he knows of his own knowledge, then it is proper and he can testify to it.

The Court: He didn't testify to anything he did. You may proceed.

Mr. Ooms: That is right, your Honor.

By Mr. Ooms:

Q. Did you visit the plant?
A. Yes, sir.
Q. Did you receive any document asking that you visit the American Brass Company at Mattoon?
A. Yes, sir.
Q. I hand you a document dated 1/18/60 on a letter-[fol. 75] head or "Message Reply Memo" of Central Wholesale Supply Co., and ask whether that is the document.
A. Yes, it is.

Mr. Ooms: Will you please mark this as Plaintiff's Exhibit 13 for identification?

(The said document was thereupon marked Plaintiff's Exhibit 13 for identification.)

By Mr. Ooms:

Q. Will you kindly read that into the record, please?
A. The subject: "American Brass Company, Mattoon.

"Dear Ralph:

"The above plant about three years old has 573 Day-Brite fixtures, some of which are having socket failures. Please arrange for sufficient time to call on them when you are in Mattoon next and advise about when it will be so we can inform them."

It was signed Warren Kepp.

Q. Did you visit the plant as a result of this message?
A. I did.
Q. Did you find any 573 Day-Brite fixtures having trouble, or any such amount of Day-Brite fixtures?
A. No, sir.
Q. What did you find?
A. I found Mitchell fixtures with defective sockets.

Offer in Evidence

Mr. Ooms: I offer Plaintiff's Exhibit 13.
No further questions.
Mr. Mullin: I will object to the introduction of this.

I think this whole thing is irrelevant and immaterial to the question of patent infringement and validity.

The Court: I will let it go in.

(Said document, so offered and received in evidence, was marked Plaintiff's Exhibit 13.)

[fol. 76] Cross examination.

By Mr. Mullin:

Q. Mr. Ferneau, you are still employed by Day-Brite, are you?

A. I am a sales representative today for Day-Brite Lighting.

Q. You say you visited this plant, American Brass Company—what date was that?

A. It was a date following the receipt of this message.

Q. Do you recall what that date was?

A. It was approximately 30 days later.

Q. So that would be just recently, in 1960?

A. Yes, sir.

Q. Were these fixtures all installed?

A. Yes, sir.

Q. When you went in, what did you do?

A. Myself and the plant manager made a tour of this plant. He and I together examined these Mitchell fixtures.

Q. I see. And, you looked at these fixtures and you could see that some were Mitchell and some were Day-Brite or most of them were Mitchell?

A. If I may be allowed to tell how I know this, yes.

Q. Yes.

A. All right.

Q. So you walked in and you made—

A. May I be allowed to tell how I could tell the difference?

Q. Just answer my question.

A. May I be allowed to tell how I knew the difference?

Q. Oh, I will bring it out. You walked in with the plant manager?

A. Yes, sir.

Q. Is it a large plant?

A. Yes, sir.

[fol. 77] Q. And these fixtures, where are they? Are they in the ceiling?

A. These are suspended.

Q. Suspended from the ceiling?

A. Suspended from the ceiling, yes, sir.

Q. How far from the floor were they?

A. The Day-Brite fixtures were only about eight feet; the Mitchell fixtures were about 15 feet.

Q. Why is that? Does the Mitchell fixture throw more light?

A. The only explanation I can give is that the contractor, at the time of sale on this job was trying to confuse and deceive the owner into thinking that he had Day-Brite fixtures in the whole plant.

Mr. Kraus: That is objected to.

The Court: It may be stricken.

By Mr. Mullin:

Q. You say the Day-Brite fixtures were about eight feet?

A. Between eight and ten feet.

Q. The others were about twice as high?

A. That is correct.

Q. And you say that the American Brass Company identified them as Day-Brite fixtures?

A. That is correct.

Q. And the Day-Brite fixtures were the ones that were low down; the others were high up?

A. Well, one was mounted between eight and ten feet and the other at fifteen feet, approximately.

Q. About twice as high and they could see the Day-Brite fixtures below because they were just above the head? You say they were seven or eight feet?

A. They were so similar you can't tell the difference.

Q. I am not asking you that. They were mounted [fol. 78] low down so that anybody walking through could see these at eye level?

A. The gentleman who made this assessment was the

plant manager who had an opportunity to get up closer to them and look at them—not me.

Q. But, I mean, he sent you this note in which he said they had 573 Day-Brite fixtures. He walked through the plant and saw them low down?

A. That is not correct. He got up and looked at them.

Q. How do you know that he got up and looked at them?

A. Because he told me.

Q. When did he tell you this?

A. At the time I visited the plant.

Q. What, exactly, did he say?

A. He did exactly as I did. He got on the lift truck and looked at the fixtures.

Q. Oh, while you were there?

A. Yes, sir, and before then.

Q. Did he tell you at the time that he sent this that he had gotten up on a lift truck and looked at them?

A. Yes.

Q. He specifically stated that?

A. Yes.

Q. What is the name of the plant manager?

A. Mr. Dawson.

Q. What is his first name?

A. Charles Dawson.

Q. Charles Dawson?

A. Yes.

Q. Is he still the plant manager there?

A. I am sure he is.

Q. Was he able to notice the difference in the slots? These are long, narrow slots. These are wider slots here (indicating).

[fol. 79] A. Evidently not, sir.

Q. Did you notice that?

A. Certainly.

Q. Did he notice the difference in the—well, you say these were all installed. In other words, these fixtures looked like these, then, when they were installed (indicating)—they were the complete fixture, right?

A. That is correct.

Q. They weren't just the reflector?

A. That is correct.

Q. With the Day-Brite name listed here (indicating)?

A. That is correct.

Q. So that if this were hung up like this (illustrating), you could see the end plate, right?

A. Yes.

Q. With the "Day-Brite" on it?

A. Yes, that is correct.

Q. But, since these were up 15 feet, you couldn't see that?

A. You are asking me to draw a conclusion. I would say my own idea of this—if you would carry that 15 feet away, I could still tell the difference.

Q. If this were up 15 feet high?

A. If you would carry that 15 feet away, this is the testimony you are asking for—I can't tell the difference.

Q. You could tell the difference between fixtures?

A. Yes, sir.

Mr. Mullin: No more questions, your Honor.

The Witness: By the nameplate, that is. You could read the name on them 15 feet away, sir.

By Mr. Mullin:

Q. Now, you couldn't see, though, the top, this ballast [fol. 80] housing, you couldn't see that if it was on top, could you?

A. Not from the floor.

Q. Not from the floor?

A. No, although we did get up on a lift truck and look at them.

Q. Are there other manufacturers making fixtures which look similar to the Day-Brite fixtures at present?

A. I suppose there are some.

Q. Do you know the names of any of them?

A. No.

Q. Does Sylvania make a fixture similar to this?

A. Not having had an opportunity to study their product, I would not know.

Q. Does Guth make fixtures similar to this?

A. Not having had an opportunity to study their product, I would not know.

Q. The same with Miller, Curtiss, Albright, Benjamin. Do you know any of those?

A. No, sir.

Q. You do know there are other manufacturers who make similar industrial fixtures?

A. Industrial.

Q. Industrial. That's all we are talking about.

A. Yes.

Mr. Mullin: That's all.

Redirect examination.

By Mr. Ooms:

Q. Mr. Ferneau, where were the Day-Brite industrial units located at this plant?

A. They were in the industrial portion of the plant, in manufacturing areas.

Q. Where were the Mitchells located?

A. Excuse me. I am sorry. I did not hear you.

[fol. 81] Q. Where were the Day-Brite fixtures located?

A. In the cafeteria. I am sorry. I misunderstood.

Q. In the cafeteria?

A. Yes, sir.

Q. And that had a low ceiling?

A. Yes.

Q. Where were the Mitchell fixtures located?

A. In the industrial area.

Q. That had a ceiling, approximately how tall?

A. Twenty-two, twenty-three feet.

Q. Do not fixtures, when mounted in industrial areas, run end to end in continuous lines?

A. Yes, sir.

Q. So that you couldn't see any name cap on the end because they don't have any, is that correct?

A. Just at the ends of the rows.

Mr. Ooms: No further questions.

Recross examination.

By Mr. Mullin:

Q. Just one question on recross.

By Mr. Mullin:

Q. What date did you say this job was in the American Brass? What was the date when they were installed, the fixtures?

A. I said that I did not know the exact date, sir.

Q. Within a year. Was it in 1954, 1955?

A. It would be difficult for me to give you an accurate date without having an opportunity to check on this.

Q. Didn't you check on this when you called down there to take a look at these fixtures?

A. I have, no longer, access to these files.

Q. At the time you called on them in answer to this inquiry, you didn't check?

A. No, sir. I had no opportunity to check the files.

Q. Wouldn't it be wise to check? Wouldn't it be the ordi-
[fol. 82] nary and usual procedure to check when they were installed, if there were complaints so you would know how long they had been there?

A. I had no access to these files, sir.

Q. And the information was never given to you?

A. No, sir.

Q. And you never requested it?

A. No, sir.

Mr. Mullin: That's all.

(Witness excused.)

The Court: Call your next witness.

Mr. Ooms: Mr. Ferneau, you may step down. Thank you.

Mr. Ooms: Mr. Humphreville.

Since there is no objection, I assume it is received.

The Court: It may be received. I think there was an objection and I overruled it.

Mr. Ooms: Thank you.

(Said document, so offered and received in evidence, was marked Plaintiff's Exhibit 13.)

Mr. Ooms: Since Mr. Humphreville and I have not had an opportunity to confer, my partner, Mr. Bradway, would like to conduct the inquiry.

THOMAS HUMPHREVILLE, called as a witness on behalf of the Plaintiff, having been first duly sworn, was examined and testified as follows:

Direct examination.

By Mr. Bradway.

Q. Will you please state your name?
A. Thomas Humphreville.

[fol. 83] The Reporter: Will you please spell your last name?
The Witness: H-u-m-p-h-r-e-v-i-l-l-e.

By Mr. Bradway:

Q. And your address?
A. 23305 Lincolnshire Drive.
Q. Could you tell us something about your present occupation?

Mr. Mullin: Of where?
The Witness: Bay Village.
Mr. Mullin: Where?
The Reporter: Bay Village.

By the Witness:

A. At the present time I am employed by the Westinghouse Electric Corporation in the Lighting Division. I am manager of interior lighting engineering.

By Mr. Bradway:

Q. Do you have occasion to supervise a number of people in that capacity?

A. In my capacity, I have approximately eight design engineers, one industrial designer. Our responsibility is for the design of the line of commercial and industrial fluorescent equipment which is manufactured and marketed by Westinghouse, as well as our industrial and incandescent equipment that is entitled "Interior Lighting," lighting used for inside, except residential types. This market, we are not in.

Q. Did I understand you, then, to say you were in the business of marketing industrial and commercial lighting fixtures?

A. Yes, sir.

Q. You mentioned industrial styling. What does that embrace?

A. We have on our staff, full time, an industrial designer, whose function is to contribute to the appearance and thus the styling of our complete line of equipment, in-
[fol. 84] dustrial as well as commercial lighting.

Q. Would it be a true statement, then, that Westinghouse believes in the importance of appearance of products also?

A. Very definitely.

Q. Has this always been true of Westinghouse?

A. Since I have been associated with the company in a responsible position, we have been striving for the product identity, to come up with unique features to achieve acceptability on the market place. This can be done through appearance and the styling of lighting equipment. It can be done by building mechanical and electrical features into lighting equipment. We attempt to do the whole job.

Q. I may have missed this in your earlier testimony, but did you testify as to how long you have been associated with Westinghouse and the lighting industry?

A. I have been with Westinghouse in the lighting division approximately eleven and a half years.

Q. Now, as manager of that department at Westinghouse, did you have occasion to follow competitors' activities?

A. This I attempt to do all the time, although, as I earlier mentioned, there are so many competitors that I

don't pretend that I follow all of them, but, I try to follow the largest, the ones who handle nationally, who market nationally, as we market nationally.

Q. Would you care to mention some of those competitors?

A. We watch the Day-Brite Company, Miller, Guth, Lithonia, Albright, Curtiss, Smutt, Holman. This is a group that we are concerned with. This is not all of them, by any manner or means.

[fol. 85] Q. Are you familiar with the lighting fixtures known as the CFI-10 fixture of Day-Brite Lighting Company?

A. Yes, I am.

Q. I will show you the physical embodiment of Plaintiff's Exhibit 4 and ask you if you can tell me what that is.

A. Looking at it from the side, I would say it is the Day-Brite design.

Q. The Day-Brite CFI-10?

A. The CFI-10.

Q. Will you tell us when you became aware of that particular reflector?

A. Well, aside from the publications, the first time I physically saw such a reflector was some time in 1956. I would say it was in the middle of the year.

Q. Did you have any particular reaction at that particular time, as a competitor of Day-Brite's?

A. Yes.

Mr. Mullin: I object to this line of questioning as leading the witness. He is telling him what to say. He is leading him.

Mr. Bradway: Your Honor, I am not telling him. I am not leading him.

The Court: He may answer. It is not leading.

The Witness: My reaction was that bringing the ribs completely down the side was unnecessary and it appeared to me that they had gone to extra effort in tooling to do this. I did not see any particular reason why it should be done.

By Mr. Bradway:

Q. Did you subsequently change your mind on that?

A. Yes. It became apparent, as time developed, with the appearance and specifications of certain wordologies which I would like to use—and, this is not precise or exact—it is chiefly ribbing reflector, embossed apertures, in [fol. 86] describing the reflector part of the equipment. Then reading the rest of the specification, it was, in my opinion, this specification was written around the Day-Brite equipment.

Now, our equipment is ribbed, but, for some reason, this didn't seem to meet the story. Checking into this, we got answers from electrical contractors—not contractors, electrical engineers.

Mr. Mullin: I object, your Honor. He is not responding to the question.

The Court: The objection is sustained.

By Mr. Bradway:

Q. Well, was it your feeling at that time, or could you tell us whether or not it was your feeling at that time that these specifications were written to specify CFI-10 fixtures?

Mr. Mullin: I object to his testifying to his feelings. What has that got to do with this?

The Court: The objection is sustained.

Mr. Bradway: I believe he has got a right to—

By Mr. Bradway:

Q. Now, following this 1956 period, could you tell us if Westinghouse did anything with respect to fixture designs of their own?

A. We have constantly been bringing out new fixture designs. We realized perhaps in 1958 that the industrial line of fluorescent equipment that we were marketing had been in existence for about seven to eight years and was pretty much as it was. We, therefore, decided that it was time to bring out a new line of industrial fluorescent equipment.

Doing some market research, some studies with our own people, we deduced that with the advent of the upright, the lower mounting heights, the total package and trying [fol. 87] to get a better working environment in factories, that now the styling, the appearance of industrial equipment was more important in 1958 than it was in 1950.

We, therefore, worked out an appearance design first into this new industrial line and, within the past few months, a patent, a design patent has been issued to our industrial designer assigned to the Westinghouse Company.

Mr. Kraus: Your Honor, that has nothing to do with this case. We are not in a suit with Westinghouse.

The Court: The objection is sustained.

Mr. Bradway: Your Honor, I would just like to say here, if you are interested in considering the validity of this patent and the importance of it, here we have a competitor who does a very vigorous patent—

The Court: I can't try a patent issued in 1958.

Mr. Bradway: We don't propose to try it, your Honor.

The Court: It hasn't any bearing on this case.

By Mr. Bradway:

Q. Are you familiar with a fixture known as the Mitchell Dynalite fixture?

A. Yes.

Q. I will show you a physical embodiment of a reflector identified here as Plaintiff's Exhibit 5. Can you tell me what that is?

A. This is the Mitchell unit you have described.

Q. Have you inspected that closely to see exactly what it is like?

A. Yes.

Q. Now, when you first saw this Day-Brite CFI-10 reflector, could you tell us if you had any impression with regard to whether it was new or not or how similar it was to other reflectors or fixtures on the market?

[fol. 88] Mr. Mullin: I object to that. He is asking for an impression. Let the witness testify to what he sees are the facts, not impressions.

Mr. Bradway: Your Honor, I think this witness is entitled to give an opinion as to that. He is a man thoroughly familiar with his field.

The Court: By any other name, it is the same. He may answer.

By the Witness:

A. It was certainly different than anything I had seen in the field previously. As I mentioned earlier in my testimony, I did not understand the ribs coming all the way down as far as they did. This was the first time I, personally, had seen this type of thing. This was different than what I had seen before.

Q. Do you think that purchasers of these fixtures might be likely to be confused by the sale of these Mitchell fixtures here (indicating) with the Day-Brite CFI-10 fixture?

Mr. Mullin: I object to that, your Honor. This man is not in a position to—

The Court: Let him answer. He is an expert.

Mr. Mullin: He is an expert but not on the question as to whether or not the purchasers were confused.

The Court: He was supposed to watch all the competitors' products. I will let him answer.

By the Witness:

A. This answer I must qualify. I would say that the consulting people and the contractors who handle and use this equipment daily, by a minute inspection, can tell the difference. The latch is different. If you turned it around this way (illustrating) you could immediately pick out the Day-Brite and the Mitchell by the latch they use. [fol. 89] Perhaps getting the total impression you get from the side of the reflector, there is a definite similarity. I would say they appear the same. It would depend on whether the person looked at it knowing the equipment or whether it was the plant manager, as I described earlier. They would look similar to him, in my opinion.

By Mr. Bradway:

Q. Could you tell us if Westinghouse makes any reflectors for lighting fixtures that are similar in appearance to the Day-Brite CFI-10?

A. No, sir.

Q. The CFI-10 which was identified as Plaintiff's Exhibit 4?

A. No, sir.

Q. Will you tell us why not?

A. We are in business to make money for Westinghouse. I do this by marketing our fixtures; not by marketing one of my competitor's fixtures. I achieve no product identification by marketing somebody else's type.

Mr. Mullin: I object to that answer.

The Court: The objection is sustained.

By Mr. Bradway:

Q. Well, when you see the appearance of this CFI-10 reflector, which is Plaintiff's Exhibit 4, does it mean any thing to you, the appearance, as such?

A. Yes. Again, this is looking at, trying to look at it through the eyes of my industrial designer. In looking at the side view of this, there is, I believe they called the word rhythm, of a flat and then a dip, of a flat and then a dip, which identifies it, and this is due to the ribs.

Q. What does that identify?

A. To my mind, it identifies the Day-Brite CFI-10, since this was the first one I saw of this type.

Mr. Bradway: May I have a moment, your Honor?

No further questions on direct, your Honor.

[fol. 90] Cross examination.

By Mr. Mullin:

Q. Mr. Humphreville, how many people are making reflectors with ribs today, industrial reflectors of this type?

A. Excuse me. You say with ribs?

Q. With these ribs here, ribs like this (indicating), ribs

going into the sides of the reflectors so that you would see them when you looked at it from the side, as you put it?

A. I would say at least a half a dozen.

Q. At least a half a dozen, and, when you look at this reflector from the bottom, can you identify the difference?

A. Yes.

Q. Between the two reflectors, I am referring to.

A. Yes. You are trying to hide the latch so I can't see the latch.

Q. Remember that these reflectors are always assembled with the ballast housing, are they not, when they are in actual use?

A. Yes, sir.

Q. They are never sold apart from the ballast housing, isn't that true?

A. That is true.

Q. It is always this reflector you are looking at there (indicating). Comparing these two, you would be looking at fixtures which look like this fully assembled (indicating)?

The Court: You ought to identify them. You can't say "like this."

Mr. Mullin: All right. Let us identify it. In the stipulation, your Honor, I think it is identified as—well, it isn't identified in this, but, for the sake of identification, will the Reporter mark this Day-Brite complete fixture as Defendant's Exhibit NN.

[fol. 91] (The article was thereupon marked Defendant's Exhibit NN for identification.)

Mr. Mullin: I am referring to the Mitchell complete Dynalite fixture, now, which I will have marked as the next number, OO.

(The article was thereupon marked Defendant's Exhibit OO for identification.)

By Mr. Mullin:

Q. So, now, referring the witness to these two fixtures, NN and OO, is this not the way in which there are dis-

played in use in the factory or when they are purchased or at any time?

A. This is the way they are used. This is the way they are operated.

Q. They are always assembled this way?

A. This is the way they are operated.

Q. When the consumer purchases, doesn't he purchase this entire assembly?

A. He purchases the entire assembly.

Q. And that is called the fixture?

A. Yes, sir.

Q. They never sell the reflectors apart from the complete fixture, is that right?

A. Aside from the replacement parts.

Q. Aside from the replacement parts?

A. Aside from replacement parts.

Q. When they are purchased and before they are mounted or in operational position then this is the way they would look from the top view?

A. Yes.

Q. I am referring now to both NN and OO. So, that it would be not difficult at all to tell the difference between these?

[fol. 92] A. No.

Mr. Mullin: The answer is "No."

By Mr. Mullin:

Q. Isn't it a fact that these slots—and I am now referring to Plaintiff's Exhibits 5 and 4—that these uplight slots are quite prominent in the picture?

A. Yes, sir.

Q. In fact, you were able to tell, sitting from where you are and just pointing to this distance, the distance of about, oh, 12 feet or so, the difference, immediately—you could select the two. Would a purchaser be able to tell that by looking at these two?

Mr. Bradway: Your Honor, I believe he should qualify that to some extent in terms of the class of purchaser. I believe there was testimony—

Mr. Mullin: The class who purchased these reflectors?

Mr. Bradway: I believe he qualified his answer along that line on direct.

The Court: He may answer.

By the Witness:

A. May I ask, are you talking now of the person who ultimately uses this or the person who specifies this?

By Mr. Mullin:

Q. Whoever purchases these. Who purchases these?

A. Well, when you purchase them from Westinghouse, a distributor purchases them.

Q. Yes. All right.

A. When they go into a building, a contractor purchases from a distributor.

Q. All right.

A. The customer purchases from the contractor.

Q. All right. Is the contractor able to tell the differ-
[fol. 93] ence?

A. Yes.

Q. And the contractor specifies and they put it in, is that right? He specifies and then the ultimate consumer purchases based on his specifications?

A. Well, let's use the word "recommendation" in the case of a contractor.

Q. Well, all right.

A. This is right.

Q. So that the class of purchasers is a fairly selective one and they are able to comprehend without much difficulty the differences between these reflectors, is that right?

A. Yes.

Q. Have you ever examined—well, cross that out, please. Does Westinghouse now make a fixture with cross ribs, an industrial fixture with cross ribs?

A. Are you using your definition of ribs that come all the way down to the bottom?

Q. Well, any ribs.

A. We make an industrial fluorescent fixture with ribs, yes, sir.

Q. With ribs that go across?
A. Yes.

Mr. Mullin: Mark this Defendant's Exhibit LL for identification.

(The document was thereupon marked Defendant's Exhibit II for identification.)

Mr. Mullin: Your Honor, this morning I showed you the original catalog of the Westinghouse Company. This is merely a blow-up.

The Court: Have it marked.

Mr. Mullin: It is marked LL, Defendant's Exhibit LL for identification.

By Mr. Mullin:

[fol. 94] Q. Do you recognize that? (Indicating.)
A. Yes, sir.
Q. Is that a fixture that Westinghouse made?
A. It still makes it.
Q. It still makes it? When did you start making that fixture?
A. Oh, it was the latter part of 1952 or early 1953. I believe the tools were finished in December of '52.
Q. December of '52? Does that have any embossed ribs?
A. On the top portion of the panel? Yes. There are six of them on this particular one, or seven.
Q. And does it also show these uplight slots?
A. Yes, uplights.
Q. And do the ribs extend between each pair of slots?
A. Yes.
Q. Excuse me, let me take that. That is, just as the ribs do across the top in the Plaintiff's Exhibit 4 for identification?
A. If you only limit my scope to across the top, yes, the same.
Q. Yes; they extend across the top between each pair of slots the same as this, right?
A. Yes.
Q. Why are those ribs put into the fixture, do you know?

A. The portion on the flat of the reflector, the top portion from about where your thumb is across to the same portion on the other side, this is done so that the whole top of the reflector will be solid. If it does not it will have a tendency to warp and not maintain its position.

Q. So the function of those ribs is to strengthen and to prevent it from warping?

A. Yes.

[fol. 95] Q. That is correct?

A. Yes, sir.

Q. You are familiar, are you, with the Guth industrial lighting fixtures, the Quick-liter and the Mazelite?

A. Just on the fringe. I would not say I am as familiar with them as I am the others.

Mr. Bradway: Your Honor, I believe this exceeds the scope of the direct examination.

The Court: What?

Mr. Bradway: I believe this exceeds the scope of the direct examination. He did not testify as to anything about—

The Court: The scope of the direct? Similarity is in direct issue and he is your expert.

Mr. Bradway: He is talking about a specific catalog here but he did not say anything about it on direct.

The Court: Anything that will reflect his judgment on similarity is admissible.

Mr. Mullin: Will you mark this Defendant's Exhibit E for identification.

(The document was thereupon marked Defendant's Exhibit E for identification.)

By Mr. Mullin:

Q. I hand you a Guth No. 44 catalog—

Mr. Mullin: The copyright date is 1944.

By Mr. Mullin:

Q. I direct your attention to pages 31 and 32.

The Court: Is that marked for identification?

Mr. Mullin: Yes, it is marked for identification as Defendant's Exhibit E.

By Mr. Mullin:

Q. I ask you if those are the Guth reflectors that you are familiar with?

A. They don't look the same as the ones I see now.

[fol. 96] Q. The ones you see now? But had you ever seen any like that?

A. Not to my knowledge.

Q. What is the difference between the ones you see now and the ones that are shown in that 1944 catalog?

The Court: Well, I would sustain an objection to that.

Mr. Bradway: Then I would object, your Honor.

The Court: I don't know what the purpose of it is.

Mr. Mullin: He testified that they are not the same as the ones he sees now.

The Court: He said he was not familiar with it, just on a fringe. He can't testify on the fringe.

Mr. Mullin: I am asking him what he knows. If he does not know, let him testify he does not know.

The Court: He says he never saw them.

The Witness: That is what I said.

By Mr. Mullin:

Q. You never saw these particular fixtures?

A. To my knowledge, I have not.

Q. All right. Have you seen this type of a fixture? (Indicating.)

The Court: Referring to what now?

Mr. Mullin: I am sorry—

By Mr. Mullin:

Q. Referring to Plaintiff's Exhibit 6 for identification?

A. Well, some time some years ago I have.

Q. Some years ago?

A. Yes. I could not tell you when. It would be in the early fifties.

Q. But you are familiar with the present Guth fixtures?

A. I believe I could identify them, yes.

[fol. 97] Q. And could you tell me whether those fixtures have ribs extending down into the sides?

A. Yes, sir.

Q. Would you say that they extend more or less than the ribs shown here? (Indicating.) I am pointing now again to Plaintiff's Exhibit 6 for identification.

A. I would say they extend further down.

Q. Extend further down?

A. Yes.

Q. But would you say that these extend down into the sides?

A. Yes.

Q. Do you know what the purpose is of extending the ribs down into the sides on any fixture?

The Court: Well, hasn't he answered that already?

Mr. Mullin: Well, he has testified that the ribs are functional, yes. Well, all right, I will withdraw the question.

Mr. Bradway: Your Honor, I do not believe he so testified. I think the record ought to be clear that he was talking about the little rib portion right across the top of the reflector.

The Court: You can take him again on redirect. Are you all through, counsel?

Mr. Mullin: Yes, I am through, your Honor. Thank you.

Mr. Bradway: Just a few questions, your Honor.

Redirect examination.

By Mr. Bradway:

Q. Mr. Humphreville, looking at this Guth fixture, which has been marked as Plaintiff's Exhibit 6, would you say that that is a different over-all appearance than Plaintiff's Exhibit 4 here, which is the CFI-10 reflector?

A. Yes.

[fol. 98] Q. In answering that I would like you to neglect this housing on top of the reflector. (Indicating.)

Mr. Mullin: Your Honor, I will object to that. The exhibits are here, the Court can judge for himself the difference or the similarity.

Mr. Bradway: Your Honor, I believe a person skilled—
The Court: I believe he has answered it.

By Mr. Bradway:

Q. Mr. Humphreville, I believe counsel for Defendant referred you to an exhibit which he identified as Defendant's Exhibit LL, which is a catalog illustration of a Westinghouse fixture. I would like you to look at that and tell us whether or not you believe that that has a different over-all appearance from the appearance of Plaintiff's Exhibit 4, which is the reflector, Day-Brite CFI-10.

A. Yes, I believe it does.

Q. Mr. Humphreville, I believe counsel for the Defendant also asked you some questions about Defendant's Exhibit NN and OO. Do you think that a purchaser of these completed reflectors upon, say, seeing a Day-Brite fixture, which is Defendant's Exhibit OO, and then two weeks later seeing the Mitchell completed fixture, which is Defendant's Exhibit LL, might be confused and believe that this Mitchell fixture, Exhibit OO, was the same thing as the Day-Brite, which is NN?

Mr. Kraus: I think that is objectionable, your Honor.

Mr. Bradway: Your Honor, I believe he asked him some questions on that subject on cross examination. He brought these two fixtures into this case.

Mr. Kraus: He has answered already that he knows that there are differences and there is no confusion in his mind. He has already testified to that. As to what [fol. 99] is in the mind of a purchaser, he is in no position to know.

The Court: He may answer.

Mr. Bradway: I beg your pardon?

The Court: He may answer.

By Mr. Bradway:

Q. You may answer.

A. With the previous qualification of purchasers, as to types, some of them would not see a difference when you look at it overall, not just from the top, but looking from

the sides, and the bottom, other purchasers, I am sure, even after a few weeks could tell the difference. I could tell the difference after two or three weeks.

Q. Then you think there are purchasers that might be confused between the two?

A. I believe there might be, sir.

Q. All right. Now, Mr. Humphreville, in your employment capacity—you are a design engineer, I take it?

A. Yes.

Q. Are you used to looking at real small differences in things? For example, dimensional differences?

A. Well, in this field of design it is sometimes the small details that make or break a total design, whether the detail be an appearance detail or a mechanical detail.

Q. Are you used to looking at a fixture, for example, and picking out some little hole or a line somewhere that you know means some particular thing and which might not be noticeable by somebody else?

A. Yes. This is what I do in competitive analysis, try to pick the flaws in my competitive fixtures for use by our sales people, or what we feel are flaws—I should qualify it that way.

[fol. 100] Mr. Bradway: May I have a moment, your Honor?

The Court: All right.

(Co-counsel conferring.)

Mr. Bradway: No further questions, your Honor.

Mr. Mullin: May I ask a few more questions?

The Court: All right.

Recross examination.

By Mr. Mullin:

Q. Then it is your testimony, as I understand it, that it is this portion of the ribs extending down into the sides which is not present in the CFI Day-Line—and the CFI Day-Line is the prior fixture which was made by the Day-Brite long before this one—

A. Yes.

Q. Is it your testimony then that it is this portion of the rib, this part that extends down into the side, that distinguishes? Is that right?

A. Only insofar as this contributes to what I see when I look at the total fixture.

Q. That is what I am talking about, what you see when you look at the total fixture.

A. When I look at the total fixture I am aware of these gashes, if you will.

Q. You are aware of these end portions of the ribs going down into the sides? (Indicating)

A. Yes, all the way down the sides.

Q. Yes; so that in all other respects the fixture is similar to what you know about the prior art?

A. Yes.

Mr. Mullin: That is all, your Honor.

The Court: You are excused.

(Witness excused.)

[fol. 101] The Court: Call your next witness.

Mr. Ooms: Your Honor, I have two more witnesses but I am going to read several short depositions into the record, and I know I will not get through by 4:30 with either of the witnesses and probably not even until a quarter to five on direct. So if the Court would like, I would begin reading these depositions into the record now.

The Court: All right. I will give you fifteen minutes.

Mr. Ooms: Thank you. In order to make this as realistic as possible, I will ask the question and put one co-counsel on to read the answer.

The Court: I am used to it. It is not realistic but it is the best you can do.

Mr. Ooms: That is the best you can do under the circumstances if you have to read depositions. This will be the depositions of Ralph Hodges and Ivan Samuel Meyer, taken before a notary public in the County of Randolph and State on May 25, 1960, pursuant to notice by the plaintiff.

Mr. Mullin: Your Honor, if you like, in order to save time, we will stipulate that this may be admitted.

Mr. Ooms: Thank you, Counsel, but I think it would be very helpful if the Court heard this rather than reading it, and, besides, I think it would be helpful to everyone.

The Court: All right.

DEPOSITION OF RALPH HODGES READ INTO RECORD

(Thereupon the deposition of Ralph Hodges was read in open Court, with Mr. Ooms reading the questions and his co-counsel, Mr. Woodruff, reading the answers, as follows:

"RALPH HODGES, having been first duly sworn, testified and deposed as follows:

[fol. 102] Direct examination.

By Mr. Naylor:

Q. Mr. Hodges, would you please state your full name, residence and occupation?

A. Ralph Hodges, 4824 West Main Street, Belleville, Illinois, registered professional engineer in the mechanical field.

Q. For what period of time, sir, have you been a registered professional engineer?

A. Since about 1947.

Q. And have you acted in that capacity continuously since that time?

A. Yes.

Q. Prior to 1947 had you had any experience in engineering subjects of any kind?

A. I had done quite a bit of studying in engineering, and I had started to work as a tool engineer and designer for Century Electric Company in about 1935; and up until the end of 1944 I had worked for Century, St. Louis Car Company, Carter Carburetor Corporation and Dressel-Betz Tool and Die Company in Belleville. At the first part of 1945 I opened up a tool designing and engineering office.

Q. Is that conducted here in Belleville?

A. Yes, sir, at the same address given before.

Q. Since you say you opened your office, I assume you have proceeded on an independent or consulting basis; is that correct?

A. Yes, for the last fifteen years I have been an independent consultant.

Q. What categories of clients have you served since you opened your own office?

A. Mostly in the manufacturing industries, the stove companies in Belleville and St. Louis, the tool and die companies and electric companies, The few, maybe, repre- [fol. 103] sentative companies would be Empire Stove Company here in Belleville, Carter Carburetor, Anheuser-Busch, Monsanto Chemical, Day-Brite Lighting, O'Fallon Tool and Die. There are a great many more, but those would be representative types of companies.

Q. You mentioned Day-Brite. Is that Day-Brite Lighting, Inc., of St. Louis, Missouri?

A. Yes.

Q. You mentioned O'Fallon. Would you give us the full name and address of that concern?

A. O'Fallon Tool and Die Company, O'Fallon, Illinois.

Q. Starting back in the year 1935, will you tell us something of the experience that you have had as a tool designer or tool engineer?

A. Well, at the beginning it was the designing of dies for specific products in the electrical field and to follow up on those dies to see that they functioned in the presses. Then there was the designing of superstructures for streamlined trains and P.C.C. cars, streamlined front; street cars. Then at Carter Carburetor I went to work almost from the beginning on war work. In 1939 they had an order from the French Government for six million 75-millimeter fuses which they were making in about two minutes each; and I had tooled it up to make it in three seconds each on automatic machines. From then on automatic tooling at Carter. I tooled some of their machines for Buick carburetors at the same time they were making the French 75's. Then after we converted for war work I tooled them for the M-51 fuses and the airborne bomb fuses. Then at Dresel-Betz I designed a general run of dies and special machines for

stove parts and chemical warfare, bombs, tanks and smoke tanks, things of that order.

[fol. 104] Q. You mentioned that your work in this period of time you are speaking of consisted of tool designing, and 'follow up' I think is the expression you used. Would you tell us what you mean by follow up?

A. Well, when you design a tool somebody builds it; so you don't have too much control of that, except that they follow the drawing. But then the tool is delivered and has to perform the function for which it is designed. Depending on how special or how new a design that tool is would depend on how much follow up, how much I continue on with the tool to operate the tool or machine in the plant to see that it does produce what it was designed to produce.

Q. Would that involve personal operation of a machine by you in some instances?

A. Yes. Also, personal work on the tool itself at times in alteration, or supervising somebody else's operation of the tool.

Q. Alteration of the tool, would you give us what you mean by that, so that the Court will have an understanding of what you mean by alteration of the tool?

A. Well, that depends on the complications. If it happened to be an automatic drilling machine, alteration might be adjusting, shimming up somewhere, making some changes in holding a clamp, or making some change to make the tool easier for the operator to load or unload. If it happens to be a die, especially a forming die, one of the things that happens in the adjustments is that you round off some portion of the dies that is not performing the part as it should, to change the contour slightly.

Q. Would that entail grinding or polishing in some instances?

A. Grinding or polishing.

[fol. 105] Q. Directing your attention to the year 1953, I would like to ask you if you were engaged in doing any work with respect to a Day-Brite light fixture reflector?

A. Yes.

Q. I note that you are referring to a record of some kind. Would you tell us what the record you are referring to is?

A. I have a card record for accounts for time and billing to O'Fallon Tool and Die Company for designing of a form die for a proposed CFI reflector.

Q. And what does CFI reflector mean to you? What identification does it provide?

A. Well, it identifies with this drawing (Indicating).

Q. And you are directing my attention, are you to Defendant's Exhibit No. 11 on the Stahlhut deposition, which is a drawing dated June 19, 1953?

A. Yes.

Q. Now, do your records indicate that you were contacted on the date that you have supplied from your card record?

A. The record indicates the day I started to work on it.

Q. You actually started to work on it?

A. Started to work on it. It does not indicate the day I was contacted.

Q. Will you tell us by whom you were contacted or by whom you were engaged for this particular assignment.

A. O'Fallon Tool and Die Company.

Q. O'Fallon Tool and Die Company?

A. Yes. I think that went in before when I read the card.

Q. Were you supplied starting information of any kind for this project?

[fol. 106] A. I had this print.

Q. You are referring again to Defendant's Exhibit No. 11, are you?

A. That is correct. Also, I had information regarding the dimensions of the press.

Q. In which the tool was to be used?

A. Yes, in which the tool was to be used.

Q. Pursuant to that which you indicated and with that information, will you tell us what you did?

A. What I did, I proceeded to make the drawings of which we have prints. We don't have all the prints. We have two. It says three sheets. But we do have in these exhibits a portion of the drawing which I made.

Q. You are directing attention now, are you Mr. Hodges, to Defendant's Exhibit No. 12 and 12-A on the Stahlhut deposition?

A. Yes.

Q. Do you identify those prints as prints of drawings actually executed by you personally?

A. Yes.

Q. How do you so identify them?

A. I have my name here on this corner and my name in the upper corner, and also from my memory I know what my drawings look like.

Q. So you have three means of identification; is that correct?

A. Yes.

Q. Now, once you did make the tool drawings, of which Defendant's Exhibits 12 and 12-A are a part what did you do next, if anything, for O'Fallon Tool and Die works on this particular assignment?

A. There is no record that I did anything else for O'Fallon Tool and Die.

Q. There is not?

[fol. 107] A. No doubt while I was working on other assignments for O'Fallon Tool and Die I also looked at this job. Naturally, when I went there I would look at it, but I wouldn't have a record, because I would be charging time for a consultation on some other job, and I would not divide it up in so many minutes on this and so many minutes on that. So I have no other record of anything else besides furnishing them this drawing.

Q. That was going to be my next question. Did you personally furnish O'Fallon Tool and Die Company the drawings of which Defendant's Exhibits Nos. 12 and 12-A are a part?

A. Yes, I furnished them with the tracings for this.

Q. Is it your understanding that they then proceeded with the actual construction of the tool that was depicted on your drawings?

A. Yes.

Q. Did you observe it in process?

A. Once or twice.

Q. Now, did you have anything further to do, Mr. Hodges, with the completion of the die or the tool for either O'Fallon or anybody else after you had furnished O'Fallon with the drawings we spoke of?

A. No. Somebody else took care of that. They took the die and went with it to Tupelo, Mississippi, to try it out, but I was not contacted on this.

Q. You were not what?

A. I was not contacted at that time. I was contacted by Day-Brite in March, 1954, to go to Tupelo, and at that time I did look at the die. It was completed, and a great many alterations had been made from the way I had originally laid it out before I got there to see it.

Q. You speak of Tupelo. Would you identify what you mean by Tupelo?

[fol. 108] A. Day-Brite had a plant in Tupelo, Mississippi.

Q. And were you there personally at Tupelo?

A. Yes.

Q. Were you there at Day-Brite's request?

A. Yes.

Q. Did the Day-Brite request embrace any follow up work on the drawings you had made for this particular fixture?

A. You say drawings?

Q. Yes.

A. No.

Q. Maybe my question was not clear.

A. There was a follow up on the tool itself.

Q. That is what I meant.

A. But not on the drawing.

Q. The question may not have been clear to you. My question was: Were you there at Day-Brite's request on the follow up work on the tool which you had drawn? That was the tentative question.

A. Yes.

Q. Is it now clear to you?

A. Yes.

Q. Would you have any record that would indicate the time that was spent by you at the Tupelo plant of Day-Brite?

A. Yes.

Q. Will you give us an indication of what the dates were?

A. I was there from March 8, 1954, to March 11, 1954, inclusive.

Q. And were you there any additional times?

A. Yes.

Q. Will you indicate the total times?

A. June 14 and 15, 1954. August 9 and 10, 1954. September 12—no, September 13 and 14, 1954.

[fol. 109] Q. That was a correction when you said the 12th, because the 13th was my birthday, and that date stuck in my mind?

A. Yes.

Q. As you observed the tool at Tupelo was it installed in a press or machine of any kind?

A. We put it in the press after I got there.

Q. And did you then do what you have previously described as follow up work with respect to the tool?

A. Yes.

Q. Will you tell us what occurred in that connection?

A. Well, I tried to make some parts on this particular die and press, trying different pressures; and then it was a matter of removing the die pressure ring and changing the length of pressure pins, cutting off pressure pins which hold up the pressure ring which supplies the grip, in order to get the pressure ring down to a point where the product forms around the parts without stretching; so that it was almost completely formed and then stretched for a final one-eighth of an inch to try to set the metal so it didn't bow from end to end.

Q. Do I gather from what you say, Mr. Hodges, that the first attempt was not completely successful in producing the part?

A. The part was produced in one piece, I will say that, but it was bowed from end to end considerably. When you looked down the eight-foot length, the side flanges or gutters were not straight. They were curved. And our drawing indicates they should be straight; so I was making an attempt to make them straight by making adjustments in the press, not by changing the tool."

The Court: How much more have you on this?

Mr. Ooms: I have about fifteen or twenty minutes.

The Court: All right, then we will recess until ten o'clock tomorrow morning.

[fol. 110] (Whereupon the trial of the above-entitled cause was adjourned until 10:00 o'clock a.m. of the following day, Tuesday, October 4, 1960.)

* * * * * * *

Tuesday, October 4, 1960,
10:00 o'clock, a.m.

Court convened pursuant to adjournment.

* * * * * * *

(And thereupon the following further proceedings were had herein:)

The Clerk: No. 58 C 1300, Day-Brite Lighting, Inc., vs. Compco Corporation, on trial.

Mr. Ooms: Your Honor, I did give to your Clerk that stipulation we talked about that the court reporter had heretofore.

Mr. Mullin: Your Honor, I want to apologize. I did not realize we were keeping you waiting.

(Thereupon Plaintiff's Exhibits Nos. 13 through 23 were remarked Plaintiff's Exhibits 14 through 24.)

Mr. Ooms: Your Honor, in the interest of further shortening the time here, we have cut down on portions of [fol. 111] the reading of the deposition and we left off on Page 1. We would like to continue on Page 15.

Counsel, of course, has the right, under Rule 27(d) to put in anything he wants.

Beginning at the top of Page 15:

(Thereupon Mr. Ooms read the questions and Mr. Woodruff read the answers as follows:

"Mr. Naylor: I can reframe it.

Q. We have established, have we not, that your starting point on the CFI reflector was the drawing, Defendant's Exhibit No. 11, is that true?

A. That is.

Q. Now, did you give any consideration upon first studying that drawing to the feasibility of a tool that would produce a reflector of that design?

A. Yes, that would be normal.

Q. Is that normal?

A. Well, I examined the drawing and tried to anticipate what troubles you would run into in making a part of this nature on the particular equipment which you have the information for.

Q. As a result of the study you made of that drawing did you have any opinion or belief concerning the practicability of the production of it by a tool?

A. I visualized some trouble with the rib, the cross rib due to the fact that it was not even depth and due to the fact that it ran too far down the sides and faded out to nothing, which is a very difficult proposition to make in a long die where you are trying to get equal tonnage pressure over eight foot of length. I also anticipated some bowing, but I did not anticipate as much as we got.

[fol. 112] Q. Now, once you had reached this belief or had developed this belief concerning the design of Defendant's Exhibit 11, did you have any contact with any of the people at Day-Brite concerning these beliefs that you entertained?

A. I did, but I can't definitely say when or whether it was before I started to design the die or not. I did have some contact with them.

Q. Do you recall the identification of the people in Day-Brite with whom you had such contacts?

A. I talked to Bert Kaeppal and Leo Stahlhut. I think I talked to Carl Meyer, but I could not be sure to make a definite statement on that.

Q. Did you make known to Mr. Kaeppal and Mr. Leo Stahlhut the beliefs that you entertained concerning the rib aspect of the reflector?

A. I made suggestions for changes in the rib design to make the product easier to manufacture.

Q. Directing your attention particularly to the contact you had with Mr. Leo Stahlhut in that regard, with what response did your suggestion meet?

A. Well, they were not accepted. The response was that —let's see, I can't put in the exact words. I do not remember the exact words, but the general idea was to do whatever you want with it, but don't change the looks of it whatsoever. 'This rib has to come in at a certain place and run out at a certain place, so we want it to look like this.'

Q. By 'this' did they have reference to the starting drawing, Defendant's Exhibit No. 11?

A. Partly, and they had a pictorial drawing on Carl Meyer's desk."

Mr. Ooms: And then, continuing on page 17, your Honor, the third question from the bottom:

[fol. 113] "Q. Mr. Hodges, you have told us you suggested certain changes in the rib area to Mr. Kaeppal and Mr. Stahlhut; is that correct?

A. That is right.

Q. And you have indicated that those suggestions were not accepted; is that correct, sir?

A. Yes.

Q. Was any reason given at the time that you talked with Mr. Stahlhut why your suggestions were not acceptable?

A. Their reason was that they wanted to keep the appearance or not to change the looks of the fixture. I had tried to explain to them that this deep rib around the radius was not necessary, but to them in their production design and for appearance it was necessary; but maybe they didn't say it in so many words, but it is typical. No matter what job I get for which product designer, it is the typical answer, 'You have got to make it the way we laid it out, no matter how much difficulty it gives you.'"

Mr. Ooms: Then over on page 20, your Honor, beginning with the second question on top of the page:

"Q. Since you have indicated that a certain portion of the rib was non-essential, will you indicate the part of the rib shown in Defendant's Exhibit 11 which you then —and I am speaking of the years 1953 or 1954—which you deemed to be unnecessary, as you put it?

A. From the running out near the flange up to within three-sixteenths of the top of the reflector.

Q. Within three-sixteenths of the top?

A. Yes.

Q. And how would you supply that in relation to the location of the longitudinal slots?

A. We are talking about what wouldn't be necessary now?

[fol. 114] Q. Yes.

A. That makes it a little harder. The part of the rib which lies outside of the slots or of the bridge between the slots would be unnecessary. Also, the part of the rib which is in the very center of the fixture would be unnecessary to get an equal stiffness across the entire fixture. I might qualify that. The part of the rib in the center of the top may be necessary because we might have more weight up there due to ballast, but I am not too familiar with just where that hangs. It may be even less necessary, because of another part being above and help stiffen it.

Q. Would you say that some part of the rib, the entire rib depicted in Defendant's Exhibit No. 11 had function?

A. Yes.

Q. Would you say that some part of the rib has no function?

A. Yes.

Q. Would you say as an engineer that the rib was an admixture of function and non-function?

A. Yes."

Mr. Ooms: That would conclude the reading of the deposition. We are not going to read the deposition, as I indicated yesterday, of Mr. Meyer, as it is merely cumulative.

The Court: Do you want to finish this deposition? Is there any part you want, counsel?

Mr. Mullin: Your Honor, we expect to introduce the deposition of their own witness.

The Court: I am talking about this one.

Mr. Mullin: No.

Mr. Ooms: Mr. Stahlhut, please.

[fol. 115] Leo George Stahlhut, called as a witness on behalf of the Plaintiff, having been first duly sworn, was examined and testified as follows:

Direct examination.

By Mr. Ooms:

Q. Will you state your name and address, please?

A. My name is Leo George Stahlhut, S-t-a-h-l-h-u-t. I live at 1217 Craigville Court in Kirkwood, Missouri. That is a suburb of St. Louis.

Q. What is your occupation?

A. I am an employee of Day-Brite Lighting.

Q. How long have you been with that company?

A. I started with the company in 1940, when I got out of high school, working in a blueprint room and also filing drawings, making drawings. In 1942 I left the company for six months. I went to another company looking for a little more varied experience. I went into the Army. I worked in a statistics section in General Eisenhower's Headquarters, preparing statistical studies for he and General Smith.

In 1945 I came back to Day-Brite Lighting, back into the engineering department, and I did product development work, some product design work.

Now I am responsible for the New Product function at Day-Brite Lighting. I am responsible for the coordination of our patent and trademark problems and I report directly to the President, Mr. Whitehead.

Q. How long have you been in charge of coordination of patent problems, and so forth, with Day-Brite?

A. I would say at least the last five years. I can't recollect exactly.

Q. Can you tell us how Day-Brite sells its products?

A. Well, we have field representatives that call on architects and engineers to get them to specify our product for [fol. 116] plans for buildings they are working on, and then, when they put these plans out for bid that contractors put on them, and if they are successful in getting the job, they buy the fixtures from a distributor, an electrical distributor.

Q. Then, do I understand your testimony correctly, that you try to have your field representatives or distributors contact architects to have them specify the product in the drawings and specifications?

A. With a thousand, over a thousand competitors, we have to do the job ourselves. We have to work on getting our product as specified. We can't rely on anyone else to do it for us.

Q. Now, are you one of the co-inventors of the design patent in suit, No. 176,367?

A. That is correct.

Q. Can you, as briefly as possible, tell us what led up to the concept of that particular design, and I am handing you here several drawings. I don't want you to go into detail. Merely identify when you started and indicate that and we will mark them accordingly. In 1950—

Mr. Mullin: Your Honor, I will object to this line of questioning. The question of the date here is not important. It has already been stipulated that the prior art is the prior art and we are not concerned with the conception of the invention. The invention is patented. There is a date on it and that's all that is required.

The Court: The objection is sustained.

Mr. Ooms: Your Honor, I have to build a record for the Court of Appeals and, one of the things in determining the question of invention is that some concept, some idea, something went into this thing and I merely want him to identify these drawings.

The Court: I will let him go into it.

[fol. 117] Mr. Mullin: Well, the patent speaks for itself. The design is there.

The Court: Proceed. I will let him go into it.

By the Witness:

A. In 1950, we were interested in developing an industrial line of fixtures which would be distinctive, or, a product which would be identifiable from anything we had made in the past or anything that was on the market offered by our competitors and I won't go through the drawings, but, if we would go through them, we would

find that it took from 1950 until 1953 until we arrived at a design which we felt was exactly what we were looking for.

And then, in 1953 until October of 1954, we were drawing for it. In October of 1954 the product was introduced on the market.

Mr. Mullin: Your Honor, I object to the term "we." He has not identified who he is talking about.

The Witness: "We" is Day-Brite Lighting.

Mr. Mullin: Any individuals? Let him specify which.

The Court: I will let it stand.

By Mr. Ooms:

Q. Now, when you say "we" who in Day-Brite were you working with?

A. From the design standpoint I naturally was working with Mr. Meyer. From the tooling standpoint I was working with Mr. Kaeppel, Mr. Hodges and Mr. Ivan Meyer that you have a deposition of.

Naturally, it takes management approval to procure the tooling for this particular product and management was so impressed with it—we had never made an expenditure for tooling and equipment as large as we had for this particular product line. To the people who were mak-
[fol. 118] ing the decision, this was the most significant product we had come out with in the history of the company.

Q. How much did the company expend in tooling up and preparing for this product?

A. Over three hundred thousand dollars without design time. This is equipment and tooling to produce it.

Mr. Ooms: Your Honor, we have marked here the various drawings showing the stages as Plaintiff's Exhibits 14 through 21 for identification. Each of these drawings has been seen and examined by counsel for the Defendant.

The Court: Is there any objection?

Mr. Mullin: I object. It is immaterial.

The Court: I will let them go in.

(The documents previously marked Plaintiff's Exhibits 14 to 21 for identification, were thereupon received in evidence.)

By Mr. Ooms:

Q. Now, did you also, besides obtaining this design application, file a mechanical patent application?

A. When you say "you," you mean Day-Brite Lighting?

Q. You as an individual, as an inventor.

A. I was co-inventor with Carl Meyer on two design patents, one of which covers design of the patent in suit, and then another reflector which we call CFI-25, which has a V-shape. We have a sample back here. (Indicating)

Q. By that you are referring to a reflector having an internal downwardly pointing channel, is that correct?

Mr. Mullin: Your Honor, I object. This patent is not in suit.

Mr. Ooms: That is correct, your Honor, but counsel made some very strong statements about a mechanical patent here, and what we have done, and I think we ought [fol. 119] to be able to refute it.

Mr. Mullin: He can refute it without introducing other patents.

The Court: I don't know what counsel said. The only reference is to one patent. The objection is sustained.

Mr. Ooms: That is correct, but I don't want the Court to have any misapprehensions as to what is covered here.

The Court: But not covered by something that has not been issued.

Mr. Ooms: It is not in suit here. It has been issued but it is not in suit here.

The Court: That is right.

By Mr. Ooms:

Q. Now, when was the first CFI-10 reflector—

Mr. Ooms: Yes, but it is not here in suit, your Honor.

The Court: Did you say this patent was issued?

Mr. Kraus: It is another design and has no relation to the patent in suit at all.

Mr. Ooms: It has a relation to it, obviously. One merely has to look at it to see. It is not here in suit, there is no question about that.

The Court: All right, I will sustain the objection.

By Mr. Ooms:

Q. When did you begin first to sell your first CFI reflector?

A. In the fall of 1954.

Q. And after you began selling this CFI—and by you I mean the Day-Brite Company—were any other similar types of reflectors called to your attention?

A. Well, after we started marketing it in 1955 we were informed that the Mitchell Company had been offering or showing a product similar in design, and since then there have been maybe eight or ten other people who have [fol. 120] copied the product design.

Mr. Mullin: I will object to the use of the word "copied," your Honor. He is in no position to say whether it is copied or not.

Mr. Ooms: I think it is a matter of semantics. He has to express himself in some way.

The Court: "Copied" will go out; "similar design" may stand.

By Mr. Ooms:

Q. Did you at my request make a compilation from the records of the Day-Brite Company concerning these similar types of reflectors?

A. That is correct.

Mr. Ooms: We have marked as Plaintiff's Exhibit 22 for identification a number of charts.

By Mr. Ooms:

Q. I ask whether these charts show this compilation from records that the Day-Brite Company keeps in its regular course of business?

A. That is correct.

Q. I note in the lower right-hand corner of each of these charts various notations. What do these notations signify?

A. That is a record of the actions which we took against these people with similar designs, and if there was an outcome it is indicated at the lower right-hand corner.

Q. Now, these were the records that were turned over for counsel at a deposition taken of yours, is that correct?

A. That is correct.

Q. Now, will you very briefly tell—

Mr. Mullin: I object to that. This is the first time I have seen these, your Honor.

Mr. Ooms: That is correct, your Honor. This is a composition chart to try and make things easier for even [fol. 121] counsel, but they are made from records which were turned over to you. I don't think you will object to that at all.

Mr. Mullin: Yes, I will. I don't recall any such records turned over.

Mr. Ooms: I have it right here in the deposition, your Honor. If counsel will begin referring to the deposition, the second deposition that you took of Mr. Stahlhut, beginning at Page 21, I will read it into the record:

"Mr. Ooms: First of all, Counsel, go into your first request: 'All records, documents, correspondence, memoranda, notices, contracts, patent applications, drawings, sketches and blueprints relating to the preparation, filing and prosecution of design patents No. 176,367 and No. 177,532, and any other patents and patent applications directed to the fixtures disclosed in said design patents.'

"So you will have it all, as to records and documents, we have here some of these records, documents and blueprints and photographs which I have already marked as Plaintiff's Exhibits 15 and 16, correspondence we do not have because most of it was done through personal correspondence and thereafter it related to what you were going to do with the patent and in our opinion, counsellor, it is a privileged communication between client and attorney.

"Memoranda, there is none. Notices, I don't understand what it means in this connection. The only contracts are the assignments from the inventors themselves.

"The patent applications, we have already turned over to you the mechanical application, serial No. 482,212. We, of course, have the File Wrapper history of the mechanical patent in suit which is available to you from the [fol. 122] Patent Office. We normally would like to make that available to you, but there are all sorts of personal notes written all over it and it is also true as to the other one.

"Sketches, there are none. Blueprints, yes, we have twenty-six blueprints here which you can have. Now, as to the other patents and patent applications, we have two design patents on small features, which have been issued—"

Mr. Mullin: To shorten this, I think he is reading on to other documents we requested. What I was referring to was that we had no documents showing infringement notices or what happened as to—

Mr. Ooms: Counsel, just let me read page 23.

Mr. Mullin: To shorten this—

Mr. Ooms: (Reading):

"With regard to Paragraph 2—"

Mr. Mullin: In order to shorten this, I will—

The Court: Let counsel finish.

Mr. Mullin: To shorten this, I don't think it is important, so—

Mr. Ooms: I want to read it.

The Court: Go ahead.

Mr. Ooms: (Reading):

"Now, with regard to Paragraph 2, reading, 'All records, documents, correspondence, memoranda, notices, contracts, patent applications, drawings, sketches and blueprints relating to sales and advertising of fixtures embodying the principles of said design patents.'

"I might say right offhand—I don't know, I think you fired a shotgun blast here, but memoranda of notices, sketches and blueprints pertaining to sales and advertis-

ing—we do have, however, records of the sales of this particular fixture and specimens of all the advertising in [fol. 123] connection therewith.

We do not have a dollar volume of advertising of the fixture because it is impossible to segregate it from the rest of the advertising relative to other products since it is usually done in conjunction with other products. As to the third paragraph, 'All records, documents, correspondence, memoranda, notices, contracts, patent applications, drawings, sketches and blueprints relating to the alleged infringement of said design patent by parties other than the defendant.'"

That is infringement, Counsel.

"Again, there are some records and documents. But, we do have the correspondence between alleged infringers. We have also the correspondence between Planned Lighting, a lawsuit heretofore filed and concluded, together with the pertinent formal papers concluding the contract of settlement in connection with.

"Since that relates to quite a pile of correspondence and documents, perhaps you want us to put it in as you go through these things, so you will have some orderly procedure. You are certainly welcome to look at them.

"Mr. Mullin: I would like to look at them.

"Mr. Ooms: Would you like to look at all these documents and then begin questioning?

"Mr. Mullin: I think that might be the best way of handling it.

"Mr. Ooms: So there won't be any question, it is now twenty minutes to four. We won't ask anyone else to come over, and we will start at 9:30 tomorrow.

"Mr. Mullin: 9:30?

"Mr. Ooms: We will hand you each of these documents and put them in a pile so you will know what they are.

"Mr. Mullin: These are drawings with regard to specifications?

[fol. 124] "Mr. Ooms: Yes. We are handing you one manila folder having on top 'Orders Received in Dollar Volume of the CFI-10-15.'"

"They are the same thing—that is, the candle power is increased for the 15. And, also all of the literature in connection with the advertising of it."

Then it goes on as to dollar volume, your honor. Then on page 27:

"Mr. Mullin: What is this?

"Mr. Ooms: That is 'Planned Lighting, now known as All Brite.' The next group is with a company relating to Ruby Philite Corporation. We had some more correspondence with reference to Globe Lighting Corporation, another series of correspondence with Gibson Industrial Fixtures, correspondence with Smoot-Holman Corporation and correspondence with Harvstone Manufacturing Company; correspondence, documents, including formal papers and final agreement with Planned Lighting, Incorporated, correspondence with Ender-Monarch, correspondence with Wm. Penn Fluorescent Lighting Manufacturing Company, correspondence with the Miller Company.

"Mr. Mullin: I suggest then that I will spend some time looking this over and then we will resume this deposition tomorrow morning."

Then we agreed to suspend until the morning. Here are these records, your Honor. (Indicating.)

Mr. Mullin: Your Honor, I think counsel has left the wrong impression here. I was objecting to the fact that I had not received documents relating to infringement and what happened to those infringements, and he here claimed and just read, "You are claiming the privilege—" and Mr. Ooms replied as to the working papers, and that is all I was referring to.

The Court: All right, proceed.

[fol. 125] By Mr. Ooms:

Q. Now, as to this chart, will you briefly go through these compilations of charts based on these records that were turned over to counsel for Defendant.

A. Well, we compiled these records into a chronological order of the number of people that we felt had a design similar to ours.

The first one is the Mitchell Company. The date we notified—well, first of all, we obtained the Mitchell Bulletin in June of '55 infringing the Cory Corporation in November of 1955, which was before the patent had issued. We wanted them to—not to get into trouble if they were not making the product. We sent them a design patent.

In December of '55 we obtained a sample which we used to make the photograph.

We notified Compco of infringement in March, 1956, and we filed suit in June of 1958.

The Planned Lighting Company had a design similar to ours. We notified them of infringement in May, 1956. We filed suit in 1957. In May of 1958 they acknowledged the validity of the patent and changed their product to another fixture with up-turned apertures and ribs, but it was a design which we felt was not similar to ours—

Mr. Mullin: Your Honor, the records, I think speak for themselves. If they are going to introduce this, all these notations are contained on the documents.

Mr. Ooms: We know, but we would like to have the record complete. Thank you, counsel.

The Court: All right.

By the Witness:

A. (Continuing) The Ender-Monarch Corporation, we first received a report by a representative in April of [fol. 126] 1957. We notified them of infringement in May, 1958. In September of 1958 they acknowledged the validity of our patent and revised their reflector to another rib design with up-turned apertures. We did not feel it infringed our patent.

The Harvstone Manufacturing Company in Chicago first listed this product in January, 1958. (Indicating.) We notified them of infringement in July of 1958 and they discontinued the sale of this product in July of 1958.

By Mr. Ooms:

Q. I notice each of these charts has a picture of a reflector. Is that the reflector that they were making?

A. Right. These photographs or photostats are either photographs of a product which we had obtained or else it is an enlargement or a photostat from their literature which they were offering.

Here is the All Brite fluorescent fixtures manufacturer. (Indicating.) We obtained a sample in March of 1958 and we notified them in June of 1958, and we filed suit in October of '58.

Q. Is that lawsuit still pending?

A. This lawsuit is still pending.

Q. In California?

A. In California. This is the Gibson Manufacturing in Atlanta, Georgia. We obtained the sample in June of 1958. We notified them of infringement in July of 1958 and they revised their product. They recognized the design and they revised their product to a different rib design which we did not feel infringed our patent.

Q. That was in January, '59?

A. January '59. The Wm. Penn Fluorescent Company; we saw this product in their price listing of June, 1958 and we notified them of infringement on June 30th of [fol. 127] 1958. They discontinued the sale of the product in July of 1958.

Globe Lighting, we did not have a photograph of theirs because this was a particular instance where they were taking a product similar in design and attempting to substitute on one of our specifications.

We notified them that we had a design patent and they referred it to their attorneys. There was no reply. That was June through July of 1958.

The same thing happened with the Ruby Philite Corporation. We did not obtain a photograph of their product nor what they were offering other than the report by a representative that it looked exactly the same to him.

We notified them of infringement and did not receive an answer.

Work-O-Lite—all we had received was a report by a representative. We took no action.

The Electric Lighting Corporation here in Chicago had a catalog No. 615 issued on April of 1959. It seems to have an appearance similar to our CIF-10. We have not taken action against them.

Q. Now, I notice that date is April '59. To shorten this up, is that same thing true of the Virden Company, you notified them in June of '59?

A. We did not notify them.

Q. Well, you received it in June of 1959?

A. Right, we received it in June of '59.

Mr. Mullin: Your Honor, counsel insisted he read this and now he is telling him not to do it. We wanted the whole thing to go in without reading.

Mr. Ooms: Fine. I am trying to shorten it.

The Court: Proceed.

[fol. 128] By Mr. Ooms:

Q. Guth in '59 and Smoot-Holman in February, '60, and Light and Power Utilities—you have done nothing with respect to them? You have not sent them notices of infringement, is that correct?

A. That is correct. After we had written a certain number of these letters of infringement we found that, well, in order to solve the problem we had to settle some of the lawsuits first, of which this suit is one.

Q. In other words, you have not filed or notified anybody else until you have a chance to litigate this design patent, is that correct?

A. That is correct.

Q. And you now have this design patent in two lawsuits, this one and the one in California?

A. That is correct.

Q. Now, yesterday counsel referred to this CFI-10, which has been marked as Plaintiff's Exhibit 9 for identification, and I would like to call your attention to the inside page, the lower left-hand feature, and ask you to read us what is stated thereunder.

A. Well, there is a photograph with a reflector on the last line, that states:

"Ribs also lend an unusual, distinctive appearance to the fixture."

Q. Does the letter speak about function? Read the entire thing. I want the record to be complete.

A. The entire thing reads:

"New rib construction; reflectors are reinforced by die-embossed ribs located between the apertures; ribs add lateral stability to keep the reflector from spreading, help maintain straight fixture edges; ribs also lend an unusual, distinctive appearance to the fixture."

Q. Now, in the case of some people who you have stated [fol. 129] make similar types of designs, do you find in any of their literature any claim by them about a distinctive design or something of similar import?

A. Here is an ad—

Mr. Mullin: May I have the question read?

(Question read.)

Mr. Mullin: I will object to that. What has that got to do with this case, what they say about it?

Mr. Ooms: Your Honor, I think it has a great deal. This shows respect by other people as to what is here, not only by these other people that Mr. Stahlhut has called to the Court's attention, but, as I hoped to show later, by even what the defendant says.

The Court: As long as it is in I will let it stand.

By the Witness:

A. May I continue?

By Mr. Ooms:

Q. Yes.

A. Well we were advertising the distinctive design. Here is the Smoot-Holman Company in February of 1960 that advertised a rib similar in appearance to our fixture. They stated:

"The best looking industrial fluorescent fixture available today."

The Court: That wasn't the question.

Mr. Ooms: Yes, it was.

Mr. Mullin: Your Honor, I will object to that.

Mr. Ooms: I think it was.

Mr. Mullin: If he is reading from something that is not going to be introduced into evidence, then we don't know what he is reading from.

Mr. Ooms: We would be happy to put that into evidence, Counselor, for your benefit. We will ask the court reporter to mark that as 26.

[fol. 130] (The said document was thereupon marked Plaintiff's Exhibit 26 for identification.)

Mr. Mullin: May I have an opportunity to examine it then.

Mr. Ooms: You may look at it again.

By the Witness:

A. (Continuing) The All Brite Company in California in their brochure offering the product similar to ours for sale—one of the main points was attractive appearance, that this product had an attractive appearance.

Mr. Mullin: I object to his characterizing the literature. If the literature is going in it speaks for itself. If he wants to read from portions, let him read, but—

Mr. Ooms: He just did. It says, "attractive appearance."

Mr. Mullin: Your Honor, I thought I heard the answer and the answer said one of the main points, so he is characterizing it.

The Court: That is what I thought.

Mr. Ooms: That is right. Just read that portion then.

By the Witness:

A. I am sorry. It states, "attractive appearance."

Mr. Mullin: I object to the answer.

The Court: It may be stricken.

By Mr. Ooms:

Q. Do you find in Plaintiff's Exhibit 27 for identification, the All Brite catalog, a statement about the appearance or design of that particular item?

A. On the left-hand side of the page at the upper left-hand corner it states, "Attractive appearance."

Mr. Kraus: Your Honor, all of this is statements made by other companies and has no bearing between Plaintiff and Defendant here. Now, what Joe Blow is saying about something, has no binding force on us. It is what we say and what the Plaintiff says that counts in this case.

[fol. 131] Mr. Ooms: I disagree. One of the important things, and some of the law the Court has, is, "What does the rest of the world think about this?" including the Defendant.

Mr. Kraus: That isn't so.

Mr. Ooms: We think a great deal of it, obviously, or we would not be here.

Mr. Kraus: That may be important, but not what Joe Blow says. We are not bound by what he says.

Mr. Ooms: No one says you are bound by it.

The Court: I will let it stand.

Mr. Ooms: Your Honor, I really believe in a semblance of good court procedure. I do not know whom is opposing me in this case. Mr. Kraus, who is a very excellent patent attorney, keeps hopping up. He isn't of record.

Mr. Kraus: I am too, your Honor.

Mr. Ooms: Are you of record now?

Mr. Kraus: Yes. I represented the Mitchell Company back in 1955 when they started this. I am of record.

Mr. Ooms: You are of record?

Mr. Kraus: I have been since the beginning.

Mr. Ooms: I am sorry. You did not sign your name to the brief and I did not find it in any formal papers, Mr. Kraus. I just wanted to be sure about the procedure here, your Honor.

By Mr. Ooms:

Q. Now, Mr. Stahlhut, did you, under the direction of your accounting department, put together the figures rela-

tive to the sales and shipments of the CFI-10, that is, the reflector of the patent here in suit, as well as the other industrial fixtures manufactured—and I say "industrial fixtures" as contrasted to commercial fixtures.

A. That is correct.

[fol. 132] Q. And have you made up a chart to indicate what these particular figures and sales are?

A. I have.

Q. And these were made from the records supplied to you by your Accounting Department and in their regular course of business?

A. Yes.

Mr. Ooms: This has already been marked as Plaintiff's Exhibit 23 for identification, your Honor. (Indicating.)

By Mr. Ooms:

Q. Now, calling attention specifically to the upper chart, I note several types of lines and graph bars. Will you indicate first what the substantially movable horizontal line indicates?

A. Well, in the normal course of business we report our industrial sales to NEMA, and this chart, the upper chart—the lower scale is the years from 1949 to 1959.

The scale goes up from, oh, it goes up to five million dollars. In other words, a red line is the report of shipments for the last ten years of industrial fixtures.

Q. This is only of industrial fixtures?

A. That is correct.

Q. This does not include commercial fixtures, and so forth, that you make?

A. No.

Q. And what about the vertical bar graphs; what do they indicate?

A. That is the total volume of incoming orders for the CFI-10 or the design in suit for the years 1956, '57, '58 and '59.

Q. Now, when was the CFI-10 first introduced or sold?

A. In October of 1954.

[fol. 133] Q. Now, at the end of '55, from the early part of '54 shows an increase, is that correct?

A. Right. The "I" stands for industrial business and the "O" stands for other business. In other words, our industrial business had increased 14 per cent; our other business increased 14 per cent from 1954 to 1955.

Q. Now, what portion of your business did the CFI-10 take of your industrial lighting sales at the end of 1956?

A. In 1956, 80½ per cent of our industrial business was the CFI-10.

Q. And I note above there that sales rose from $2,793,136 to $3,958,579; is that correct?

A. That is correct.

Q. Now, the "I" indicates that the industrial business of the company increased 42 per cent?

A. That is correct, from 1955 to the present.

Q. And the "O" indicates—

A. Our other business increased only 22 per cent.

Q. What can you say about the year 1957?

A. From 1956 to 1957, our industrial business increased 19 per cent. Our other business increased only 9 per cent. And, in 1957, 80 per cent of our industrial business was the design in suit.

Q. What about the year 1958?

A. In 1958, our industrial business declined 26 per cent and our other business only increased—only decreased 5 per cent and we had five times the loss as in our industrial business.

Mr. Mullin: Your Honor, I object to an answer that was recently made. I think he said this 80.5 per cent represented the sales of the fixture in suit. Is that what you said? I think that is what you said.

The Witness: The design in suit.

Mr. Mullin: The design in suit?

[fol. 134] The Witness: Yes.

Mr. Mullin: That represents only the—

Mr. Ooms: The CFI-10.

The Witness: That is right.

Mr. Mullin: The 80.5 per cent represents that?

The Witness: The fixtures with the reflector of the design in suit.

Mr. Ooms: That is right.

By Mr. Ooms:

Q. Now, we supplied figures to counsel for defendant, did we not, at your deposition which, I believe, had a heading "CFI-10" and "CFI-15", is that correct?

A. Yes. This is the information that we had supplied.

Q. What is the difference between the CFI-10 and the CFI-15?

A. In the electrical components only. There is no difference in the metal parts.

Q. In other words, the reflector is identically the same?

A. Yes.

Q. It is only in the light input or output that there is a difference?

A. It is the type of lamp that is used in the fixture. You have to have different electrical components to operate.

Q. To take care of it?

A. Yes.

Q. It is the identical design?

A. Yes.

Q. These figures include both of these figures, is that correct?

A. Yes.

Q. I ask you what percentage the CFI-10 was in 1958, of your total industrial sales?

A. It had dropped to 72.3 per cent.

Q. Now, I would like to call your attention to the lower [fol. 135] graph and, will you explain as briefly as you can, exactly what this lower graph shows.

A. Well, taking them one at a time, let us take the first, which is—

Q. Why don't you take this stick and show the Court?

A. What we show on this chart are three different items: Monthly in-dollar volume of incoming orders for the CFI-10 type reflector, competitor recognition—

Q. We will strike that.

A. With similarity of design. This chart goes from 1954 until 1959, which is, basically, the period which we have been marketing this fixture.

The vertical scale leads from zero to 25,000 reflectors.

When we first went into this industrial line of fixtures, we put out a porcelain enamel. For each month we have kept a record of the equivalent four-foot, enamel reflectors.

The first year of production we have 11,629 reflectors. The second year, after introduction, almost 15,599. The third year—

Q. That is per month?

A. Yes. The third year it is 20,482. This is over a quarter of a million reflectors a year in 1958.

Q. Let me first call your attention to—I note the word on the first bar graph, the word "Mitchell." What does that refer to?

A. Again, this chart runs from 1954 until 1959 and we first received information that Mitchell was going to produce a fixture which was similar to ours or which we thought would be following on our specification. This would indicate the middle of 1954, when we were first advised.

This was when we were advised of another reflector similar in design (indicating).

[fol. 136] Q. That was in 1956?

A. Right, in 1956, the first quarter of 1957. Here is a third person has a similar design (indicating), and, in 1958 you can see we had an increasing number of people with similar designs.

Q. Now, in 1958, correlate that to your sales then. We all, of course, can recognize the fact than in 1958, business was down, generally; we had a slight recession. "Industrial down 25 per cent," and "Industrial down 26 per cent." Will you correlate that with the bar graph below?

A. Here is 1957 (indicating), an average of 24,482 reflectors a month, and, in 1958 our business had dropped to 11,240 reflectors a month, or below an average of the first year of introduction. In other words, we seemed to have commercial success or product acceptance, and then the sales fell off and all we could attribute it to was dissolution of identity so that we were not getting the orders for our specification work.

Q. That was because of all of the other people—

Mr. Mullin: I will object, your Honor. He doesn't know whether it was due to dissolution or for another reason.

Unless he can specify or show his figures, he can't give an opinion.

Mr. Ooms: He is showing you figures.

The Court: I will let it stand.

By the Witness:

A. (Continuing) In 1958, the figure is 11,240. In the year 1959 it is 8,073. The number of four-foot reflectors that we made in 1958 and 1959 were below the first year of its introduction, in 1955.

We show dollar volume of incoming orders of—that is the red line, the continuous line, and, it is used to correlate between the production of reflectors and the dollar volume of incoming orders that correlate to the vertical bars in the graph above.

[fol. 137] By Mr. Ooms:

Q. I again call your attention to the fact that in 1958 your industrial business had fallen off 26 per cent and all other business 5 per cent. Is this normal?

A. No. Normally—well, we are in the commercial and industrial lighting business, and, normally, business is up or down. It was unusual circumstances when industrial business increased much more rapidly than our other business and we felt there were unusual circumstances when it decreased five times the rate of our other business. This is more than we feel is economic.

Q. What reason did your company attribute for that?

A. Well, we felt that we had gained an identity with our product design. We felt that we had lost it in 1958, due to all of the people with similar design reflectors, so that we had dissolution of identity.

Q. Now, did you make up another chart or surveys that have been made with respect to brand preference, and so forth?

A. That is correct. Rather than use our own figures, independent surveys have been made which we had no responsibility for at all. McGraw-Hill, who published—

Mr. Mullin: Your Honor, I will object to that. That was stricken yesterday and you didn't permit those surveys to go in.

Mr. Ooms: And very properly so, your Honor, because yesterday there was no background, no basis for their being introduced. We are now going to show, with these surveys, that during this critical period that we are talking about when this reflector was introduced and during the period when it enjoyed success, these surveys were made, and it will show that the Day-Brite Company increased in leadership in the industrial field, three years of which— [fol. 138] two years of which it had 80 per cent in the industrial line, and the third year it was 72 per cent, and, it was during this period—

Mr. Mullin: Your Honor, I object to characterizing what this is.

Mr. Ooms: You are arguing before I even have a chance to finish. Before the Court can intelligently rule, he has to know what I intend to show with this.

Mr. Mullin: Your Honor, this graph covers industrial lighting. It does not attempt to distinguish the fixture that is in suit. That is the only one we are concerned with. They have introduced others. They have tried to introduce the C-25, which is another fixture. They have a number of them. Unless they can show it pertains only to the patent in suit, it has no place here.

Mr. Ooms: We have just shown in these critical years, the CFI-10, the design of the patent in suit, accounted for 80 per cent of the business in two years and 72½ per cent in another year and that these are the years that these particular surveys were made by some independent group.

Mr. Mullin: Furthermore—

Mr. Ooms: Now, it will go to the weight of the evidence as the difference between 100 per cent and 80 per cent.

Mr. Mullin: This is a question of brand preference. It is not a question of the fixture preference. Furthermore, I don't even see what the entire question of preference has to do with it.

Mr. Ooms: That is exactly the point of this lawsuit, Mr. Mullin. We are here because of the distinctiveness of

the design which creates the brand preference. That is precisely it.

Mr. Mullin: I was under the impression that the point of the lawsuit was whether or not there was infringement or whether or not this is a valid patent.

[fol. 139] Mr. Ooms: That is right, and it goes to the weight of it.

The Court: Primarily, the question will be is the patent valid and the secondary question will be, is it an infringement.

Mr. Mullin: That is right.

Mr. Ooms: That is right. Now, many elements—

The Court: Let him proceed.

The Witness: As I stated in my earlier testimony, we are representatives who call on two classes of people in order to obtain specifications. Here are electrical contractors, the electrical consultants who specify equipment and the chief electrical men. These are large plants. They maintain their own engineering departments which specify equipment for factory illumination.

We have another type of customer that specifies our equipment, which is the electrical contractor, and, if we look at the upper left-hand chart, at the top of the chart is "What Makers of Industrial Lighting Fixtures (Fluorescent) Do You Consider in Planning Purchases."

If we look up there (indicating), "A" we will find that there are four horizontal bars which represent the years 1942, or, rather,—excuse me—the four bars represent 1952, 1954, 1957, and 1959.

We will find that "A" indicates the manufacturer, and, if we go to the little inset, we will find that "A" is Day-Brite Lighting. These horizontal bars show that for the years 1957 and 1959, Day-Brite was in the No. 1 position among electrical contractors and brand preference for industrial lighting fixtures.

In 1952 and 1954 which are the years prior to the introduction of this new industrial fixture, we were in second place.

[fol. 140] Here in the upper right-hand corner is the "Electrical Consultant" or "Specifier." In 1955 we were in second place. In 1957 and 1959, after this product had

been introduced, we moved up to first place. Among the Chief Electrical Men in 1952 and 1954 Day-Brite was in fourth place and, in the years 1957 and 1959, after we had introduced this product, we were in first place.

Here is another—"Plant Engineer Readers" and this study was made in 1958. The study from which these, the upper two and the middle left-hand chart were taken from, were in 1959. They are later but, here it shows that Day-Brite Lighting is in fourth place and the only companies that have a better brand preference than Day-Brite are Westinghouse, Sylvania and General Electric and all of those companies make not only fixtures, but they make lamps, they make switch gearings; they would have a better brand preference from all their other electrical components. Day-Brite makes only lighting fixtures.

Mr. Mullin: Your Honor, I object to his introducing his opinions. Let him testify to it.

The Court: Yes. The objection is sustained.

The Witness: Shall we forget this (indicating)?

Mr. Ooms: Yes. Go right ahead.

By the Witness:

A. Going back to these charts, we also find not only an improvement in Day-Brite's position from 1954 to 1957, but, in the case of electrical contractors and electrical consultants, we find that Day-Brite is losing brand preference. In other words, when we look at this preference, we feel that the CFI-10 type design gained this recognition and then all of these other competitors are creating dissolution and we are losing what we had gained.

[fol. 141] Mr. Mullin: Your Honor, it speaks for itself.

Mr. Ooms: I don't think it speaks for itself to that extent.

Mr. Mullin: He gave an opinion.

Mr. Ooms: He gave an opinion as to what the company decisions were in this respect.

Mr. Mullin: He is giving an opinion as to why these figures went down or up and he has nothing to substantiate it.

Mr. Ooms: Except the charts, the charts which have already been introduced which I think show that abundantly.

Mr. Mullin: It is a self-serving document, your Honor. I question the admissibility of it at all.

The Court: I feel that the admissible part of it emphasized is the volume of sales from 1954 to 1959 and then down, but not as to its position in the market, its relative position. But, I will let it go in.

Mr. Ooms: I think it goes to the weight, your Honor.

By the Witness:

A. Well, then, the lower two charts, there was a survey made among electrical distributors in August, 1958 and they were asked as to "What is the best selling industrial line?" Day-Brite showed up as the No. 1 of the best selling industrial line and, they were asked to rate on design, how they feel about their suppliers' quality.

Mr. Mullin: I object.

The Court: I will also sustain the objection to that. They were asked—who was asked? Who gave this information?

Mr. Ooms: Your Honor, this was the document that we had stipulated as to, if the editors and so forth had been called, they would say how it was made, who it was [fol. 142] made by and everything else. It was one of the Plaintiff's exhibits here offered and the chart is based exactly on what is in these two documents.

Mr. Mullin: And those documents—

OFFERS IN EVIDENCE

Mr. Coms: I would like to re-offer them now that we have put in a base for their offering. In other words, we have tied them, now, to a specific time, to a specific feature, at least 80 per cent of which, during this period of time, was in the particular design of the patent in suit, and, I, therefore, would like to now offer them, since the groundwork has been established, as Plaintiff's Exhibits 2 and 3.

Mr. Mullin: I voice the same objection.

The Court: I will have a motion called shortly.

Mr. Mullin: I voice the same objection, your Honor. This is a study that has nothing to do with the question of infringement, the question of validity, and even as to commercial success.

The Court: That is the only phase that I am debating on. Then it is admissible under the so-called commercial success theory.

Mr. Ooms: That is correct. That is precisely what they are offered for.

Mr. Mullin: Commercial success can only be considered if there is any doubt of the validity of the patent.

The Court: It will be in the record only for that purpose.

Mr. Ooms: Thank you, your Honor.

(The documents previously marked Plaintiff's Exhibits 2 and 3 for identification, were thereupon received in evidence.)

Mr. Ooms: I would now like to offer Plaintiff's Exhibits 23 and 24, the two charts here and Plaintiff's Exhibits 26 [fol. 143] and 27, the two folders which have also been identified and which the witness testified about.

Mr. Mullin: I don't think there is any proper foundation that has been laid for these. I don't know where he got these, what they are. I am talking about these Exhibits 26 and 27. As to the charts, again, I say, they do not pertain to the question of validity or infringement or even of commercial success because they are not—

The Court: That is true, they have no relativity to the validity or infringement, but, if commercial success has any value, it belongs in that category.

Mr. Ooms: That is correct.

Mr. Mullin: Except these figures do not show the commercial success of the fixture, the only fixture which is here involved, and, that is the CFI-10.

Mr. Ooms: Your Honor, perhaps counsel might want to take ten minutes to analyze these figures. They show precisely that we are only talking about the CFI-10.

The Court: They may be received in evidence.

(The documents previously marked Plaintiff's Exhibits 23, 24, 26 and 27 for identification, were thereupon received in evidence.)

Mr. Ooms: I don't know if we offered the package of charts yet, your Honor, but I would like to offer them, your Honor, right now.

Mr. Mullin: All right.

The Court: Counsel said he withdraws the objection.

Mr. Ooms: Fine.

The Court: They may be received.

(Said documents, so offered and received in evidence, were marked Plaintiff's Exhibit No. 22.)

[fol. 144] Mr. Mullin: I have, your Honor, one more objection to the introduction of the charts if you will hear me. They have introduced nothing as to what these figures are taken from. Where are the records? We do not know whether they were made in the ordinary course of business. We don't know but that they may have selected these figures. They are self-serving. They speak for themselves. We know nothing about the background of them or anything else.

Mr. Ooms: Your Honor, I asked him the question whether they were compiled under the direction of the presidential head, whether they were taken from their records, whether they were maintained in the regular course of business.

We turned over records to them, showed them the type of records we took them from. We turned records over to them when Mr. Stahlhut's deposition was taken. If he had any question about their authenticity he should have raised the question at that time, when we turned these figures over to him.

Mr. Mullin: First of all, these are compilations. If these were taken from compilations, they are not proper to introduce in evidence. They have to be kept in the regular course of business. We don't know where these were taken from.

The Court: Suppose I reserve my ruling and see how that objection enters into it. I think that objection is well founded.

Mr. Ooms: He is saying he doesn't know where they came from. We gave him the background material for that compilation when we turned over the records to him from Mr. Stahlhut when they took his deposition.

[fol. 145] The Court: He said what you did was make the compilations.

Mr. Ooms: We gave him the type of background records from which they came. He at no time questioned any of the authenticity. Furthermore, this witness testified these were taken from the records kept in the regular course of the business. If he wants to doubt the authenticity, we will bring them here, but at his expense, reams and reams of them.

Mr. Mullin: Your Honor, counsel himself has stated they were taken from compilations which were given to me. These are the only compilations he has given me (indicating).

Mr. Ooms: Your Honor, he was given all these background figures, just as many as are right here.

Mr. Mullin: These are what you gave me (indicating).

Mr. Ooms: You had everything to look at, Mr. Mullin, and now you come up and question the authenticity, which, I think, is something esoteric.

Mr. Mullin: He didn't state whether they were going to be introduced at the trial or anything. These were merely a part of the deposition.

The Court: I don't blame counsel. I think his objection is well founded. Let me reserve my ruling and see how much importance it has. Let me see how important it becomes. If I should find there is no patentability, that is the end of it. If I find there is any infringement, that is the end of it. On the other hand, if I find there is infringement, the patentability becomes important as to the commercial success.

Mr. Ooms: That is correct, your Honor. That is entirely what it is put in for.

Mr. Ooms: Will you please mark these Plaintiff's Exhibits 25-A and 25-B for identification.

[fol. 146] (The said documents were thereupon marked Plaintiff's Exhibits 25-A and 25-B for identification.)

By Mr. Ooms:

Q. Did you have enlarged charts of the patent in suit made for me, which has been marked Plaintiff's Exhibit 25-A for identification?

A. Yes.

Q. And did you also have pictures made of the accused structure here showing the accused structure in the same relative position as the patent in suit?

A. That is correct. We purchased a fixture in December of 1955. We had our photographer take views which would correlate to the views in the figures in the patent design application, or patent design.

Mr. Ooms: Rather than putting a long testimony on with respect to infringement, your Honor, I think these speak more eloquently than anything we could do, and, I offer Plaintiff's Exhibits 25-A and 25-B.

Mr. Mullin: No objection.

The Court: They may be received.

(Said documents, so offered and received in evidence, were marked Plaintiff's Exhibits 25-A and 25-B.)

Mr. Ooms: No further questions.

The Court: Do you have personal knowledge of the sales figures of your company over a period of years?

The Witness: Yes, sir, I have them.

The Court: Reflected in those charts?

The Witness: To the best of my knowledge these are the most accurate figures we can provide.

The Court: All right. Do you have access to those figures?

The Witness: Yes.

[fol. 147] The Court: Have you had a chance to study those figures?

The Witness: Yes.

The Court: Have you had a chance to compare those figures with the indications on the charts?

The Witness: Your Honor, I got the sales figures. I made the charts.

The Court: You did?

The Witness: Yes, sir.

The Court: Are they true and correct?

The Witness: To the best of my knowledge they are, your Honor.

The Court: Have they been taken from the original true and correct figures of the company?

The Witness: Yes, these are the figures which we had available.

The Court: All right. Proceed.

Cross examination.

By Mr. Mullin:

Q. On Plaintiff's Exhibit 22, which represents—well, which represents other manufacturers making similar fixtures, does that represent—well, you have it there—does that represent all of the companies who you know of that make a similar fixture? Is that correct?

A. No. I have been informed of two additional companies that have a product similar in appearance to this fixture since I compiled them.

Q. What are they?

A. One is Luminous Ceiling of Chicago, who have since discontinued the sale of it, and, just yesterday, Mr. Whitehead, the president, brought in an ad from Good Manufacturing Company that shows a product substantially the same as this.

[fol. 148] Q. Those are all that you know of?

A. These—that is all I know of that are making a product similar in appearance to CFI-10.

Q. Isn't it a fact that Sylvania Electric Products, Inc., also made a product similar to yours, or, is making a product similar to yours?

A. Sylvania Electric makes a product similar to our CFI-25, which is not in suit.

Mr. Mullin: Miss Reporter, will you mark this Defendant's Exhibit X-1 and Defendant's Exhibit X-2 for identification.

(The said documents were thereupon marked Defendant's Exhibits X-1 and X-2 for identification.)

By Mr. Mullin:

Q. Mr. Stahlhut, I hand you a letter from the Miller Company to Day-Brite, or a letter from the Miller Company marked Defendant's Exhibit 1 for identification, written on January 10, 1956. Do you recognize that letter?

A. I believe I have seen a copy of this letter before.

Q. Isn't it a fact that you gave us that letter? I am talking about Day-Brite.

A. I should imagine, if you have it in your possession, that we gave it to you.

Q. Do you also recognize this telegram?

A. Yes, I believe I recognize it.

Q. Is this a telegram from the Miller Company to Day-Brite?

A. Yes. That is correct.

Q. In that letter of January 10, 1956, which was written in reply to your letter of December 21, 1955, did not the Miller Company deny the infringement and deny the validity of your patent?

Do you want to look at it? Take your time.

[fol. 149] A. Your Honor, may I have your—

Q. Just answer my question, please.

A. There is a background.

Q. Well, answer "Yes" or "No" and then you can explain.

A. What was the question?

Mr. Mullin: Will you please read the question?

(Thereupon the pending question was read as above recorded.)

The Court: He wants to know, isn't it a fact that the Miller Company denied the validity of your patent and the infringement?

The Witness: Yes, that is correct. They have denied the infringement.

By Mr. Mullin:

Q. And the validity?

A. And the validity.

Q. And that letter was written on January 10th, 1956?
A. That is correct.
Q. This telegram is dated February 28th, 1956. Would you read that telegram, please?
A. This letter is from Meriden, Connecticut and it is signed by B. J. Tremaine, Jr., who is the President of the Miller Company. It is addressed to D. J. Miller, the President of Day-Brite Lighting, Incorporated. It gives the address and then:

> "Over a month and a half has passed since writing our letter of January 10, 1956 in reply to yours of December 21, 1955 regarding infringement of patent Stop. We requested prompt withdrawal of charges contained in your letter and any which may have been passed on to your representatives Stop We are concerned with the report from field that one of your representatives indicated suit was in progress Stop We [fol. 150] respectfully request an immediate communication regarding our request."

Mr. Mullin: That was Defendant's Exhibit 2 for identification.
Mr. Kraus: What was the number on that, please?
Mr. Mullin: Defendant's Exhibit 2 for identification.
Mr. Kraus: X-2.
Mr. Mullin: X-2 and the other was Defendant's Exhibit X-1.

By Mr. Mullin:

Q. Now, you read portions from two exhibits which your counsel tried to introduce, Plaintiff's Exhibit 26, I believe it is Plaintiff's Exhibit 27 for identification. One of them is a catalog sheet or an advertisement, rather. It is an advertisement. I am speaking of Plaintiff's Exhibit 26 for identification of the February, 1960 Electrical West, and I believe when you read that, you pointed out that "Best Looking Industrial Fluorescent Fixture Today."
Now, will you read the two lines directly below that?
A. (Reading:)

"New Reflector Aligner Clips."

Q. No, that isn't it. Directly below what you read. That is this (indicating).

A. (Reading):

"New Reflector Aligner Clips prevent light leaks."

Q. That still isn't it. I am talking about the one that is underlined.

A. (Reading):

"5 die-formed ribs provide maximum rigidity, straight rows."

Q. Now, referring to this All-Brite catalog sheet Exhibit No. 27 for identification in which you again read the portions referring to the appearance, do you see, there is a sketch of a reflector and with an arrow pointing to the rib? [fol. 151] What does it say just above that arrow?

A. (Reading):

"Reflector rib rigid reinforcement."

I believe we make similar statements in our advertising.

The Court: Let me take a five-minute recess for the lawyers. I have a motion coming up.

(Thereupon a short recess was taken.)

The Court: All right. Be seated, please.

By Mr. Mullin:

Q. Now, I again direct your attention to Plaintiff's Exhibit 22. Plaintiff's Exhibit 22 is this which shows all the other manufacturers. Now, looking at this Planned Lighting, Incorporated, of Philadelphia, are they a large company or a small company, or how would you rate them compared with Day-Brite?

A. Well, I think we should establish that Day-Brite—

Q. Just answer the question and then you can enlarge on it.

Mr. Ooms: If you know.

Mr. Mullin: And I would appreciate no coaching from the attorneys.

The Court: He may answer.

By the Witness:

A. Planned Lighting is a subsidiary of Herman Hassinger, and Herman Hassinger makes parts which they sell to a great number of other fixture assemblers, so I would say the cumulative effect—

Mr. Mullin: Your Honor, I must object.

The Court: I think he is within his bounds. They are a subsidiary of some other company. You asked for that answer.

Mr. Mullin: No, I asked, "How large is Planned Lighting Corporation compared to Day-Brite?"

By the Witness:

[fol. 152] A. Planned Lighting is a very small subsidiary of Herman Hassinger.

By Mr. Mullin:

Q. It is a small company?

A. Yes.

Q. But it is a subsidiary of a large company?

A. That is correct, who was making these reflectors for Planned Lighting.

Q. But who sells these reflectors, Planned Lighting?

A. Planned Lighting and also Herman Hassinger. We solved two problems with this one—

Q. You have answered the question. Planned Lighting is a subsidiary of Herman Hassinger—was that the name?

A. Herman Hassinger.

Q. And Planned Lighting is a small company? Now, Ender Monarch, is that a small company?

A. Moderate.

Q. Well, I understand that Day-Brite's annual sales are approximately twenty-five million. Do you have any idea of what Ender Monarch's sales are?

A. No.

Q. You have no idea whatsoever?

A. No, I haven't.

Q. But it is a medium-sized company, you say?

A. Yes, medium.

Q. And how about Harvstone Manufacturing Company, is that small, large or medium?

A. You are asking for opinions.

Q. Yes, and you are an expert, you are in charge of—

Mr. Ooms: Your Honor, we have not named him as an expert of other companies as to how large or small they are.

The Court: He is answering to the best of his judgment.

[fol. 153] By the Witness:

A. All right, moderate.

By Mr. Mullin:

Q. How about All Brite Fluorescent Fixtures of California; are they large, small or medium?

A. Moderate nationally, or medium.

Q. They are moderate as a national company?

A. Yes.

Q. Would you say that All Brite is larger or smaller than Harvstone, for example?

A. I don't know.

Q. Do you know whether it is larger or smaller than Ender Monarch?

A. Not having access to sales figures, I cannot relate them back.

Q Well, but you are in charge of new product design. Do you keep abreast of the industry in general?

A. You cannot keep abreast of a thousand competitors.

Q. I know, but do you try to?

A. No.

Q. You don't try to?

A. No.

Q. And you know nothing about their products, or anything?

A. I know that they brought out a product that was similar in appearance to the reflector in suit.

Q. Now, this All Brite Fluorescent Fixtures, you have filed a lawsuit against them?

A. That is correct.

The Court: He says so. It is pending. They are among those who refused to go along until there was an adjudication.

Mr. Mullin: That is right.

By Mr. Mullin:

Q. And when you filed that lawsuit, did you work with [fol. 154] the attorneys in preparing the complaint, and so forth?

A. I am fairly familiar with the complaint.

Q. And did you investigate All Brite Fluorescent Fixtures to determine whether it was a small or large company before you filed the lawsuit?

A. No.

Q. No? How about Gibson Manufacturing, is that small or large?

A. I do not know what their sales are. I am saying moderate because it is a guess. I have no idea whether they are large, small or—

Q. You have no idea whether they are large or small?

A. No.

Q. Have any of these, Wm. Penn Fluorescent Fixtures, and so forth—

The Court: He is giving you his best judgment without any qualification.

Mr. Mullin: That is what I am asking for, and he does not know evidently. He says they are moderate.

By Mr. Mullin:

Q. But do you know—

The Court: Well, he does know, being active in the field, and has an impression.

(Addressing the witness): Is that right?

The Witness: That is right, and I know that none of them are as large as Day-Brite.

The Court: He knows who is who but he has no intimate knowledge.

By Mr. Mullin:

Q. None of them, you said, are larger than Day-Brite or as large?

A. No one in the lighting fixtures business is as large as Day-Brite.

Q. And do you have any idea of how much it cost to file and prosecute a patent lawsuit?

[fol. 155] A. I am learning.

The Court: Do you mean paying the lawyers?

By Mr. Mullin:

Q. You are learning? Have you learned whether it is a considerable figure or not?

Mr. Ooms: Oh, your Honor, I think this is argumentative.

The Court: I know somebody said here some time ago, and it almost seems like a year ago, that the reason they did not prosecute them was because it is an expensive proposition and they did not want to go into it. He is not going to tell us that. We presume that these lawsuits are protracted and involved and it takes a lot of able lawyers.

Mr. Kraus: That is precisely the point. The Plaintiff was trying to make a very decided point that all of these people got out of the business because they were afraid of the patent. The point of this is to show that it wasn't fear of the patent but the cost of this expensive lawsuit which this Defendant has to undergo.

Now, those that are able to fight, those are little guys and—

The Court: I do not think that has any bearing on the case, with all due respect to your ability as lawyers in your particular field. Why a man goes out of business or a company goes out of business does not have anything to do with this or has no relevancy in this case.

Mr. Kraus: That was the point of this.

The Court: I am going to let it get in the back door because of commercial success and that is all. If or when it becomes admissible—I do not want to try your lawsuit, but your are going to be adjudicated primarily upon whether or not this is patentable or isn't and whether it is or is not infringed.

Mr. Mullin: That would be just exactly what we would [fol. 156] like.

By Mr. Mullin:

Q. Now, you testified this morning—

The Court: I want to correct the record to say that patentability sometimes is aided in the course of determination, by commercial success. It has some bearing on it. As to when it has or how much it has, it could tip over the scale when there is that much doubt.

Mr. Mullin: In a doubtful case.

The Court: I have read those cases. I will hear you some more.

By Mr. Mullin:

Q. Now, you testified this morning that Smoot-Holman and All-Brite in their advertisements refer to the function of the ribs, that they are to provide maximum rigidity, straight rows and strength. Now, you also—

Mr. Ooms: If the Court please, I do not like counsel here to testify. I do not think that is a proper question. He testified to more than just that. If he wants to ask him a question, I have no objection, but—

The Court: His answer may stand.

By Mr. Mullin:

Q. You also read this morning from Plaintiff's Exhibit 9, which is the CFI-10 booklet, referring to the fixture which you claim is embodied in the patent. You read one sentence there.

Mr. Ooms: The entire paragraph, counsel.

By Mr. Mullin:

Q. You read first the one sentence and then, upon being reminded, read the balance. The last sentence you read was that ribs also lend an unusual, distinctive appearance to the fixture.

Then you read the first part which related to the strength of the fixture. Now, can you tell me when that [fol. 157] particular pamphlet, Plaintiff's Exhibit 9, was published?

A. It was printed in November of 1954 by—I have got a paper back there that would authenticate or give the date.

Q. November of 1954? Well, I hand you—

Mr. Mullin: First, may this be marked Defendant's Exhibit O-1 for identification.

(The document was thereupon marked Defendant's Exhibit O-1 for identification.)

By Mr. Mullin:

Q. I hand you a publication called the Day-Briter, and I believe this was identified as the house organ of the Day-Brite Lighting Company—

A. Yes.

Q. And referring your attention to pages 6 and 7—

Mr. Ooms: Does that have a date, Mr. Mullin?

Mr. Mullin: Yes, it has a date, October, 1956.

Q. It shows a picture of a 358-pound man sitting on your fixture. I ask you if in this—directing your attention now to the left-hand column, I ask you to read that, please.

A. It says: "All CFI reflectors are reinforced by die-embossed ribs located between the apertures. Ribs are a Day-Brite first to add lateral stability, to prevent the reflector from spreading, help maintain straight fixture edges. Apertures are die-embossed, too, for increased reflector rigidity."

Q. And do you find in there this last sentence which you read from Plaintiff's Exhibit 9, the one that you say

was issued in 1954, about the appearance, that the ribs lent something to the appearance?

The Court: Do you mean before the patent?

Mr. Mullin: No, this was after the patent.

By the Witness:

A. No. This statement of unusual, distinctive—

[fol. 158] By Mr. Mullin:

Q. It is not in there?

A. It is not in the Day-Briter.

Q. Yes; and you are referring, are you not, to Plaintiff's Exhibit 4 for identification? (indicating)

A. Yes.

Q. You are referring to the ribs going across there? Is that what we read here?

A. Yes, but the complete rib is not there for the function of adding rigidity.

Q. But you were just reading what you just read from this about the rigidity and strength and that was referring to that rib, is that correct? (Indicating) I am referring now to Defendant's Exhibit O-1, which is your own house organ, your publication.

A. You are correct.

Mr. Mullin: Please mark this Defendant's Exhibit O-2, and so on.

(The said documents were thereupon marked Defendant's Exhibits O-2 through O-9, inclusive, for identification.)

The Court: We will recess until 2:00 o'clock, this afternoon.

(Thereupon a recess was taken to 2:00 p.m., of the same day, Tuesday, October 4, 1960.)

* * * * * * *

Court convened pursuant to recess.

Present:

Mr. Owen J. Ooms, Mr. Malcolm S. Bradway, Mr. [fol. 159] Frederick M. Woodruff, on behalf of Plaintiff;

Mr. Eli Mullin, Mr. Max Kraus, Mr. Sidney J. Goldstein, Mr. David Kaufman, on behalf of Defendant.

(Thereupon the following further proceedings were had herein:)

Leo George Stahlhut, a witness on behalf of the Plaintiff, having been previously duly sworn, resumed the stand, was examined and testified further as follows:

Cross examination (continued).

By Mr. Mullin:

Q. Now, Mr. Stahlhut, this morning you testified that the Day-Briter of October, 1956, Defendant's Exhibit O-1 for identification and which showed this picture of a heavy man sitting on a reflector, contained language describing the function of the ribs saying that the ribs are added for lateral stability to prevent the reflector from spreading, to help maintain straight fixture edges, apertures are die-embossed too for increased rigidity, and that it did not contain the statement which was contained in Plaintiff's Exhibit 9.

The Court: You have gone over this this morning.

Mr. Ooms: I was just going to say, are we testifying or are we asking questions on cross?

Mr. Mullin: I am sorry. I was just trying to refresh his recollection.

The Witness: May I see that brochure, that last exhibit?

Mr. Mullin: I am all finished with that.

The Witness: I would like to refresh my memory.

[fol. 160] Mr. Ooms: He wants to be sure he said what you said he said.

The Witness: I had an opportunity to examine this brochure a little more closely and this 358-pound man is not sitting on the reflector in suit. It is a CFI-25 reflector and I think that should be corrected.

By Mr. Mullin:

Q. He is sitting on a CFI-25 reflector?

A. Yes. It clearly states it in there.

Q. But, your illustration here on the next page shows both the CFI-10 and the CFI-25, is that correct?

A. That is correct, and I believe the CFI-25 has more rigidity than the CFI-10.

Q. But the statements here about the functionality of the ribs which is positioned directly below a reflector which at least to me looks like the CFI-10—and you can correct me if I am wrong—that statement is as was stated and pertains to that reflector, is that correct?

A. This brochure states that:

"All CFI reflectors are reinforced by die embossed ribs located between the apertures," and I think we have to recognize or certainly I, as a co-inventor have to recognize, portions of the ribs were functional and portions were not functional—they were put in for a decorative effect, for ornamentation, for appearance, to give the product a distinctive appearance.

Mr. Mullin: I move to strike the latter part of the answer.

Mr. Ooms: I think it is responsive.

The Court: I will let it stand.

By Mr. Mullin:

Q. I now hand you Defendant's Exhibit O-2, for identification, which is entitled "Illuminating Engineering, November, 1954," and this is a publication of the journal of the Illuminating Engineering Society containing a two-[fol. 161] page—what appears to be an advertisement of the Day-Brite Company.

I direct your attention to this column here which is entitled "New Rib Construction," and ask you to read that, please.

A. This particular illustration shows a CFI-25 reflector.

Q. I am not talking about the illustration. It also refers to the CFI-10. I am just asking you to read what is stated there.

A. It states; the copy under the illustration of the CFI-25 reflector states:

"New Rib Construction reflectors reinforced by die-embossed ribs between the apertures. Ribs add lateral stability, prevent spreading, maintain straight fixture edges."

We have been talking about rigidity in our industrial promotional material.

Mr. Ooms: Your Honor, I think we are talking about the CFI-25. He is objecting to our referring to it, and then he is asking him to read from it.

Mr. Mullin: Your Honor, this is their specific—it covers specifically the CFI-10 and the 25. I don't know which one is referred to, which the language refers to. Both are covered.

Mr. Ooms: It only shows the CFI-25, under which this language is quoted.

Mr. Mullin: The other one showed it, too, the CFI-10.

The Court: Proceed.

Mr. Mullin: Are you through reading that?

By Mr. Mullin:

Q. You were referring to these ridges here, these ribs going across here (indicating). Is that what that refers to?

A. No.

[fol. 162] Q. What does it refer to?

A. In the course of the last two days, we have been calling everything from a little bead an inch and a half long to something continuous across the top of the fixture a rib. You can have ribs that have this appearance; the rib, the portion of the ribs which is the function of the reflector, extends between the apertures.

Q. Just between the apertures?

A. That is correct, perhaps an inch and a half or just a little beyond the aperture.

Q. Could you point that out here (indicating)?

A. May I get off the stand?

Q. Here. I will bring it to you.

A. When you take a reflector like this and you put apertures in there, you have weakened the middle. From a

functional standpoint or an engineering standpoint we could have terminated the rib within a quarter of an inch or a half an inch beyond the apertures and restored the rigidity.

We heard Mr. Hodges testify in his deposition to that effect this morning. He also testified that the—

Q. We are not worried about Mr. Hodges' testimony. Just tell us what your testimony is. That's all you have to testify to.

A. The rib from between the two red marks is what I would term functional. The rest of the rib is for decorative purposes. It is for ornamentation, to distinguish this product from any we have made in the past or from any of our competitors'.

Q. Have you always maintained that position, Mr. Stahlhut?

A. To the best of my knowledge, we have.

Q. You have always maintained that the only functional portion is the part that is shown here between the two red marks going across on Plaintiff's Exhibit 4?

[fol. 163] A. I don't know what you are getting at, but, we have—

Q. Never mind. Just answer my question.

A. We have recognized that you can obtain the same functional equivalent across the center section by another design of ribs and it is in evidence in the Planned Lighting, that is, where they took a consent decree, where they paid fifteen hundred dollars in damages and they also changed a product which had functional ribs, but it didn't have the same appearance.

Q. Now, you have made some statements here in which you have stated that the only functional portion of the ribs is the part that goes across the top of the reflector between these two red lines, is that correct?

A. To my knowledge, that is what I believe.

Q. You stated that you had maintained that position throughout?

A. I believe so.

Q. Now, were you the co-inventor or the co-applicant on a mechanical patent application which was filed at the same time that you filed your design patent application

and which is identified as Defendant's Exhibit Q, which I will ask the Reporter to mark for identification.

(The document was thereupon marked Defendant's Exhibit Q for identification.)

Mr. Ooms: I am going to have to object to the introduction of another application in suit, your Honor. Every time we mention it they object to it. They objected to the CFI-25. Just a moment, Mr. Kraus.

Mr. Kraus: I wasn't going to—

Mr. Ooms: Furthermore, that is a patent application covering a mechanical feature. As such, it has nothing at all to do with the design characteristics of the patent.

[fol. 164] The Court: Has that issued or not issued?

Mr. Ooms: Not issued, your Honor.

Mr. Mullin: Your Honor, this application has been stipulated in our stipulation covering the mechanical application and all of the contents and I am using this to show that he made statements. If you will permit me to continue with the cross examination, I will show he made statements contrary to what he has just testified.

Mr. Ooms: I will disagree, but, first of all, all of these exhibits were stipulated to but, the materiality of them was held in reserve and, I say it is not material at all.

Mr. Mullin: Your Honor—

The Court: For impeachment purposes, I must allow it.

Mr. Ooms: If he wants it for impeachment purposes, fine. That's all.

Mr. Kraus: We want to introduce it later on, also—

Mr. Ooms: Oh, I am going to object to this.

The Court: I don't know what is going to be introduced later. Right now it is for impeachment purposes.

By Mr. Mullin:

Q. Now, did you answer that "yes" that you were the co-applicant on this mechanical patent application?

A. I am the co-applicant with Mr. O. W. Klingsick.

Q. You were the co-applicant?

A. Yes, sir.

Q. Did you sign the application that was filed on Exhibit Q, Defendant's Exhibit Q?

A. I mentioned the application was filed, that I was the co-owner, yes.

[fol. 165] Q. And you signed it?

A. Yes.

Q. Did you read it before you signed it?

A. As best as I am prepared, yes, sir.

Q. And then, are the statements that are contained in this application correct, to the best of your knowledge?

A. To the best of my knowledge they are correct.

Q. I will hand this to you and you can follow this with me. I have some pages here.

Mr. Mullin: Will you identify this as Defendant's Exhibit Q-3.

(The document was thereupon marked Defendant's Exhibit Q-3 for identification.)

By Mr. Mullin:

Q. This Exhibit is Defendant's Exhibit Q-3 for identification and is a reproduction of a page taken from that File Wrapper. It is page 12. I direct your attention to page 12.

A. Where are these pages numbered? Oh, I see.

Q. These numbers here (indicating).

Claim 1, it is part of your application, beginning with the part after the semicolon, which reads as follows:

"... and means adapted to stiffen said reflector body against warp and twist, including flanges formed about said body openings and ribs extending across a longitudinal light reflecting wall and into each of said side walls."

Are these the side walls shown here in your Plaintiff's Exhibit 4?

A. That is correct.

Q. Do the ribs extend down into the side walls?

A. The statement doesn't say "down into the side walls."

[fol. 166] Q. What does it say?

A. It says:

"... ribs extending across said longitudinal light reflecting wall and into each of said side walls."

Q. " . . . into each of said side walls." And, would you say the portion you have marked here—does that portion only extend into the side walls?

A. I believe so.

Q. It does?

A. To me, the apertures—the area between the apertures is the center portion. The area outside of the apertures is a side wall.

Q. Are you speaking of the—what portion of the apertures are you referring to? Well, is it the inner side or the outer side or what?

A. This, I would say, would be the center section of the reflector (indicating). This (indicating) from the outer edge of the aperture, down, would be the side wall of the reflector.

Q. The outer edge of the aperture down, would be into the side wall, is that correct?

A. To me, I believe this would be a proper definition.

Q. So, then, you are saying that when you stated that these only extended across the top, what you meant is that little portion, a little portion of it did extend down into the side wall, is that right?

A. What we were defining was—

Q. Just answer the question "Yes" or "No" and then explain it.

The Court: I think you are bickering with the witness. It speaks for itself. It is obvious to the Court.

Mr. Mullin: All right. Thank you.

[fol. 167] By Mr. Mullin:

Q. Directing your attention now—oh, excuse me.

Mr. Mullin: Miss Reporter, will you mark this as Defendant's Exhibit Q-6.

(The document was thereupon marked Defendant's Exhibit Q-6 for identification.)

Mr. Ooms: Counsel, will you tell us what your exhibits are so we can mark them down? I have to follow.

Mr. Mullin: I will call this out to you—

Mr. Ooms: Thank you.

Mr. Mullin: —as I did in the other one. This is Defendant's Exhibit Q-6, which is a reproduction of page 47 of the File Wrapper and I will ask:

By Mr. Mullin:

Q. I direct your attention to the middle of the third paragraph in which, it reads as follows:

"The unit is provided with means to retain the spacing of the side surfaces in fixed relationship, such means including rib portions in each side surface extending transversely from the spaces between the apertures outwardly and downwardly into the side surfaces to substantially fix the form thereof."

A. That is stated here.

Q. That is stated there?

A. Yes.

Q. So that portions of the ribs which extend outwardly and downwardly into the side surface are there to substantially fix the form thereof?

A. I believe that we could have turned the ribs downwardly without going all the way down to the lower edge of the reflector.

Q. I am just asking you if the statement you made there is correct.

[fol. 168] A. Well, you say, "Is the statement correct" and then you pick up a reflector.

Q. I am asking you—

A. I am challenging what you are implying when you hold up the reflector.

Q. Tell me in your own words, then. Here is a reflector right before you. Now, read that and point to the parts that you made.

A. Here it says that the "unit is provided with means—" Would you like—

Q. Go ahead.

A. (Reading):

"The unit is provided with means to retain the spacing of the side surface in fixed relationship."

Q. Let us stop there just one minute so that the Court will understand. These are the side surfaces (indicating)?

A. That is correct.

Q. And there are means there to fix these in permanent relationship so they don't bend in or out or change their position, is that correct?

A. Portions of the ribs—

Q. No. I am just asking you if there is means there. The word "means" is a broad term. I am just asking you if there are means to do that.

A. A section or a portion of the rib provides means to fix that reflector in lateral relationship.

Q. Yes.

A. It says—

Q. "Such means including"—

A. "Such means including rib portions in each side surface extending transversely from the space between the apertures outwardly and downwardly into the side surfaces."

[fol. 169] Q. Now, what would you say "outwardly and downwardly into the side surfaces" meant?

A. Well, I believe we will find that the horizontal surface actually doesn't even come out to the edge of the aperture; that the reflector, or side has actually taken a downward curve before it gets to the extremity of the aperture. This rib here could, by a proper design, extend downwardly into the side of the reflector. It doesn't have to go down as close to the bottom as ours and provide the appearance that it does.

Q. You say that this quarter of an inch that extends from the outer edge of the slot outwardly and downwardly is what you meant when you were talking there, is that correct?

A. No.

Q. What you stated in the file wrapper?

A. What I stated here, this construction, the ribs extending to approximately where I have indicated here could conform to what is stated in the application.

Q. Is that what you were referring to when you stated in the application that this quarter of an inch to the out-

ward edge of the slot, that portion, to that part you have marked in red pencil?

A. This is the construction of the product or the way we had visualized it.

Q. Just answer "Yes" or "No." Is that or is that not the portion you were referring to when you stated that?

A. I wouldn't say that this is the exact dimension we had in mind, but, we definitely didn't have in mind that these ribs would have to go all the way down as close to the lower edge of the reflector, as we finally manufactured. All of the other people are making products of a similar design.

[fol. 170] Q. Are the drawings of the mechanical patent application, specifically Figures 1, 2 and 3, the same as the drawings in the design patent application. There are copies. You can put them back.

A. The fixture that you have in hand is substantially what is shown on this patent drawing, but, this is—

Q. No, that isn't the question. I asked you, Mr. Stahlhut, I asked you whether the drawings of the mechanical application are the same as the drawings, at least those three figures that I mentioned, are the same as the drawings of the design application?

A. I haven't been able—

Q. Here they are.

Mr. Ooms: Your Honor, we will stipulate that they are.

Mr. Mullin: All right.

Mr. Ooms: This is pure argument. Unfortunately, I think counsel, because he knows that your Honor has not had a great deal of experience in patent suits, is trying to make your Honor draw that there is something improper in doing this. This is a common thing where one tries to cover—

The Court: I will listen to you when your turn comes.

Mr. Ooms: This is pure argument.

Mr. Mullin: First of all, I feel your Honor knows a lot more about patent cases than counsel thinks.

Mr. Ooms: No, no, I wasn't saying—

The Court: Each side will have a chance to straighten me out if I am wrong.

Mr. Mullin: I am merely trying to point out this man made statements before on which he is now changing his testimony.

Mr. Ooms: You can show that but I don't think the record will show that.

[fol. 171] By Mr. Mullin:

Q. Well, it is agreed then that the drawings of the mechanical application and the drawings of the design application are the same; is that what you stipulated to?

A. No, there are some drawings—there were more drawings in the mechanical application. There are some drawings that—

Q. I will amend that as I stated previously, Figures 1, 2 and 3 are the same as Figures 3, 4, and 5?

A. They are substantially the same.

Q. Yes. All right. Now—

Mr. Ooms: We will stipulate that they are the same, the mechanical and design, and that the statements made there by counsel, as read into there, were statements made to the Patent Office. We will reserve the rest as to argument as to the propriety of not because it is a mechanical application and not a design application.

By the Witness:

A. (Continuing) I believe there is a very important point that—

Mr. Mullin: Your Honor, there is no question pending.

Mr. Ooms: That is right.

The Court: No question is pending.

By Mr. Mullin:

Q. Can you tell us what happened to this mechanical patent application? I am referring now to Defendant's Exhibit Q.

Mr. Ooms: We will stipulate it was never issued. It has nothing to do with this lawsuit. I will be happy to stipulate that.

Mr. Mullin: And that the Board of Appeals upheld the ruling?

Mr. Ooms: Absolutely, and the Board after that. It was never issued.

[fol. 172] Mr. Mullin: Now, we have here a number of other publications with various dates, 1954, 1957, et cetera. I can introduce these separately. These all are to the same point. He is speaking about the functionality of the ribs.

Mr. Ooms: Counsel, I may be able to stipulate if you show them to me, if you want me to, unless you want the witness to—

Mr. Mullin: We are going to introduce them so we may as well mark them now.

Mr. Ooms: You are identifying them now?

Mr. Mullin: That is right. They have already been marked for identification as Defendant's Exhibits O-3, O-4, O-5, O-6, O-7, O-8, and O-9.

By Mr. Mullin:

Q. You may look all of these over and then advise me whether or not the statement that you are referring to, the function of the rib construction, is correct?

A. These are all Day-Brite catalog sheets, promotional brochures or advertising. I did not make these statements.

Q. You did not make the statements?

A. No.

Q. But these are the statements of your company, of the plaintiff, the Day-Brite Corporation?

A. Well—

Q. Well, yes or no? Are they?

A. It is in printed words under the Day-Brite name; yes.

Q. So you are not denying then that these are the statements of the Day-Brite Corporation?

A. The company has published statements to that effect.

Q. Of course. Now—

Mr. Ooms: May I see them?

Mr. Mullin: As a matter of fact, most of them have [fol. 173] already been stipulated as genuine.

By Mr. Mullin:

Q. Now, at the time you filed this patent application, and I am referring now to the patent in suit, your first action—well, let me get this.

Mr. Mullin: May this be marked Defendant's Exhibit P for identification?

(The document was thereupon marked Defendant's Exhibit P for identification.)

Mr. Mullin: Then mark this Defendant's Exhibit P-1 for identification.

(The document was thereupon marked Defendant's Exhibit P-1 for identification.)

Mr. Mullin: This File Wrapper has also been stipulated to, your Honor.

By Mr. Mullin:

Q. I hand you Defendant's Exhibit P for identification, and refer you to the File Wrapper on page 4.

Mr. Ooms: Is this on the CFI-25 again?

Mr. Kraus: No, this is the patent in suit.

Mr. Ooms: Oh, fine. Excuse me. I did not hear.

By the Witness:

A. I have page 4 now.

By Mr. Mullin:

Q. Do you know what that page is, page 4?

A. Well, I don't know what action it is but it is the Patent Office's rejection.

Q. The Patent Office's rejection? Were you shown this Patent Office rejection or were you advised about it by your attorneys?

A. Yes. They normally pass these on to me.

Q. And stated in there is the statement of the Patent Office Examiner, who stated in rejecting the patent, he said:

[fol. 174] "The design appears to be substantially anticipated by the reflector designated by the numeral 10 in the patent to Abernathy."

Mr. Mullin: I showed your Honor the one patent yesterday cited by the Patent Office, the Abernathy patent, which showed the curved configuration and the slot.

By Mr. Mullin:

Q. Then he goes on further:

"The four cross ridges on the underside, as shown in Figure 1, have been considered but these appear to be purely for mechanical purpose of stiffening the reflector and no ornamental significance can be attributed thereto."

Now, at that point you were shown this Patent Office action. What, if anything, did you tell your attorney as to any other fixtures which you might have known about which had ridges?

A. Well, No. 1, my reaction to the Patent Office's comments were that they pointed out that the ribs were functional and I felt exactly the same, as I have discussed here before, that portions of the ribs are functional, portions are non-functional.

As far as the Abernathy patent that was cited, I saw no similarity in the Abernathy patent.

Mr. Mullin: He is not responding to my question, your Honor.

Mr. Ooms: You asked him what he told his attorney. He is telling you.

By Mr. Mullin:

Q. What did you tell your attorney?

A. That is it, that I felt that the examiner was wrong, that there were portions of these ribs which were non-[fol. 175] functional and I did not see any similarity between the product which we were applying for and the Abernathy patent.

Q. Did you tell him about this prior "Day-Brite Day-Line" fixture having these ridges across the top? (Indicating)

A. Not on the design application because we see no similarity in the product. The over-all effect is completely different.

Q. But you will notice that the Court there rejects it on the grounds that the cross ridges are functional even though they are not shown in the prior art. In other words, the Court was saying that because they did not find any prior art with ridges, the only rejection they could make was on the basis of functionality.

Mr. Ooms: I will object. That is pure argument on what he is deducing from that.

The Court: Yes.

By Mr. Mullin:

Q. But did you at that time understand that the Court was—

Mr. Ooms: You mean the Patent Office.

By Mr. Mullin:

Q. (Continuing) —that the Patent Office was claiming that they could find nothing with ridges?

A. Not at all.

Q. What did you say?

A. I am sure there are patents—well, in the mechanical patent they cited, ribs are functional.

Q. I am talking about the design.

A. All you can assume is that the Patent Office—don't they use the same references for design or mechanical?

[fol. 176] Q. Well, just tell me whether or not the Patent Office at that time said anything about any prior art having ridges.

A. In this rejection—

Mr. Ooms: Your Honor, I am going to object to this again as argument.

The Court: The objection is sustained. I think the wrapper speaks for itself.

Mr. Mullin: All right.

By Mr. Mullin:

Q. Did you tell your patent lawyer about the existence of the CFI "Day-Line" fixture?

A. Our attorney has always known about all of our products.

Q. Your attorney knew about this CFI "Day-Line" fixture with the ridges across here? (Indicating)

A. Certainly.

Q. He did?

A. (Witness nodding head.)

Q. Do you know whether the Patent Office was ever advised that there was such a reflector in existence?

A. I don't believe so.

Q. You don't believe so? All right. May I have that paper back?

A. Yes.

Q. Now, I believe this morning on direct testimony you stated that these charts showing industrial lighting sales were prepared under your direction or by you—I think you said by you?

A. Yes, I prepared these charts.

Q. From actual sales figures?

A. Which were supplied me.

Q. Which were supplied you? But you know that those [fol. 177] figures were the correct figures for the corporation, is that right?

A. They were furnished me as correct.

Q. Yes, yes; and—

Mr. Mullin: Please mark this Defendant's Exhibit Y for identification.

(The said document was thereupon marked Defendant's Exhibit Y for identification.)

Mr. Mullin: This is Defendant's Exhibit Y for identification, which is a compilation of figures which was furnished during a deposition by the attorney for the plaintiff,

and refers to sales figures of CFI-10 and 15 during the years 1956, '57, '58, and '59, and to total industrial fixtures during the same years.

By Mr. Mullin:

Q. Now, I believe also that the chart shows that total industrial fixtures—sales of total industrial fixtures during the year 1956 was $3,811,997. Now—

Mr. Mullin: Will you mark this Defendant's Exhibit Q-10 for identification.

(The document was thereupon marked Defendant's Exhibit Q-10 for identification.)

By Mr. Mullin:

Q. Now, I hand you back Defendant's Exhibit Q, which is the mechanical File Wrapper Application again, and refer you to page 130 of the File Wrapper. Page 130 of the File Wrapper is page 2 of an affidavit by James F. Whitehead, at that time Executive Vice-President of the Day-Brite Lighting, Inc. and now President of the corporation.

The last paragraph reads:

> "That the business done in 1956, the second year of [fol. 178] sales of CFI fixtures, amounted to $4,029,000," and that is referring only to CFI fixtures and not to the total industrials.

Now, did both those figures come from the same source?

A. I don't know without checking them. First of all, it says that the business done in 1956—

Q. Well, you have answered the question.

Mr. Ooms: Just let him answer.

Mr. Mullin: He answered it already. If he wants to enlarge on it he may go ahead.

By the Witness:

A. (Continuing) "The business done in 1956, the second year of sales of CFI fixtures, amounted to $4,029,000."

In other words, we mentioned before that there are other industrial fixture lines.

By Mr. Mullin:

Q. Yes.

A. And I believe that this figure would include both CFI-10 and 25 and other fixture lines.

Q. Yes.

A. I believe that $4,029,000 in 1956—well, over here we have $3,958,000 or almost four million dollars.

Q. Well, then you are saying that the CFI is not the total of the industrial sales?

A. No; we stated here that the CFI-10 and 15 is 80 per cent or 80.5 per cent.

Q. Yes; and Mr. Whitehead said that the CFI sales were $4,029,000?

A. No.

Q. What did he say?

A. The business done in 1956, the second year of sales of CFI—

[fol. 179] Q. Yes.

A. That is substantially the same.

Q. Four million? Here you are saying that the total on this figure that you have used there is $3,811,000 and—

A. I don't know. Let me see the figures.

Q. Yes. The figures are the same as you have up here.

A. $4,029,000 is our total industrial business.

Q. Yes.

A. The three million—

Q. No, that isn't the figure I am referring to. I am referring to the total industrial.

A. All right.

Q. The total industrial right here (indicating). What is that figure?

A. $3,811,000.

Q. So that your total industrial was $3,811,000 on one and on the other it is four million-something?

A. I can explain that. This continuous red line is the figures which we report to NEMA on shipments, and the page which we have furnished Mr. Mullin is orders re-

ceived. There would naturally be a difference in shipments and orders received.

That is why in order to save time we did not discuss—if you notice from 1956 there is a very fine black line on the chart and a fine black line is orders received from the figures that are in that particular paper (indicating).

This red line is shipments which we have reported to NEMA. The reason we use the two sets of figures is we have no set of sales figures going back beyond 1956. The only way we could give the history of our industrial line was to go to our NEMA sources.

Q. And you are referring here to the 1956 figures?

A. We are referring there to orders received, which are for the years '56, '57, '58 and '59. I believe you will find [fol. 180] that those figures correspond to the bars. I believe that you will find that those figures correspond to this fine black line (indicating).

Q. In other words, these figures here are the NEMA figures, is that right?

A. Reports of shipments.

Q. Reports of shipments?

A. That is correct.

Q. And the figures you are using here are the orders received, is that right?

A. In order to properly convey the story—

Q. Well, just answer; is it or isn't it?

A. Yes, we have figures which report shipments and we have figures which report incoming orders.

Q. But you use them interchangeably? All right. Now, you are in charge of new product development, and so forth. Are you familiar with the advertising and promotion as well as the sales of your products?

A. I see most of the promotional efforts.

Q. Now, do you know approximately how much you spent in advertising CFI-10 fixtures during the years from about '54 through the present for each year?

A. We have no breakdown on advertising for the industrial fixtures.

Q. You have no breakdown for advertising on the industrial fixtures? How are your figures broken down?

A. Well, we know that we have spent an average of two and a half per cent of our sales dollar for advertising and promoting all of our fixtures.

Q. All of your fixtures?

A. And industrials are probably about 20 to 25 per cent of our business.

[fol. 181] Q. Have these sales figures increased or decreased, say, from the date of the introduction of your CFI-10 on the market to the present?

A. What figures do you mean?

Q. The sales figures.

A. Well, the sales figures have increased from 1954 to 1957, and then there was a drop.

Q. Well, prior to the introduction of this fixture when you were still selling the CFI "Day-Line", Plaintiff's Exhibit 12, how does the advertising costs compare, that is, before when you were advertising the CFI "Day-Line" and after when you were advertising the CFI-10?

A. Well, industrial business has always been a very poor segment of our over-all business. I would say the expenditures were equal.

Mr. Mullin: Your Honor, I would like the witness to be cautioned again just to answer.

By Mr. Mullin:

Q. Will you just answer the question?

Mr. Mullin: Would you read the question again, please.

(Question read.)

By the Witness:

A. I have no breakdown. I do know that we have promotional brochures and Day-Briters and catalog sheets on the CFI "Day-Line" as well as this new industrial fixture.

By Mr. Mullin:

Q. Well, isn't it a fact that when you introduced the CFI-10 you increased your budget for advertising tremendously?

A. No, not to my knowledge.

Q. Not to your knowledge?

A. We promote any new product.

[fol. 182] Q. Well, how can you say not to your knowledge when you don't know what the figures are? You just testified that you did not know.

Mr. Ooms: You are asking him the question. He says he does not know except that it has been continuous.

The Court: I will let it stand.

Mr. Mullin: That is all, your Honor.

Mr. Ooms: I have just a couple of questions.

Redirect examination.

By Mr. Ooms:

Q. On cross examination you were referred to a Miller letter and telegram. Do you recall that, Mr. Stahlhut?

A. Yes, I do.

Q. I believe it is Defendant's Exhibit X-1 and X-2. Do you know what type of fixture was being manufactured by Miller, what it was similar to?

A. The fixture we had in mind when we wrote the letter of infringement was a fixture similar to our CFI-25.

Q. In other words, the fixture not here in suit?

A. That is correct.

Q. Are you familiar with the Patent Office prosecution in so far as what an Examiner does when he makes a search or when he does not make a search?

A. No, I am not too thoroughly familiar.

Q. You don't know then whether he can assume there are certain pertinent prior art and when he does not assume there is certain pertinent prior art?

A. We have no idea of it, other than that which they cite.

Mr. Ooms: No further questions.

Mr. Mullin: No questions.

The Court: You are excused.

(Witness excused.)

[fol. 183] The Court: Call your next witness.

Mr. Ooms: Mr. Lawrence Blazey.

Lawrence Blazey, called as a witness on behalf of the Plaintiff herein, having been first duly sworn, was examined and testified as follows:

Direct examination.

By Mr. Ooms:

Q. Will you state your name and address, please?

A. My name is Lawrence Blazey, B-l-a-z-e-y. I live at 537 Juneway Drive, Bay Village, Ohio.

Q. Will you kindly speak up so counsel here can hear you.

Now, what is your occupation in life, Mr. Blazey?

A. My occupation is a consulting industrial designer.

Q. And how long have you been in that business?

A. Approximately twenty-two or twenty-four years.

Q. Before going into that, will you tell us what your formal education has been?

A. I have had an engineering course in Fenn College in Cleveland; I am a graduate of the Cleveland Institute of Art on a scholarship; studied abroad at the University of London; took refresher courses in engineering in Fenn College; have taken a postgraduate course at Cranbrook College on ceramics and have engaged in continuous study in my profession and other professions since then.

Q. Tell us what work, as completely and yet as succinctly as possible, you have done in the industrial design or styling field?

A. My work in the industrial design field has encompassed a great variety of products. I can only skip to a few highlights and say that they include desks for offices, printing equipment, machine tools, household products, [fol. 184] household utensils, some lighting fixtures, and plastic products, et cetera.

Q. And have you been in any particular form of business partnership, individually, or what?

A. I was co-founder of Designers For Industry, Incorporated, in Cleveland, Ohio. That was in 1936. They were engaged in the practice of industrial design up until the time of the war. Since then the business has increased in the proportion of engineering and product development work.

I left the company in 1952 to engage in private practice.

Q. And you have been engaged in private practice in the field which you have just described?

A. Yes, I have.

Q. Are you a member of any industrial organizations relative to industrial styling or design?

A. I am a member of the Industrial Designers Institute, a national institute, one of two in the United States.

Q. And do you take active part in that organization?

A. I take active part and I am a member of the Design Protection Committee of the Industrial Designers Institute, for the purpose of carrying over information from the design profession into the legislative session which is now in the enactment of this particular law.

Q. And how long have you been active in that regard?

A. This particular function has been active about a year and a half.

Q. And you have been active in that?

A. I will take that back; about a year.

Q. Are you listed in any publications?

A. I am listed in Who's Who in America in the Fine Arts, and I was listed in the Business Directorships in 1948 and 1952.

[fol. 185] Q. Are you at present a member of any civic committees?

A. I am also at the present time, and have been for about fourteen years, a member of the Fine Arts Advisory Group of the City of Cleveland for the purpose of directing the aesthetics on city properties.

Q. Can you very briefly tell us, what is industrial styling and design and its importance as to product research, and so forth?

A. Industrial design in its present form is a means of expression aesthetically to complement the engineering

function of a product to enable it to be identified by a manufacturer as a proprietary item and to increase the sales thereof by appealing to the aesthetic tastes of the consumer.

Q. Are you familiar with an industrial fixture known as the CFI-10?

A. Yes, I am.

Q. Made by the Day-Brite Lighting Company?

A. Yes, sir.

Q. Have you had occasion to study it from an industrial styling or design point of view?

A. I have, sir.

Q. And what conclusions did you reach as a result of such a study?

A. My conclusion was that it represented a deliberate attempt to imitate the CFI-10—

Q. No, I am talking about the Day-Brite fixture.

A. Oh, I beg your pardon. The Day-Brite fixture was a complete intent to perform a function of design for identity purposes in the trade.

Q. Can you specify what elements in your mind bring this particular styling or design out?

[fol. 186] Mr. Kraus: Your Honor, I think this whole line of testimony is a thing that the Judge is going to decide. He is giving his opinion.

Mr. Ooms: That is right.

Mr. Kraus: The whole question as to the point of novelty, as to whether there is invention in this whole thing, is strictly for the Court to decide, not for an expert to say what has been done. I think this is all immaterial to the issues here in this Court.

Mr. Ooms: Before I rejoin, maybe Mr. Mullin would also like to add something to this.

Mr. Mullin: I would just like to add, your Honor, that this is a design patent involved here, and it is nothing very complicated. Usually experts are introduced where there is something complicated that a Judge may not be able to see, something technical, but this is just a matter of appearance.

The Court: Sometimes they describe what the Judge can't see. I am going to let him answer. It can't do me any harm. Maybe it will help us.

Mr. Ooms: Please read the last question.

Q. (Read by the Reporter.)

By the Witness:

A. The elements in the CFI-10 fixture are exemplified by several means, some of which include the characteristic rib which is predominant, the spacing of the rib, the over-all effect in its unity as applied to an installation which is usually an installation in a large area which has a definite bearing on the individual design imparted in the fixture, and also the number of slots, the size of them, the location of them and the requirements of good proportion and rhythm in the entire reflector.

Q. What do you mean by a good proportion and rhythm? [fol. 187] A. That is a term which is possibly ambiguous in the sense that it takes a person trained in esthetics to determine whether a fixture is in good proportion or bad proportion as far as spacing and composition is concerned.

Q. Now, do these ribs you are referring to,—what are they specifically that you are referring to in the structure?

A. They have two functions, one of beauty of rhythm and a functional purpose of allowing up-lighting,—

The Court: Allowing what?

The Witness: Uplighting.

By the Witness:

A. (Continuing) —and also to perform a function of providing an interesting pattern.

The Court: For symmetry?

The Witness: Symmetry of pattern, yes.

By Mr. Ooms:

Q. Now, refer to the rib across the top. (Indicating.) Does that have a function?

A. Yes, sir, there is a function inherent in the rib laterally.

Q. And where is that rib functional?

A. The rib is only functional across the flat surface and slightly over the curve.

Q. Why is that so?

A. Sheet metal has to be ribbed or dented in order to be rigid, thus allowing a thinner piece of metal to be used.

Q. Now, drawing your attention to the ribs down the side of the fixture almost to the bottom, is that portion of the rib functional? (Indicating.)

A. That is not functional; that is purely decorative.

[fol. 188] Q. I believe you spoke about a continuous open area in connection with your answer on rhythm. What did you mean by that?

A. The proportion of the openings in the reflector and the necessary spacing of the ribs are concurrent in the effect that they give in a straight line when it is installed in an industrial site.

Q. You mean when the reflectors are put end to end and in a large line, is that what you mean?

A. That is right. In other words, let me say this, that the length of the uplighting openings can be varied to suit any degree of pattern that is implied on the side line of the ribs.

Q. Now, can a particular reflector like this—does it admit of any other different type of rib to obtain exactly the same function that one desires in this fixture?

A. You are speaking of the CFI-10?

Q. I am saying, can you place into any industrial reflector any other types of ribs than are put in here and still obtain the same function which you obtain with this reflector?

A. You can, definitely.

Q. Did you at my request just make a few illustrations of that?

A. I did, sir, which can be shown to the Court.

Mr. Ooms: Mark these 28, 29 and 30, please.

(The drawings were thereupon marked Plaintiff's Exhibits 28, 29 and 30 for identification.)

Mr. Ooms: I have had the Court Reporter mark as Plaintiff's Exhibits 28, 29 and 30 certain sketches.

By Mr. Ooms:

Q. Are you familiar with those sketches?

A. I am, sir.

[fol. 189] Q. Will you first tell us who made those sketches.

A. I made these sketches myself at your request.

Q. And refer to the sketch on Figure 28 and tell us whether that particular reflector there would give the same function as the CFI-10 and whether it is esthetically or symmetrically or rhythmically—whether it would have the same effect as the CFI-10 reflector.

The Court: Isn't that approximately the same as the exhibit there that your company made prior to—

Mr. Ooms: This one, your Honor? (Indicating.)

The Court: That is the one.

Mr. Ooms: No, I think you will find out there is a great deal of difference.

By the Witness:

A. Those are only across the flat surface. I have carried these ribs over the corner, which is a necessary functional part, and elaborated on it by putting a depressed area of metal around it to still reinforce it and give it a decorative effect. So this particular portion is an identifying feature on a line of fixtures.

By Mr. Ooms:

Q. In your opinion, would that design—

A. This is particularly decorative and would be equal to the CFI-10.

Q. Functionally?

A. Functionally.

Q. And what about esthetically?

A. As well as esthetically.

Q. Now, do you have another one?

A. I have No. 29.

The Court: Let me ask a question: Is it admitted that this would not be patentable?

Mr. Ooms: No, your Honor. This man might be able to go out and get a patent on it today.

[fol. 190] The Witness: It can be patented. These are the functions of a design patent. You can use the functions determined by the mechanics to improve them, to elaborate on them, to create an esthetic value which would be distinctive and also give you an interesting, beautiful job in installation.

The Court: All right. Proceed.

The Witness: This has the same characteristics. Shall I enumerate?

Mr. Ooms: I think his Honor can see that.

By the Witness:

A. (Continuing) All right. Now, this has the same thing only a different design treatment. This elaborates still more by increasing the number of uplighting slots and creating an identifying feature by depressed areas instead of raised areas. (Indicating.)

By Mr. Ooms:

Q. Now, are you familiar with the Mitchell "Dynalite" here marked as Plaintiff's Exhibit 5?

A. Yes, sir, I am.

Q. Did you study that with the over-all esthetic point of view in mind?

A. I studied it from the over-all esthetic view, yes, sir.

Q. And do you have an opinion with respect to that reflector as it relates to the CFI-10 reflector or the patent in suit?

A. Speaking from an aesthetic view, I would say it had a very similar aesthetic value.

Q. In your opinion, would the over-all appearance of that particular reflector be confused with the CFI-10 reflector or the one shown in the patent in suit?

A. It would certainly be in installation.

[fol. 191] Mr. Kraus: I don't believe this expert is in a position to state that and, furthermore, that is the prov-

ince of this Court on the question of infringement, and this expert is not supposed to testify to infringement. He is giving an opinion on a question which this Court has to decide.

The Court: Let him answer.

By Mr. Ooms:

Q. Go ahead.

A. I would say that definitely the fixture in suit is enough exactly looking like the CFI-10 to be confusing.

Q. Now, we have been shown a particular card, which I don't believe has been marked, by the defendant, showing a cross-section of a rib in the Compco and a cross-section of the rib of the patent in suit. Have you studied that?

A. I have, sir.

Q. And did you study the particular physical product representing the Mitchell or Compco products?

A. The physical product does not seemingly represent the true enlarged sections of the drawings submitted.

Q. Could you, in fact, get such a sharp bend as shown there?

A. It is undesirable to have a sharp bend in the porcelain enamel, so therefore the curvatures are minimized—I mean the angles are minimized in the curvatures to a great extent.

Q. And did you find that true in this physical embodiment?

A. That is true in the physical embodiment.

Mr. Ooms: No further questions.

The Court: Let's take a ten-minute recess.

Mr. Ooms: I will be through with my case after this cross examination, your Honor.

[fol. 192] The Court: All right.

(A short recess was taken, after which the following further proceedings were had herein:)

Cross examination.

By Mr. Mullin:

Q. Mr. Blazey, are you an expert on metalworking?
A. Yes, sir.
Q. Now—

The Court: What you have testified in substance, if I may review it from a layman's point of view, is that the exhibit of the plaintiff has sufficient aesthetic features as would make it identifiable as a specific plaintiff's product?

The Witness: Right.

The Court: And that the alleged copied product has similar features as to sufficiently confuse the general users?

The Witness: The public, that is right.

The Court: That is in substance your testimony?

The Witness: That is right.

The Court: You didn't say that you know of your own knowledge that these same features had not been previously exhibited anywhere? You didn't say that?

The Witness: I didn't say that, no.

The Court: Pardon?

The Witness: I didn't say that they were previously exhibited.

The Court: That is right. Then you don't know that?

The Witness: Well, I do from the study of the case.

The Court: Beg pardon?

The Witness: Only from a study of the case. I know the background now. I haven't been questioned on that yet.

The Court: Are you familiar with the—

The Witness: Prior art?

[fol. 193] The Court: —with prior art?

The Witness: Yes, sir.

The Court: That similarity?

The Witness: Only by my education in this case.

The Court: No, from your own personal observation in your field?

The Witness: No, my field does not specifically take in only lighting fixtures; it takes in a whole gamut.

The Court: But whatever it does take in, have you any personal knowledge of that phase of it, independent of

what has been shown you by way of prior art in the Patent Office?

The Witness: Only from a cursory examination of lighting which I use in my work as an interior designer.

The Court: Would you consider yourself qualified in that field of determination?

The Witness: I would, definitely.

The Court: All right. You may proceed.

By Mr. Mullin:

Q. Now these fixtures come in, I believe, two lengths; some are 48-inch and some are 96-inch. In other words, some are twice as long as the others?

A. That is right.

Q. These fixtures here are all 48 inches, isn't that right?

A. Yes.

The Court: By fixtures you mean what, identify them so we know what we are talking about.

Mr. Mullin: I am referring to all of the reflectors we have here, Plaintiff's Exhibit 4, Plaintiff's Exhibit 5, Plaintiff's Exhibit 12 for identification.

The Court: All right.

Mr. Mullin: Mark this as Defendant's Exhibit LL for identification.

[fol. 194] (The said document was thereupon marked Defendant's Exhibit LL, for identification.)

By Mr. Mullin:

Q. Now, this is Defendant's Exhibit LL for identification, and that is a blowup of that catalog we gave you yesterday about the Westinghouse fixture. Now is that—

Mr. Ooms: Your Honor, if I may, and before you proceed, Mr. Mullin, of course I didn't question him about this, it would exceed direct examination, but I think the Court should have the benefit of this expert; otherwise I would object to it as exceeding the direct and he could make him his own witness. But to expedite this thing, I will let him answer, I will let him ask him about any prior idea he wants to.

The Court: I don't think the witness has touched upon prior art.

Mr. Ooms: I have no objection to it.

The Court: I have. I want you to—Unless you make him your witness.

Mr. Mullin: No, I would just like—He has stated that these ridges extending beyond a certain point are ornamental and not functional; that the ridges only across the top and around the corners are—

The Court: That is what he testified to.

Mr. Mullin: Yes, and now I want to take him down and show him—

The Court: Not as prior art; as a feature in his product.

Mr. Mullin: Yes, but then I want to ask him—he is an expert, he is qualified as an expert, and I want to go into the question of whether there is anything there—

The Court: All right. Proceed.

By Mr. Mullin:

[fol. 195] Q. Now this is the Westinghouse called the 2 SDP-58. Are you familiar with that fixture?

A. I am familiar with this, yes, sir.

Q. Is this a 96-inch or a 48-inch reflector shown here?

A. That is a 48-inch shown.

Q. This is a 48?

A. Yes, sir.

Q. What is the number on that?

A. SDP-58.

Q. 2 SDP-58?

A. Yes.

Mr. Ooms: Speak up, please, Mr. Blazey.

The Witness: 2 SDP-58.

By Mr. Mullin:

Q. And this is it here?

Mr. Mullin: I will take this out and ask that it be marked as Defendant's Exhibit Z for identification.

(The said document was thereupon marked Defendant's Exhibit Z for identification.)

By Mr. Mullin:

Q. This is Defendant's Exhibit Z for identification which is a copy of the catalog sheet of the Westinghouse Electric Corporation. I hand you the exhibit. This is the other page from which this is blown up. Now, do you see anywhere on there that same designation, 2 FDP 58?

A. 2 FDP 58 (indicating).

Q. Right opposite that does it give the length?

A. 6 foot.

Q. That is a six foot unit, not a 48-inch unit?

A. That is right.

Q. So then you don't know, you can't tell about the length?

A. You can't tell from the illustration.

[fol. 196] Q. But can you tell where that shows cross ribs going between the slots?

A. It does show a slight depression, right.

Q. Going between each slot?

A. Between each slot.

Q. And it also shows slots similar to the slots of Defendant's Exhibit 4?

A. Uplighting slots.

Q. Uplighting slots?

A. Right.

Q. With cross ribs between?

A. Right.

Mr. Mullin: I believe your Honor was shown this yesterday.

I will ask this be marked as Defendant's Exhibit G for identification.

(The document was thereupon marked Defendant's Exhibit G for identification.)

By Mr. Mullin:

Q. I now show you Defendant's Exhibit G for identification and I think your Honor has one of these also. It is the Guth Mazelite catalog sheet blow up.

Do you see on that any cross ribs extending down into the sides?

A. Yes, sir, I do.

Q. And do those ribs extend down into the sides beyond the point where they would be purely functional and not ornamental?

A. From the viewpoint I am looking at them—from the viewpoint of the illustration, I would say no.

Q. You would say these do not extend down into the sides, these ribs?

A. They extend down only beyond the curve to provide function.

[fol. 197] Q. Beyond the curve?

A. Just beyond the curve to provide function.

Q. Beyond the curve?

A. Just beyond the curve.

Q. How do you know that?

A. Only because of the illustration, the way it is made. I can't be sure in the exact fixture.

Q. Well, I am just asking you to look at this illustration. Forget about the fixture.

A. I can only judge from the illustration.

Q. From the illustration you say that those ribs do not extend down beyond the point where they become ornamental?

A. That is right.

Q. So then you say that when the rib is extended down beyond this point, beyond the curve—now I am pointing to Plaintiff's Exhibit 4, to a point beyond the red, would you say that the curve that the rib in order to be functional has to extend beyond this point that is marked in red here?

A. Not necessarily. The point that is marked in red determines the zero point, we will say, of the strains in the sheet.

Q. This doesn't go beyond the curve, does it?

A. It has to terminate to the other surface by the use of the toolmaker's knowledge.

Q. In order to maintain the rigidity and the strength necessary, does the rib have to extend beyond that point?

A. Only so that it deforms the—

Q. Answer yes or no.

A. Yes, sir, it does.

Q. Now, Mr. Witness—

Mr. Mullin: Will the Reporter mark this as Defendant's Exhibit AA for identification.

[fol. 198] (The document was thereupon marked Defendant's Exhibit AA for identification.)

By Mr. Mullin:

Q. This is a Defendant's drawing, Defendant's Exhibit AA, which was referred to during the direct testimony of the witness. Did you testify that this cross rib—that the cross-section of that rib was impractical and couldn't be made and did not represent properly the fixtures?

A. That is right, sir.

Q. The corners are too sharp and couldn't be made that way?

A. The corners are too sharp, exactly.

The Court: That is in the lower right-hand corner.

By Mr. Mullin:

Q. Now this is a section here similar to that section there. Now, can you see that? I am referring to Figure 5 here.

A. Yes, sir.

Q. Is that practical to make it that way?

A. It is impractical.

Q. It is impractical?

A. It is impractical.

The Court: Figure 5 in what?

Mr. Mullin: I will show him that in just one minute. I will get to that.

By Mr. Mullin:

Q. And are those corners there even sharper than the ones that are shown here?

A. It is possible. That could only be determined by measurement.

Q. Well, you can look right there and tell me.

A. Yes, I would say about the same.

[fol. 199] Q. It is sharper?

Mr. Ooms: Will you speak up?

Mr. Mullin: I am referring, your Honor, to the patent drawings of Defendant's Exhibit O for identification which happens to be the patent drawings of the same fixture made by the Defendant.

The Court: Made by the Defendant or Plaintiff?

Mr. Mullin: By the Defendant—by the Plaintiff, I am sorry.

Mr. Ooms: Your Honor, that is their interpretation of the drawing. They haven't laid any foundation for such a statement.

Mr. Mullin: Well, the expert testified.

Mr. Ooms: I don't think he testified to that, your Honor.

Mr. Mullin: This is the drawing here, it is taken from the File Wrapper and certified.

The Court: The record speaks for itself.

Mr. Mullin: Certainly; certainly.

By Mr. Mullin:

Q. Now are there any other portions of this drawing that you say are not correct or not the same as what is shown in the patent in suit? Is this correct as compared with this—well, let me put it this way: Let us refer now to Defendant's Exhibit AA, the top view of the Compco fixture. Does that or does that not represent a top view of this fixture, Defendant's Exhibit 5?

A. I have to qualify that statement by saying that you cannot compare a Patent Office drawing by a patent artist with a three-dimensional object and expect to compare it. They have to be compared on other grounds.

Q. So then we should refer—since the patent in suit—since it is the patent that is involved here and not the reflector, then it is the patent drawing here that must [fol. 200] be compared with the defendant's exhibit or with the Defendant's Exhibit 5, is that correct?

A. The equitable way is to compare physical embodiment with physical embodiment, not drawing with physical embodiment.

Q. Well, that might be a fine way to do it, but here we are involved with a patent and we are involved with a pat-

ent in suit, and I believe this is a blowup of the drawings of the patent in suit. So therefore we have to compare drawings with drawings or either fixture with fixture. Is that what you are saying?

A. No, sir, I am not saying that.

Q. What are you saying?

A. I am not saying that it is not necessarily so, that a patent drawing will imitate the production fixtures, because of tool changes in the operation, the production.

Q. But what is involved here is the drawings of a patent in suit and therefore it is the drawings that we are concerned with, isn't that correct?

A. If you will establish it that way, yes, sir.

Mr. Mullin: Will you mark this as Defendant's Exhibit BB for identification.

(The said document was thereupon marked Defendant's Exhibit BB for identification.)

By Mr. Mullin:

Q. I show you now a drawing marked Defendant's Exhibit BB for identification which is the production drawing of the accused reflector and ask you to look that over and tell me whether this view, this top view is a fair representation of this view here and whether the cross section here —this I am talking about now, this cross section of the reflector is a fair representation of the cross section shown on the drawing?

[fol. 201] Mr. Ooms: Before he answers, I would like to interpose an objection, your Honor.

Mr. Mullin: He has already answered. Have you already answered?

Mr. Ooms: That may or may not be a production drawing that is accurate and true. It may be the production drawing they are using. I am not quibbling about that. What we are talking about here is whether a product comes out like that, because the Court undoubtedly knows, in metal there is spring back and a few other things which do not accurately and precisely allow a product to conform to a production drawing. What we are talking about here

is whether that model, the thing that the Defendant makes, infringes the patent in suit.

Mr. Mullin: Exactly, your Honor, and that is what we propose to show, that it doesn't.

The Court: I will let him answer.

By Mr. Mullin:

Q. Would you answer my question, Mr. Witness?

A. The drawing shown me substantially indicates or vice versa the chart shown me.

Q. So that these are substantially the same as the drawings, is that correct?

A. That doesn't qualify the fixture to be the same.

Q. But the drawings are the same?

A. The drawings are the same.

Q. Now, will you compare the drawing again, the same drawing, Defendant's Exhibit BB with Plaintiff's Exhibit 5 for identification and I ask you whether this drawing is a fair representation drawing of the fixture that you see before you?

A. From a cursory examination, I would say yes.

Q. Therefore the representations shown on this drawing are correct and they show the patent in suit and compare [fol. 202] the accused device.

Now, will you look—

Mr. Ooms: Again, I am going to have to object, your Honor.

The Court: Objection sustained.

Mr. Ooms: This testimony—

The Court: Objection sustained. That is analyzing the witness' testimony.

Mr. Ooms: Furthermore, so that the record is abundantly clear, when he asks the witness whether this was the same as the patent in suit, he was referring to the mechanical thing and there is nothing shown like that in the patent in suit and it is misleading this witness.

The Court: You can show the differences between the drawing and the patent in suit.

Mr. Ooms: All right, your Honor. I will do that.

Mr. Mullin: Your Honor, I would like to correct one statement made by the attorney for the Plaintiff and that is that we were asking him before about comparing the production drawings with the device itself and we were comparing the patent in suit with the drawings there. Now, the only Figure that I asked him at the beginning and I used this, which is the patent in suit, this is the drawings, and he compared them with that, and this is Plaintiff's Exhibit 25 for identification, and that was the one that they introduced as their patent drawings, the patent in suit.

Now, I did ask him to compare the cross-sectional rib here and he said that that cross-sectional rib as shown there was impractical, that it could not be made, and then I showed him a representation in the mechanical patent application—

[fol. 203] The Court: Why should you repeat all that? I have heard it. I followed it.

By Mr. Mullin:

Q. Will you direct your attention now to that drawing which is marked Defendant's Exhibit AA and tell me if the shape of the ribs—and I am pointing now to the shape of the Compco ribs, are the same or different than the shape of the ribs of the patent in suit?

A. In the area which you are pointing to, which is a flat surface, they are substantially the same.

Q. All right. Are you talking about this from here to here (indicating)? And from here to here (indicating)?

A. Yes, sir.

Q. Beyond that point, you testified that this area here was strictly functional, did you not?

A. I did.

Q. Now, the area beyond that you said was ornamental?

A. No, I did not.

Q. What did you say?

A. I said the area beyond the curve was ornamental.

Q. All right. The area beyond the curve is ornamental.

A. That was not in the area beyond the curve in any way.

Q. All right. Now, does this show, is this area here (indicating), and I am pointing from a point just beyond

the slot, the outer edge of the slot of the Compco device, is that the same from just this area here, is that the same as the area beyond the slot of the patent in suit?

A. It cannot be determined from the drawing you are pointing to.

Q. Well, I am asking you if on the drawing it appears the same, yes or no?

A. No, it does not.

[fol. 204] Q. It does not. What about these slots up here, are the uplight slots the same as the uplight slots here? I am talking about the shape and configuration of the two slots, the slots in the Compco device and the slots in the patent in suit?

A. From a detail standpoint they are not, no.

Q. They are not?

A. No.

Q. And these cross-sections here (indicating), are the corners the same on the Compco which shows the sharp corner and the rounded corner here of the patent in suit?

A. No, sir.

Q. They are different?

A. Yes.

Q. Is the slot here on the Compco cross-section spaced inwardly from the corner or is it right at the edge of the corner?

A. Inwardly.

Q. Where is the slot placed here on the patent in suit?

A. Further to the outside.

Q. All right, adjacent the curve, is that right, the end of the curve?

A. Right.

Q. And is the cross-section of the rib, taking the cross-section of the rib here (indicating)—are those two cross-sections the same?

A. No, sir.

Q. They are different?

A. Yes, sir.

Mr. Mullin: That's all, your Honor.

Redirect examination.

By Mr. Ooms:

Q. Mr. Blazey, you were shown Figure 5 of the mechanical patent not here in suit and asked whether Figure 5 com-
[fol. 205] pared with the cross-sectional rib of the lower portion of Defendant's Exhibit AA, is that correct?

A. That is correct.

Q. Now, I show you a patent in suit and ask you whether you find in that patent in suit any cross-section that compares with what is entitled under "patent in suit."

A. None whatever.

Q. In other words, the cross-section over there does not have the sharp, defined contours as shown on this chart Defendant's Exhibit AA?

A. Exactly.

Q. You were also shown Defendant's Exhibit BB and asked whether it was, and I quote, "a fair representation to the top view of the Compco," and I believe you answered it was a fair one.

A. Substantially the same.

Q. Is it an accurate one?

A. No, sir.

Q. I would like to—

Mr. Mullin: I am sorry. Would you repeat that answer?

By the Witness:

A. No, sir.

By Mr. Ooms:

Q. I would like you to compare the rib sections at the bend with the two products here in suit and ask whether, first, Plaintiff's Exhibit 5 is an accurate representation as shown on the photograph AA, as to the rib portion at its bend.

A. The intended drawing was intended to be like the model.

Q. Now, tell me this: What is closer, is it Plaintiff's Exhibit 4 at its turn and Exhibit 5 close to it, to the drawing, than Plaintiff's Exhibit 5 is to the drawing?

[fol. 206] A. I cannot determine that.

Q. You cannot determine that minute difference, is that correct?

A. That is correct.

Q. You did testify as to several minute differences between the size of the slots, the various things as depicted by the drawing, did you not?

A. I did.

Q. And said there were some. Now, from your position as a man schooled in industrial styling, by looking at the two products, in its entirety, is it your opinion still even though these minute differences were brought out to you, that there would be confusion between them to any purchaser?

A. That is exactly right.

Q. Now, referring to Plaintiff's Exhibit 4, I believe you said that this red line was not absolutely accurate insofar as lending finish to the reflector, is that correct?

A. Right.

Q. How much further would you extend that red line?

A. That would have to be determined by the toolmaker and it would depend on how deep the rib is.

Q. Do you have an opinion with respect to it?

A. I would say that it should terminate to the end of the curve only.

Q. About here (indicating)?

A. Right.

Q. And that the rest of the rib is non-functional?

A. Non-functional.

Q. Now, you were shown the Guth Mazelite fixture, Defendant's Exhibit LL, and I believe you said that the ribs in that particular picture only extended just around the bend, is that correct?

A. Just around the bend.

[fol. 207] Q. Now, how can you determine that from that particular drawing?

A. Only because of the spacing between the lower extremity of the reflector and the termination of the cross rib.

Q. Now, looking at the underside of that reflector in the upper left-hand picture, did you, at my request, run a draftsman's line to the side to determine approximately where that curve would terminate at the end of the reflector?

A. Yes, sir.

Q. Where does it terminate?

A. Just below the curvature.

Q. Would you say that this lower, the underside portion, then, would give one an optical illusion as to its extent?

A. That is right.

Q. The only accurate way of extending it is by running a draftman's line out to the side?

A. Exactly.

Q. You have seen a physical embodiment of a Guth structure, have you not?

A. I have.

Q. Is this the one (indicating)?

A. That is the one.

Q. Does that correspond with the opinion you gave with respect to the photograph?

A. No, sir.

Q. How does it differ?

A. The ribs are not as deeply imbedded and do not extend down as far as the illustration indicates.

Q. Did you, at my request, make a drawing of that particular feature to better bring out the proportions?

A. I did.

[fol. 208] Mr. Ooms: Will you please mark this Plaintiff's Exhibit 31 for identification.

(The said document was thereupon marked Plaintiff's Exhibit 31 for identification.)

By Mr. Ooms:

Q. I hand you an illustration. Who made that?

A. I made this, sir.

Q. In your opinion, does it show the Guth structure in

proper perspective when taken from that photograph, as shown here?

A. Yes, sir. It compares with the same perspective.

The Court: Will you identify it, please? What is it now? What is the identification?

Mr. Ooms: 31, your Honor, Plaintiff's Exhibit 31.

By Mr. Ooms:

Q. Now, you were also shown an enlarged section of a Westinghouse structure.

Mr. Ooms: Do you have yours handy? Have a small one here?

By Mr. Ooms:

Q. (Continuing) You were asked whether there was a rib between the longitudinal openings.

A. Right.

Q. And you said there is.

A. There is.

Q. Now, does that rib perform any means of product identification?

A. No, sir, it does not.

Q. Is it strictly in there for function?

A. It is purely functional.

Q. You were here yesterday when Mr. Humphreville testified, were you not?

A. Yes.

[fol. 209] Q. And you heard Mr. Humphreville testify that this was the type of Westinghouse fixture that they were manufacturing?

A. Yes.

Q. And you agree with this conclusion?

A. I do agree.

Mr. Mullin: Just to correct the record, your Honor, he testified that was one of the fixtures.

Mr. Ooms: All right, one, and, they were currently manufactured.

By Mr. Ooms:

Q. In any event, you agree with this conclusion?

A. Right.

Q. Now, looking at the Guth fixture and the Westinghouse fixture—incidentally, so that we will have this in, I will ask the reporter to mark this Plaintiff's Exhibit 32.

(The said document was thereupon marked Plaintiff's Exhibit 32 for identification.)

Mr. Ooms: I have had marked, as Plaintiff's Exhibit 32, another sketch.

By Mr. Ooms:

Q. Will you tell us what it is?

A. This is the Westinghouse fixture with the addition of the Guth ribs running over the curve.

Q. In other words, the Westinghouse fixture does not show the ribs running down all the way?

A. Right.

Q. Where would the Westinghouse ribs be on that particular sketch? You are drawing it in red, is that correct?

A. That is correct.

[fol. 210] Q. What you have done is taken the Guth ribs as shown in Plaintiff's Exhibit 31 and added it to the Westinghouse feature, is that correct?

A. That is correct.

Q. Now, in your opinion, would the combination of both of these elements suggest to you the particular industrial styling or design of the product of the patent in suit?

A. No, sir.

Q. Can you tell us why not?

A. The proportions are different. There are more slots. The size and location of the ribs are different and the identity of the fixture from the ground would not be observable in the combination offered in the particular drawings shown.

Mr. Ooms: No further questions.

Recross examination.

By Mr. Mullin:

Q. Did you testify that the ribs shown in the pictorial representation, that is in the catalog, as, for example, Defendant's Exhibit G for identification appeared to be further down than they actually were on this fixture, on this fixture which the Plaintiff has called Exhibit 6 for identification?

A. Yes, sir.

Q. They appear to be further down?

A. Yes, sir.

Q. What was that, was it Plaintiff's Exhibit 31, the one where you said that you added the Guth—

A. Yes. Here it is. This is No. 31 and that is 32 (indicating), Westinghouse. 31 is the one you wish.

Q. 32 is the one I wish. Is that the one where you tried to add the Guth ribs onto the Westinghouse?

A. Yes, sir.

[fol. 211] Q. And did you try to add the Guth ribs as they appeared on the fixture or as they appeared on the catalog sheet, Defendant's Exhibit G?

A. As it appeared on the physical—

Q. On the fixture?

A. Right.

Q. If you tried to add the ribs as they appear on the catalog, then they would have extended further down, wouldn't they?

A. Very much smaller, very much smaller.

Q. It would look much closer to the patent in suit, right?

A. Slightly so.

Q. Now, do you know the class of purchasers that purchased the fixtures, and, I am speaking, now, about the complete fixtures and I am referring now to Defendant's Exhibit NN for identification and Defendant's Exhibit OO for identification.

A. I do.

Q. What class of purchasers purchased these fixtures?

A. Either a contractor or a purchasing agent.

Q. Are they ever sold over the counter?

A. No, sir.

Q. Do you know how much these cost?

A. Yes, sir.

Q. How much do they sell for?

A. Are you talking about retail price?

Q. Well, the price that the purchaser pays for them.

A. I couldn't give you the exact price. I know the parameter of the price range.

Q. I beg your pardon?

A. I know the parameter of the price range.

[fol. 212] Q. Approximately.

A. From thirty to sixty dollars.

Q. From thirty to sixty dollars?

A. Yes, sir.

Q. And they are purchased by contractors and purchasing agents?

A. Right.

Q. These people, the contractors, usually are fairly skilled people, are they not?

A. Right.

Q. And they know their business and the purchasing agents, of course, are in a position to judge and examine fixtures of various types, isn't that true?

A. Only ones.

Q. Would you say that class of purchaser such as that would be confused when he saw these two fixtures?

A. Definitely I would say so.

Q. You would say so?

A. Definitely.

Q. Would he be confused if he saw these two fixtures? He would examine the fixtures, would he not?

A. Not necessarily.

Q. How would he purchase them?

A. He would purchase them on catalog description and salesmen's descriptions.

Q. He would purchase them on catalog description and salesmen descriptions?

A. Right.

Q. What about specifications?

A. The specifications, that would be up to the architect or the contractors.

Q. Do you notice, is there any difference in these end portions here (indicating)? These are the portions that hold the fluorescent tubes.

A. Yes, sir.

[fol. 213] Q. There is a difference?

A. Yes.

Q. Is there any difference in the channel here, the housing for the ballast channel (indicating)?

A. Slightly.

Q. But, you say that the class of purchasers that would purchase these would be purchasing agents and these are purchasing agents for what, for factories?

A. For a factory.

Q. For factories. And, contractors would not be able to tell the difference in these fixtures, is that right?

A. Not by a cursory examination.

Q. How would they tell the difference?

A. By comparing one against the other, as you are there.

Q. By comparing the designs?

A. They never get the opportunity to compare one with another.

Q. They wouldn't? They wouldn't?

A. Hardly.

Q. Hardly? Would you be able to look at these, for example and see these large uplight slots and these narrow slots and wonder if they were the same?

A. It would be unusual for a contractor to handle two lines of fixtures, to compare them on sale.

Q. Does the contractor handle them? What do you mean by "handle"? Does he sell them?

A. He sells them.

Q. You are speaking of—

A. I am talking about the distributor.

Q. The contractor is—

A. The purchaser, I am talking about.

Q. And the distributor is not the class of purchaser you are referring to?

A. That is right.

[fol. 214] Q. Now, I believe this morning Mr. Ooms introduced these two (indicating). One is a photograph and

I am referring now to Plaintiff's Exhibit 25-B for identification, which is an actual photograph of the accused device, the Mitchell reflector, and this is the blow-up of the patent drawings.

Now, I ask you to look at this actual photograph and I am directing your attention to the bottom-most Figure which is a side view in which you see this wall with the end portions of the slots.

A. Yes, sir.

Q. Are you also looking at Figure 4 of the patent which is a similar view?

A. Yes, sir.

Q. Showing the side view with the slots?

A. Yes.

Q. Are those the same?

A. No, sir.

Q. What is the difference?

A. The difference is in the ability for the patent artist to draw a three-dimensional surface.

Q. What is the difference as you see it there?

A. The rib portion is not as pronounced in the actual photograph as in the patent drawing.

Q. Well, is there a difference? You notice these are formed with curved, arcuate curved or, conversely curved sides. I am speaking about the side of the slots.

A. Yes, sir.

Q. Do you see such conversely curved sides in the other?

A. No. That is exaggerated.

Mr. Mullin: That's all, your Honor.

OFFERS IN EVIDENCE

Mr. Ooms: I have no further questions, your Honor. I would like to offer in evidence Plaintiff's Exhibits 28, 29, 30, 31, and 32, being the experts' renditions of the [fol. 215] physical structures.

The Court: You would like to offer them?

Mr. Ooms: Yes, sir.

Mr. Mullin: May I see them, please?

The Court: They may be received in evidence.

(Said documents, so offered and received in evidence, were marked Plaintiff's Exhibits 28 through 32, inclusive.)

The Court: Both sides have no further questions?

Mr. Ooms: Your Honor, the Plaintiff rests its prima facie case.

You may step down, Mr. Blazey.

(Witness excused.)

Thereupon The Plaintiff Rested Its Case In Chief.

Thereupon The Defendant, To Maintain The Issues On Its Part, Introduced The Following Evidence, To Wit:

Mr. Mullin: We would like to open our case by reading a short deposition, your Honor.

Would the Clerk hand the Court the deposition of Bert A. Kaeppel.

The Court: How short is it?

Mr. Mullin: It is three and a half pages long.

The Court: All right.

Mr. Mullin: Four and a half pages. I am sorry.

Miss Reporter, will you mark this as Defendant's Exhibit W for identification?

(The said document was thereupon marked Defendant's Exhibit W for identification.)

Mr. Mullin: This is an exhibit that is referred to in the deposition, your Honor.

This is the deposition that was taken on March 29, [fol. 216] 1960, of Bert A. Kaeppel, and I will read the questions and my colleague, Mr. Kaufman, will read the answers.

The Court: All right.

Deposition of Bert A. Kaeppel Read Into Record

(Thereupon the quesetions were read by Mr. Mullin and the answers were read by Mr. Kaufman, as follows:)

"By Mr. Mullin:

Q. Will you state your full name?

A. Bert A. Kaeppel, B-e-r-t.

Q. That is K-a-p-p-e-l?
A. K-a-e-p-p-e-l.
Q. K-a-e?
A. Yes.
Q. What is your address, Mr. Kaeppel?
A. #2 Elmcrest Acres.
Q. That is your residence address?
A. Yes.
Q. What is your business address?
A. 5441 Bulwer Avenue.
Q. What company do you work for?
A. Day-Brite Lighting, Incorporated.
Q. What is your position?
A. I am manager of tools and dies.
Q. How long have you been in that position?
A. It has been a growing position. I would say approximately 15 years.
Q. Fifteen years?
A. That is subject to revision, but about that.
Q. You said approximately?
A. Yes.
Q. So that would take you back to about 1945?
A. Possibly.
[fol. 217] Q. What are your duties as manager of tools and dies?
A. It is my responsibility to see that the company is equipped with the necessary tools and dies and recommend the necessary equipment to operate those tools and dies.
Q. Do you have anything to do with the design of these tools and dies?
A. With the design of tools and dies, yes, that is my responsibility.
Q. Did you have anything to do with the tooling of the CFI-10?
A. Oh, yes, all of it.
Q. Did you have anything to do with the tooling of the CFI-Dayline?
A. I would say yes, all of it.
Q. And what about the Dayline without the CFI?
A. There I am on unsure ground. I still call everything

Dayline, but if the Dayline goes back at least 15 years, I would say I still had that responsibility.

Q. On the CFI-10 can you tell us just how you were brought into the picture?

A. The first thing that I can remember about that—that is the CFI-10 we are talking about, which has openings upward and has ribs (indicating) transversely?

Q. Yes?

A. It was that we were looking for a better way of producing that fixture. We were forming them on press brake dies which is not a too accurate way of producing the parts. So, in one of our huddles with Mr. Klingsick and Mr. Biller, and whoever else was around, I did suggest that there is a way of doing it which is going to cost a good deal more and that is to draw it or form it just exactly as though it were to be a drawn shell, but without the ends in it. In order to carry out that particular thought we [fol. 218] experimented with some draw dies that we already had down at the Tupelo plant. We sheared pieces somewhat shorter than the normal blank and formed them in that draw die. I think that is where this whole concept started of adding onto the fixture then.

Q. Adding what?

A. Adding this sort of thing"—

Mr. Kauffman: I believe he pointed to the drawing at that point, your Honor.

(Reading):

"Adding this sort of thing (indicating). I was interested in getting a nice uniform profile there.

Q. Before that, the profile wasn't as uniform, was that it?

A. It was uniform within the limitations prescribed by the way we were forming the part, which is the press brake forming.

Q. I see. I refer your attention to Revision D in this drawing which is Defendant's Exhibit #19, and ask if that is what you are talking about?"

Mr. Mullin: Your Honor, if you will look in the box, it is a little indistinct, but it is in this box here (indicating) —DS—D, rib depth reduced. In the drawings there is a section DD showing the ribs and how the ribs were reduced.

The Court: All right.

Mr. Mullin: (Continuing reading)

"Q. I see. I refer your attention to Revision D in this drawing which is Defendant's Exhibit 19, and ask you if that is what you are talking about?

A. It says here "rib depth reduced?"

Q. Yes?

A. Well, to the best of my knowledge, that rib depth [fol. 219] reduced entered the picture after we tried to produce that part with a much deeper rib.

Q. That's right?

A. And couldn't do it. We couldn't get a good part.

Q. So then you had to reduce it in order to get a good part?

A. That's right.

Q. So that the shape and depth of the rib is dictated by the manufacturing difficulties?

A. That's right.

Mr. Mullin: That's all."

Mr. Mullin: Thereafter there was cross examination by Mr. Ooms and, with your permission, Mr. Ooms—

Mr. Ooms: Do you want to read it in? Oh, help yourself.

The Court: How many pages is it?

Mr. Mullin: It is one page.

The Court: All right.

Mr. Mullin: (Continuing reading:)

"By Mr. Ooms:

Q. I have several questions here, Mr. Kaeppel. When did you begin your experimental work on this drawing and so forth? Do you remember in what year?

A. If I had my files available, I could give you the exact date, but sitting right here without—

Q. Sitting right here what would you make as a guess?

A. I would say probably around 1952 or '53.

Q. I see. Now, I believe you stated in answer to the last question, of counselor here, that the depth and the shape of the ribbing was dictated by your production limitations. Is that correct?

A. That's true, because if you try to draw them much too deep, you simply tear it apart.

[fol. 220] Q. Is the shape dictated by the product?

A. Yes, if the side of the ribs were to be much more nearly parallel. Again we would have that same problem of tearing the metal.

Q. Look at the upper section of these drawings. That is Defendant's Exhibit 19. Could you make that rib in the form of a teardrop or a circle or in some other form other than that shape shown in the upper section there?

A. That is a little bit like asking me if I could have made this in the first place. I didn't know it until we built a die to find out.

Mr. Ooms: I see. No further questions."

The Court: All right. Tomorrow morning at ten o'clock.

Mr. Mullin: We will be here on time, your Honor.

The Court: How much longer will you be? How long will it take you?

Mr. Mullin: I will say not more than a couple of hours.

The Court: I will see you tomorrow morning.

(Thereupon an adjournment was taken to 10:00 o'clock, a.m., of the following day, Wednesday, October 5, 1960.)

* * * * * * *

Wednesday, October 5, 1960, 10:30 o'clock a.m.

Court convened pursuant to adjournment.

* * * * * * * *

[fol. 221] (And thereupon the following further proceedings were had herein:)

The Clerk: No. 58 C 1300, Day-Brite Lighting, Inc., vs. Compco Corporation, on trial.

The Court: All right. The case on trial.

Mr. Mullin: Mr. Zagel, please.

SAMUEL J. ZAGEL, called as a witness on behalf of the Defendant, having been first duly sworn was examined and testified as follows:

Direct examination.

By Mr. Mullin:

Q. Will you state your full name, please?
A. Samuel J. Zagel.

The Reporter: Will you please spell the last name?
The Witness: Z-a-g-e-l.

By Mr. Mullin:

Q. Where do you reside, Mr. Zagel?
A. 2734 West Jarlath Avenue, Chicago, Illinois.
Q. How old are you?
A. Forty-six years old.
Q. What is your occupation?
A. I am president of Compco Corporation in Chicago.
Q. And is Compco Corporation the defendant in this lawsuit?
A. Yes, it is.
Q. How long have you been associated with the Compco Corporation?
A. Since its inception. I am one of the two founders of the company.
[fol. 222] Q. What year was that founded?
A. In 1932, I believe it was in August.
Q. In August of 1932?
A. Twenty-eight years ago.
Q. Mr. Zagel, can you trace the history of the corporation since its founding in 1932?
A. Yes. In 1932 we started business in a small plant approximately 18 feet wide by about 35 feet deep, smaller than the size of this courtroom.
We had three pieces of production equipment, a punch press, a metal spinning lathe, a square shear and a circular sheer and a pot-bellied stove. That was for heat in the winter time.

We started to manufacture metal parts, reflectors, incandescent lighting equipment, contract manufacturing. God was kind to us. He smiled at us and we grew and we prospered. I did most of the work when we started, together with my associate who started with me, who, incidentally, is my father. It wasn't incidental.

We started this business in a very small way. My father or I went out and we got orders from customers. We went back to the plant. We actually manufactured the materials, the parts that we received orders for. I did the work at that time, together with my father and, when the work was finished in the shop, we packed it up and I took it on the streetcar to deliver it.

As time went on, of course, we hired more people to augment our own services, our own work in the plant, and, we moved from one location to another as we required more space.

Later we evolved on the idea of increasing the growth of our business, the sales of our company, by acquisitions of other companies and, in 1953 I believe it was, we acquired one of our major acquisitions of the Outdoor Light-[fol. 223] ing Division of Leader Electric Company in Chicago. That Outdoor Lighting equipment consisted of lighting for airports, parking lots, service stations, shopping centers.

We sold to many people like the major oil companies and that division grew. It is a regular lighting division, and, then, in 1956 I believe it was, we acquired from the Cory Company the Mitchell Lighting Division of the Mitchell Manufacturing Company and, this reflector is a part of the entire purchase—this industrial unit, I should say.

The Court: When did you acquire that from the Cory Company?

The Witness: 1956, your Honor.

By Mr. Mullin:

Q. Did that include dies, tools and so forth?

A. That included tools, dies, jigs, fixtures, some inventory finished and partially finished, the general things

that you take over when you take over a manufacturing portion of an organization for the production of a line of equipment, lighting equipment in this case.

Q. Did you acquire more than just the fixture, which is the fixture here involved in this lawsuit?

A. Yes. That is only part of the entire line of lighting equipment. As a matter of fact, I have what I think is known as the only copy, to my knowledge, of the original line of equipment we acquired in the Mitchell Lighting line.

There are about thirty to forty different groups of lighting and, in each group there are, between, oh, I would say sixteen to twenty-five different items in each group.

There must be about six hundred to seven hundred items and this only one of those items.

Q. It is only one of those items?

A. That is right. Of course, with all that we acquired, [fol. 224] all of the equipment, the tools and dies and fixtures, we are using those tools today.

Q. You are still using the same tools and dies today?

A. We are still using the same tools and dies, yes. We didn't do anything to these tools and dies to alter them in any way. They are the original tools. Of course, there was maintenance to keep them in good operating order.

Q. You say that is the only copy of that?

A. Yes, this is, if you would like to look at it.

Mr. Mullin: Your Honor, for that reason, I would like not to introduce it in evidence but, if you care to look at it—

The Court: I don't want to look at it.

The Witness: We refer to this regularly so we do have to have it.

By Mr. Mullin:

Q. Now, do you, or have you ever done product design work?

A. Well, since I started the business, of course I was, shall we say, janitor and manufacturer and product designer and engineer all at the same time.

As my duties increased, due to the increase in business, I naturally concentrated my activities along fewer lines, which was sales, product design, engineering, product developing and all of this, of course, is based on the experience I have had throughout these twenty-eight years of being connected up with my company.

I have taken, in addition to my experience, I have, of course, gone to night school because I started this business when I was eighteen and had no chance to go to college, so, I went to night school and took some courses at night at Northwest University. Of course, I never received a degree, but the knowledge I got was quite helpful to me.

[fol. 225] Q. Now, I believe you mentioned that included in that purchase was a group called the "Dynalite" fixtures. Does that include more than what you see here or does the "Dynalite", the trade-mark "Dynalite" identify any other fixture besides what is shown here?

A. I believe there were two separate types of fixtures under the "Dynalite" name.

Q. Excuse me. I am referring to Defendant's Exhibit OO for identification.

A. There were two types of fixtures under the "Dynalite" name when we had purchased that from Mitchell. There were also other industrials which were sold but not under the "Dynalite" name.

Q. But, in the industrial fixture line?

A. Yes.

Q. You say there were two types?

A. Yes.

Q. Now, what other type was there besides this?

A. There was a type with an angular reflector which did not have apertures or slots.

Q. Didn't have apertures or slots?

A. No.

Q. That is also sold under the "Dynalite" name?

A. That was sold under the "Dynalite" name.

Q. Do you still sell that unslotted, unribbed fixture?

A. We do today, just until we get rid of our inventory and then it is our intention to discontinue that particular line of reflector, industrial fixtures.

Q. Why are you discontinuing that line?

A. It is an older design. It is a different design. It doesn't lend itself to the advances in lighting that are going right along and we would like to keep up to date with the latest lighting techniques and this, in my opinion, is the reason that we have to discontinue that. It is out-[fol. 226] moded, outdated. It is like last year's model automobile.

Q. Does that other fixture have the same lateral stability that this one does? Again, I am referring to Defendant's Exhibit OO for identification.

A. Well, yes, it does. It is a different type of unit that has similar lateral stability.

Q. But it doesn't have the slots?

A. It has no slots in there or other apertures.

Q. Oh, I see. Now—

Mr. Ooms: Your Honor, I do not mind counsel leading him but I think he is leading him a little too far.

Mr. Mullin: I am just trying to get this done as fast as I can.

The Court: Proceed.

Mr. Mullin: Please mark this Defendant's Exhibit U-1 for identification.

(The said document was thereupon marked Defendant's Exhibit U-1, for identification.)

By Mr. Mullin:

Q. This is Defendant's Exhibit U-1 for identification which is a Mitchell catalog, copyright date 1949, of the Mitchell Manufacturing Company. I ask you if you can identify that?

A. Yes, I can.

Q. What is it?

A. It is part of some catalogs we received when we purchased the Mitchell Lighting Division.

Q. And is it a catalog showing industrial fluorescent lighting fixtures?

A. It shows generally fluorescent lighting fixtures, or commercial and industrial. There are quite a few industrial lighting fixtures in here on Pages 6, 7, and so forth.

[fol. 227] Q. Can you look through that and see whether there are any reflectors or fixtures having reflectors which have the general shape of the reflectors here involved?

A. Well, yes, all of the open-end reflectors have the same general shape.

Q. On which pages do those appear?

A. This is on Page 6, the bottom of Page 7, some of the illustrations on Page 8; is an illustration on Page 9 and an illustration on Page 10.

The design of the reflector is more or less dictated by good lighting practice. It is made in accordance with suggested design to accomplish a certain lighting effect and the shape of the reflector, of course, follows the general shape of anything we have seen here or anything that competitors make as well.

Q. And that is in the 1949 Mitchell catalog, right?

A. That is right, sir.

Q. Now, I think you testified that the length of the reflectors is dictated—by what was that?

A. Well—

Mr. Ooms: Your Honor, this is direct examination and I think these leading questions are way out of line.

The Court: Yes.

Mr. Mullin: All right.

By the Witness:

A. If you are referring to size, well, the width of the reflector, of course, has been generally accepted by the industry as standard. As far as length is concerned, that is dictated by the length of the tubes, the fluorescent tubes that are on the market. The most generally used in industrial application are 48 inches long and 96 inches long and, of course, that, of necessity, dictates the length of the lighting fixture.

By Mr. Mullin:

[fol. 228] Q. Can you show me—

The Court: Are you now on the patentability feature of it?

Mr. Mullin: Yes. Will the reporter mark this Defendant's Exhibit NN for identification.

(The said document was thereupon marked Defendant's Exhibit NN for identification.)

By Mr. Mullin:

Q. Now, will you show me—

Mr. Mullin: Well, let me correct my statement; it is the patentability and the functionality. Of course, the functioning affects the patentability.

By Mr. Mullin:

Q. Now, will you show me where those tubes would go in this fixture (indicating)?

A. The tubes would be inserted on the sockets here and the length, of course, is determined by the tubes used in the fixture.

Q. And these fixtures are made long enough to accommodate those standard lamps?

A. Standard-sized lamps, four-foot and eight-foot long, and others under special consideration.

Q. Now, referring to Plaintiff's Exhibit 4 for identification, which is the Plaintiff's structure of the reflector: These slots, do you know why they were put in? (Indicating)

A. They were put in in keeping with the latest advancements of lighting practice in order to allow a light to travel upwards so that a dark ceiling or a dark upward area of the room would be illuminated. It is in keeping with what is known as minimum contrast lighting.

[fol. 229] In the past, before slots were put into reflectors, the ceiling in a room was usually dark and the surface, the work surfaces was light. Now, that, in the opinion of many lighting experts, created a rather strong contrast which caused eye fatigue. In order to avoid that or eliminate that to a point, they put slots in reflectors to give an upward light component or to throw light up to the ceiling, very much like these fixtures here (indicating).

Q. Oh, so part of the light from these lamps which are positioned below goes up into the ceiling?

A. That is what I have explained, it goes up into the ceiling and reduces contrast.

Q. And that is the function of these slots?

A. That is the function of those slots, yes, sir. That is right.

Q. And when did the industry start putting those slots in reflectors?

A. I don't remember the exact dates, but I believe, from what I can recall, between, about 1950 to 1952. It was in that general area that slots started to become apparent in industrial lighting fixtures.

Mr. Ooms: Unless the witness knows, I will object to his hearsay. He was not in this particular business until 1956.

Mr. Mullin: He testified he has been in it since 1932.

The Court: I thought he was in that business.

Mr. Ooms: He was in a type of business, but not the industrial reflector business.

The Court: That goes to the weight and not to the admissibility.

Mr. Mullin: Well, let me clear that up.

By Mr. Mullin:

Q. When did you start making industrial fixtures?

[fol. 230] A. We started in the fluorescent lighting business when the fluorescent lamp was first introduced back in 1932 under the Compco trade-name. We had a full line of industrial and commercial equipment and we had a line of industrial lighting equipment. Prior to our purchase of Mitchell we were quite well known in the middle-west under the Compco trade-name and we, of course, did sell a few industrial fixtures since '30 up until the time we had acquired Mitchell.

Mitchell was only a means of increasing our over-all business nation-wide. So we did have a good reputation. We want to improve that and increase our sales scope nation-wide, of course.

Q. So you did make industrial lighting fixtures prior to the acquisition of the Mitchell Lighting Division?

A. Right. I might also add, as far as lighting practices goes, I am a member of the Illuminating Engineering Society, and I keep up to date with good lighting practices.

Q. And what does the—what did you call that?

A. Illuminating Engineering Society.

Q. What does the Illuminating Engineering Society have to do with prescribing practices for the lighting industry?

A. The Illuminating Engineering Society, among many other things, sets up recommended standards of illumination. We have study classes and study clubs, we hold technical seminars, regionally, nationally, and we acquaint not only the people in the trade, such as manufacturers, distributors, contractors and purchasers of lighting, but generally through a program of education we try to acquaint the general public with practices of good lighting.

They also publish a lighting handbook which is nationally known.

[fol. 231] Q. Now, you referred to page 9 in this Mitchell catalog, marked Defendant's Exhibit U-1 for identification, as one of the fixtures made by Mitchell having a reflector of the same general shape as this one (indicating)?

A. Right.

Q. Can you look at that. Do you know whether the relationship of the sides of the reflector were fixed with respect to each other so that it could not be moved?

A. Yes, they were. They had to maintain a rather uniform lateral size and stability.

Q. And this one also does not have these slots, these uplight slots?

A. No; we are just talking about shape of reflector.

Q. I see. Now, what happened when the industry started to put these slots in? I am pointing now to the slots in Plaintiff's Exhibit 4 for identification.

A. Well of course, a good thing happened; we started to enter into the field of what is known as minimum contrast lighting. We also had some problems, some manufacturing problems. When those slots were put into the reflectors we had warpage to a great extent when the reflectors were passed through porcelain enameling ovens.

The temperatures in porcelain enameling are approximately 1500 to 1600 degrees Fahrenheit. Great stresses

and strains are set up when the molten glass is fused to the metal. It will warp considerably and will not maintain the lateral stability which is very important in a lighting fixture.

That was one of the roughest problems, I believe, that was encountered in the industry. I might enlarge on that. We did not have that problem in porcelain enameling a reflector without slots because no metal was removed from the slots.

[fol. 232] Now, when you remove the metal from a reflector you take away a part of the structural strength of the reflector and, consequently, something has to be done to, shall we say, replace that structural strength that has been lost.

Q. And what was done?

A. The ribs are about the only answer to that problem that we have found or that we know of.

Q. What ribs are you referring to? Can you point those out?

A. The ribs on this reflector running in this direction (indicating), that led us to maintain the dimension, the lateral dimension to within good manufacturing tolerances that we feel are permissible.

Q. And when you pointed to the ribs, from where to where did you point?

A. Well, I pointed from the full length of the ribs, from the side all the way across the curve, across the top, down the other side, and down the reflector (indicating). It is necessary to have that to prevent reflectors from warping.

Q. Well, now, wouldn't this rib be enough? I am pointing now to Plaintiff's Exhibit 12 for identification, which is the CFI "Day-Line." They have a rib just going across the top. Isn't that enough?

A. My experience indicates that that would not be enough.

Q. And why would that not be enough?

A. That would still cause the sides of the reflector to warp.

Q. And permit them to be displaced, like this (demonstrating)?

A. Well, they would be distorted.

Mr. Mullin: Yes. Now, will the reporter mark this Defendant's Exhibit U-2 for identification.

[fol. 233] (The said document was thereupon marked Defendant's Exhibit U-2 for identification.)

By Mr. Mullin:

Q. I hand you Defendant's Exhibit U-2 for identification and ask you if you can identify this.

A. Yes, this is one of our latest Mitchell lighting catalogs.

Q. And does that cover industrial lighting fixtures?

A. This covers industrial and commercial and other types of lighting fixtures.

Q. And included in that is the Mitchell "Dynalite" fixtures?

A. Yes, sir. That is part of our industrial line of equipment. I say, industrial lighting is all-inclusive in the industrial field.

Q. Now, did you testify that you were also in charge of sales?

A. Yes, I am.

Q. Now, do you know how these industrial lighting fixtures are purchased?

A. Yes, it is my job to know.

Q. Well, how are they purchased?

A. Generally there are a great many ways of purchasing these things—specifications through architects and engineers and distributors, but it boils down to the contractor and the purchasing agent generally.

Q. They are the individuals who ordinarily purchase these reflectors?

A. Yes, they are. That is right.

Q. I will correct myself: Fixtures instead of reflectors.

A. Lighting fixtures.

Q. Yes.

A. I thought that is what you said, was lighting fixtures. I am sorry.

[fol. 234] Q. Well how do you sell these? Do you sell them in separate component parts or do you sell them assembled?

A. Well, no, we never sell a component part. We sell an industrial lighting fixture. It is like we would sell a commercial lighting fixture, complete with all components. An industrial lighting fixture without one of the parts would not be a complete unit.

Q. And what is included in a fixture?

A. The body, the reflector, the socket.

Q. Would you take this and point out the parts so that the Court can see them?

A. The body, which is the top of the fixture, which houses the ballast. The ballast is a transformer inside the fixture.

The body also is attached to the sockets here (indicating). That holds the sockets (indicating). Then, the reflector, which is part of this assembly (indicating)—all of these comprise the entire unit.

The three main visible components, component parts are, the set of sockets, the body and the reflector. The invisible component parts which cannot be seen here, of course, are the ballasting and wiring and various screws, nuts and bolts.

Q. Now, let us assume that a factory wants to purchase some reflectors or some fixtures. How would they go about it?

A. They would request their sources of supply to submit catalog sheets and samples and they would make their selection from samples and catalog sheets.

Q. Would they ever purchase them just from the catalogs?

A. Sometimes they may, but, as a rule, they do not. The only time they would purchase them from catalogs, in [fol. 235] my experience, if is they reorder fixtures to add to an existing installation.

Q. If they reorder the fixtures?

A. Right.

Q. But, in the initial purchase—

A. In the initial purchase, they would generally look at samples and catalog sheets to study all of the competitive units that are available of that type.

Q. What if the contractor—how would a contractor purchase these?

A. The contractor would purchase these the same way. He would look at the samples. He would examine them. He would examine the catalog sheets. Of course, first, he would look at the catalog sheet to determine which samples he might like to examine. He might have a dozen catalog sheets and maybe narrow them down to an examination of three samples rather than look at 12 samples.

Q. Is it conceivable that he might purchase without even looking at the samples or catalog sheets?

A. It is conceivable, but it is generally not done.

Q. How much does your fixture sell for?

A. Well, depending on the size. Approximately, we would say $20, $25, $30.

Q. That is for the 48-inch?

A. For the 48-inch. There is a wide range of prices, but they are not inexpensive. The are expensive.

Q. Well, how many fixtures does one usually purchase in the average purchase?

A. It depends on the size of the installation. A small room might take a dozen units and a large installation might take hundreds or thousands of units.

Incidentally, I would like to add that in the expenditure of an item that costs about $20 per unit, and where you are going to order quite a few units, I have found [fol. 236] in my experience that a contractor or a purchasing agent will always look at samples to make sure that he knows what he is buying and getting the best merchandise.

Q. Well, when he looks at samples, is he able to determine or recognize whose fixture he is looking at?

A. Yes. That is the reason he is looking at samples, to determine which one he likes better. Each sample is individual and has got its own characteristics.

Q. Do you know of any instances where a customer was confused between the products of the various companies?

A. When you are speaking of a customer, the prices of these various companies, you are talking about a man who is accustomed to buying the lighting fixtures and, for a man in that particular industry, the variations in these lighting fixtures would be very apparent.

Of course, if it is a necktie salesman, he couldn't tell the difference, possibly.

Q. Well, if he looked at it the first time?

A. Yes, that's right.

Q. Well, do you personally know of any instance of confusion between your fixture and those of other manufacturers?

A. In 28 years of experience, I have never run across confusion between one product and another. They are all distinctive.

Q. You are talking about the industrial lighting fixtures?

A. Industrial lighting, yes.

Q. Do you know whether there has been any instance of confusion between your fixture and the plaintiff's fixture?

A. In my experience, no; there has been no instance of confusion because the two fixtures are of different char-
[fol. 237] acteristics and have a different appearance, a different external, outward appearance.

Q. What are the differences?

A. Well, let me explain it to you.

Q. Would you step down here?

A. If I may, please.

Q. Well, just point this out.

A. In viewing the lighting fixture from any angle, looking at it from the top, of course, the apparent difference, the large difference is in the size there, in the shape of the slots, the placement of the ribs. The ribs on this exhibit (indicating)—I am not familiar with these exhibits—are higher. These (indicating) are lower.

Q. What do you mean by "higher" or "lower"?

A. Well, they are closer to one end in this exhibit and they are further from one end in this exhibit (indicating).

Mr. Mullin: Let the record show he was pointing first to Defendant's Exhibit NN and secondly, to Defendant's Exhibit OO.

By the Witness:

A. (Continuing) Now, further looking at this, in addition to the difference between the slots, which is quite apparent, and the difference of the placement of the ribs, the body of the fixture is different. Ours is straight. Pardon me. That is Exhibit—

By Mr. Mullin:

Q. OO?

A. Exhibit OO is straight. This exhibit—

Q. NN.

A. —NN, is tapered and has a step or a flange—a step on the body. That is also very apparent.

Now, turning the fixtures so that they are viewed from the end, there are very large differences as well. The one [fol. 238] big difference is that the Exhibit NN has a name on it, the "Day-Brite" name. The Exhibit OO does not have a name. That in itself is a big identifying feature of one fixture to the other.

In addition to that, the shape of the unit is different. This Exhibit NN has a curved side, a fully curved from a point on the top.

Exhibit OO has a straight top and then the curve starts, which is quite apparent.

The socket plate of Exhibit NN is different from the socket plate of Exhibit OO. The shape is entirely different. The shape of the top of the body is different, being tapered on the sides as against straight sides (indicating).

When you look from the underside of the reflector, you will find on Exhibit OO that the rib is further from the end and the means of fastening the reflector to the body is between the rib and the socket plate.

On Exhibit NN the rib is closer to the end and the means of fastening the reflector to the body is below the rib and away from the socket plate.

Those are the apparent differences of these two fixtures.

Q. I direct your attention, at the same time that you are comparing these fixtures, to the Defendant's Exhibit AA for identification.

A. Yes.

Q. The two drawings entitled "Cross-section of Rib"—now, do you see any differences there?

A. There is a difference in the cross-section of the rib. The shape is different in one over the other. One has, if I may point it out to the Judge—this has (indicating) a flat surface. That is Exhibit NN has a flat surface on the rib.

This is very apparent. You can recognize the flatness [fol. 239] of the rib on each one of these (indicating).

The ribs on OO have a rounded surface and that is indicated on the Exhibit AA here in the cross-section of the Compco as against the cross-section of the patent in suit.

Q. How about the depth of the rib? Is there any difference there?

A. There is a difference in the depth also, which is very apparent. This is deeper (indicating). The rib on NN is deeper. The rib on OO is not as deep.

Q. Are there any other differences, important differences?

A. Yes. There is a method of fastening the ends to the body, which is different between the Exhibit NN and Exhibit OO.

The ends are fastened in one way here (indicating), where screws are visible to the end. Screws are not visible in the end on Exhibit OO.

Q. While you are here, Mr. Zagel, will you also, now, refer to Plaintiff's Exhibits 4 and 5, and I ask you if you see any other differences that might not be seen in the complete fixture.

A. Yes. There is a difference in the size of the slot and the shape of the end slot of Exhibit—is this the right number (indicating)?

Q. Yes, Plaintiff's Exhibit 4.

A. Plaintiff's Exhibit 4, as against Plaintiff's Exhibit 5. There is a difference.

Mr. Mullin: Let the record show that the witness has pointed to an embossed end portion of the cutout on Plaintiff's Exhibit 4 and, on Plaintiff's Exhibit 5 there is no such embossing. Is that right?

The Witness: That is right, sir.

[fol. 240] Mr. Mullin: You may return to the stand, Mr. Zagel.

By Mr. Mullin:

Q. Now, do you put any label on your fixture anywhere?

A. Yes, we do. We put a label, a name label on our fixture. It is on the side, I believe, if I am not mistaken. There it is, right on the side (indicating) and the Mitchell

logo or identification is right here (indicating), very visible, in red.

Q. Does it refer to the name?

A. It says "Mitchell Lighting Division, Compco Corporation" and other information, but, the Mitchell logo or shape is very identifiable just like the Day-Brite shape on the end here is identifiable (indicating).

Mr. Mullin: Miss Reporter, will you mark these Defendant's Exhibits EE and FF for identification, respectively?

(The said documents were thereupon marked Defendant's Exhibits EE and FF for identification.)

By Mr. Mullin:

Q. How do you sell your fixtures? By that I mean, do you package them or do you sell them the way they are?

A. Well, we always package our product and we put it in a corrugated shipping container. It would be difficult to ship unless you did package it.

Q. Well, I show you Defendant's Exhibit EE for identification. Is that the package that you use?

A. That is the package that we use with our name prominently displayed on the package.

Q. It says "Mitchell" right across the face of it?

A. And our company name is also on there.

Q. Oh, yes, "A division of Compco Corporation"?

A. Right.

[fol. 241] Q. Have you ever seen a "Day-Brite" package?

A. Yes, I have. I am familiar with them.

Q. I show you Defendant's Exhibit FF for identification.

A. Yes.

Q. Do you recognize that?

A. Yes, I have seen boxes of that type, which is identifiable.

Q. That is the Day-Brite package or box?

A. Right.

Mr. Mullin: That's all, your Honor.

Cross examination.

By Mr. Ooms:

Q. Mr. Zagel, I believe you stated that you had two types of design under the Mitchell "Dynalite", is that correct?

A. Yes, that is right.

Q. The accused structure and some other type of fixture, is that correct?

A. Yes.

Q. Could you, briefly, describe this other type of fixture?

A. It has an angular reflector and a different shaped body.

Q. All I want to know is the design of it. Is that what the difference is?

A. Yes.

Q. Did it have apertures in it?

A. No, not that particular model.

Q. Not that particular model?

A. No.

Q. So, when we refer to design, what we are talking about is primarily the reflector design?

A. The reflector shape.

[fol. 242] Q. The reflector shape?

A. Yes.

Q. Well, what is it? Is it whether it has apertures or ribs?

A. No; just the shape of the reflector.

Q. That's all you mean by "design"?

A. Yes, the shape, not design.

Q. What do you mean by "design" then?

A. Well, we are just talking about shape.

Q. That's all you are talking about?

A. That's all, right.

Q. Would you include it if the shape had some sort of embossing on it as part of the shape?

A. Would I include what, sir?

Q. Would you include it in the word "design"?

A. I might.

Q. Well, do you or don't you?

A. Now I don't, no.

Q. Now you don't? When did you change your mind; when this lawsuit was filed?

A. I didn't change my mind.

Q. Well, you said that now you don't. When did you include it?

A. I never included it.

Q. Well, then, you must have misspoken yourself when you said, "Now I don't."

A. Yes, you may use it that way, if you wish.

Q. Now, you said the accused structure had a distinctive design. What is distinctive about the Mitchell accused structure?

A. I pointed those out in the testimony that I have just given.

Mr. Mullin: I don't recall him using the words "distinctive design."

[fol. 243] Mr. Ooms: I happen to have written it down, counsel and the record will show if I am incorrect.

The Witness: I believe I said there were differences.

By Mr. Ooms:

Q. Well, let us use the word "distinctive." Do you believe it has a distinctive design?

A. Do I believe what has a distinctive design?

Q. Your accused structure?

A. It has a shape of its own, yes.

Q. What do you mean by having a shape of its own that makes it distinctive?

A. It has a shape which is different from the patent in suit.

Q. What is this difference?

A. The differences are those that I pointed out just before.

Q. I am talking about the reflectors. That is what we are talking about, the shape.

A. Would you like to have me point them out again?

Q. I certainly would.

A. All right. The shape of the reflector, if you would like to use the samples, are: A more pronounced curve with less of a straight surface here (indicating) and a

lower curve with more of a straight surface on Exhibit 5. The first one I referred to was Exhibit 4.

Q. Correct.

A. That is one apparent difference, very apparent. The other difference is the placement of the rib further from the end on Exhibit 5, closer to the end of Exhibit 4.

Q. I see.

A. The other difference is the method of fastening the structure to the body, which is closer to the end on Exhibit 5 and on the end between the rib and the outside or end of Exhibit 5.

[fol. 244] On Exhibit 4 the method of fastening is between or back of the rib which is closer to the end.

Now, the other differences are the slots, a difference in size and shape, the difference of the ribs. One is larger than the other. One is round and the other has a flat— I went over this just before, sir.

Q. I just want to know, do you include all these elements in the word "shape"?

A. Of course I do.

Q. Which you said determines the design?

A. May I go back to my seat now, sir?

Q. Certainly.

(Continuing) which determines design, is that correct?

A. We are just talking about shape now, sir.

Q. All right. We will use the word "shape" for "design," then.

A. Yes, sir.

Q. Now, Mitchell puts out some catalogs, do they not, or, Compco, that is?

A. Yes, sir.

Q. And I believe on your catalog covering this particular accused structure, you use the words "advanced design." What is "advanced design"?

A. Since I did not write the catalog, I have no idea what the author meant by the words "advanced design", sir.

Q. You have been handing out these catalogs for about four or five years, is that correct?

A. Yes.

Q. And you are sales manager?

A. I am not sales manager. I am in charge of sales.

Q. You are in charge of sales?

A. Yes.

[fol. 245] Q. And you don't know what the words mean that are on the catalogs that you are handing out to the trade?

A. That is not the question you asked me. You asked "What do those words mean." I don't know what the author meant by those words.

Q. You don't know what they mean?

A. I can't read into the words the author's meaning.

Q. Can you tell what they mean?

A. No. It has never come up before.

Q. No one has ever questioned you about your advanced design?

A. No.

Q. Have you ever read your catalogs?

A. Yes.

Q. When did you read them?

A. At various times.

Q. Are you familiar with it? You are thoroughly familiar with it?

A. I am familiar with it but not word for word, no.

Q. Are you sufficiently familiar with it to talk to some prospective customer when you hand this catalog to him?

A. I am not the type of person who sells by reading from a catalog, sir.

Q. But you do hand them a catalog and you do send it out?

A. I personaliy do not hand them a catalog, no.

Q. Do you have a greater knowledge as to what is in the catalcg now than when we took your deposition?

A. I haven't read the catalog after you took my deposition, no.

Mr. Mullin: Which deposition are you referring to? You took it twice, Counsel.

Mr. Ooms: I will advise you as soon as I get it, as soon as I get the right one myself, Counsel. It is March 25, 1960.

[fol. 246] By Mr. Ooms:

Q. Do you recall this testimony—

A. No, I don't.

Q. I haven't read it yet.

A. You asked me if I recalled it and I said I don't.

Q. You don't even recall any part of it?

A. I know I gave testimony and it is in the record and it is not necessary for me to retain it.

Q. On Page 53:

"Q. We are not talking about the sale of an item, Mr. Zagel. We are talking about the statements made in that catalog. Do you stand in back of these statements made in that catalog, or do you not?"

And that was referring to Deposition Exhibit 8, the one I have in my hand.

This is the one you have been handing out?

A. Yes.

Q. And you have been handing it out since Compco took over Mitchell?

A. Since we purchased the Mitchell items.

Q. (Reading):

"Q. Do you stand in back of the statements made in that catalog or do you not?

"Mr. Mullin: I will ask you to define what you mean by 'stand in back of.'

"By Mr. Ooms:

"Q. Do you agree that they are accurate? Are the statements accurate in there, Mr. Zagel?

"A. I have not read the statements in there.

"Q. You are in charge of sales, are you not?

"A. That is right.

"Q. You have been handing this catalog out for some five years, is that correct?

"A. Ever since we bought Mitchell.

[fol. 247] "Q. And you have not read any of the statements in the catalog?

"A. No.

"Q. So, you don't know if they are accurate or not then?

"A. We assumed that they would be accurate as far as engineering or quality and other pertinent facts would be concerned.

"Q. But, you don't know?

"A. No. I did not write it, or my company did not write it.

"Q. But your company has been handing it out for five years, is that correct?

"A. My company has been using that literature."

You don't know, if someone asked you, what you mean by "advanced design"?

A. I know, but I don't know what the author meant.

Q. What do you mean by "Advanced Design"?

A. Advanced design is an up to date design.

Q. What is this design? That is what I am trying to get at.

A. I am no author on the definition of words, counsellor.

Q. I am not playing a game of semantics here with you. We have a couple of reflectors here you can refer to.

A. Yes.

Q. Prior to now, did you ever make, did Mitchell or did Compco ever make a reflector that had these various shape characteristics that you speak of? Did they ever make them before?

A. Before when?

Q. Before you purchased and before you came out with Exhibit 5?

[fol. 248] A. We made reflectors, yes, of course we did.

Q. Having all these shape characteristics?

A. No, not having these shape characteristics, except the general shape of the reflector, without the ribs.

Q. Just the contour, without the ribs?

A. That is correct.

Q. Other than that, you never made anything like that or sold it?

A. When you say never made anything like that or sold it, we made reflectors with slots.

Q. All right. That is, with the three slots in line?

A. They had slots in there.

Q. With the three of them in line?

A. The slots were in line.

Q. Were there three in line, Mr. Zagel? Can you understand my question?

A. There were slots in line. I don't know the number of slots that there were in there. I didn't count them.

Q. You have the catalog there. Would you like to check it and find out?

A. No.

Q. You wouldn't take my word, then, that there never were three in line?

A. I take your word—

Mr. Mullin: Your Honor, I object to counsel arguing with the witness.

The Court: The objection is overruled.

Mr. Ooms: He is not answering.

The Witness: I can't answer your questions if they are ambiguous.

By Mr. Ooms:

Q. If they are, I will try to explain them the best I can, without your being so snotty.

A. I am not being snotty, counsel, I think you are.

[fol. 249] Q. Let us go to the ribs. Did you ever make one with ribs completely across the top?

A. No.

Q. Did you ever make one with ribs down the sides?

A. Let me qualify it. We experimented. We did not make or sell them.

Q. You didn't sell them, is that right?

A. We experimented with them. We didn't sell them.

Q. You made a few samples?

A. Yes.

Q. That was with ribs across the top?

A. Various shaped ribs.

Q. Did you make them all the way down the sides?

A. We made various kinds.

Q. Did you make them all the way down the sides?

A. We made them all the way down and all the way up.

Q. You don't have those reflectors here?

A. No.

Q. And you didn't sell them?

A. No.

Q. I believe you testified these ribs are functional, all the way from the bottom of the sides all across the top, is that right?

A. As we considered them, yes.

Q. I didn't ask you that. You said they were functional all the way from the bottom to the top, the sides?

A. I didn't say from the bottom.

Q. Where are they functional from?

A. They are functional as far as they extend.

Mr. Mullin: I think what is being confused is that counsel is pointing to something and saying—

Mr. Ooms: All the way from the sides.

The Witness: I didn't use those words, counsellor. I used the words "as far as they extended they are functional."

[fol. 250] Q. In other words, what you are saying, on Plaintiff's Exhibit 5 the entire length of the rib is completely functional?

A. Absolutely.

Q. Now, have you made tests to ever prove that or to determine that?

A. I have had experience of 28 years which indicates to me that these are functional, sir.

Q. That indicates it to you?

A. That is right.

Q. Did you ever make a test to determine its functionality or not?

A. When you say "its" you mean ribs?

Q. The ribs' functionality, complete, throughout, as you testified.

A. Allow me to say we used ribs in many of our products; ribs in one form or another are strictly for strength. We used them regularly.

Q. I think everyone here will agree to that.

A. That is right.

Q. You are talking about extending the ribs all the way on the side as you do in Plaintiff's Exhibit 5?

A. Yes.

Q. Have you ever made any determination by test or otherwise to determine whether they are functional?

A. We stopped our work when we purchased the Mitchell Lighting Division because we felt that those ribs on that reflector would do the job properly and they are doing the job properly.

Q. Your answer is, then, "No" you never made a test?

A. No, that is not my answer.

Q. Well, will you answer it, then?

A. I personally did not make tests.

[fol. 251] Q. Did anyone in your organization?

A. To the best of my knowledge I believe some people did make those tests.

Q. Who?

A. I don't know. We employ 60 people.

Q. Well, then, you don't know?

A. Absolutely, I don't know.

Q. All right. Now, do you sell many industrial fixtures? First of all, do you think, when you put an aperture in there that you have to do something to beef it up to make it a saleable product? In other words, when you put slots in here, do you have to put something else into the reflector in order to make it a saleable product?

A. I don't understand what you are driving at, sir.

Q. Well, I believe you testified on direct that when you take metal out, you weaken structurally that product. Isn't that correct?

A. That is correct.

Q. Now, my question is, when you take out this metal, you have to do something to that reflector in order to make it a saleable product.

A. In order to make it structurally sound, yes.

Q. And that is what Compco sells and makes, I presume, structurally sound products?

A. Of course.

Q. Do you sell any product that has apertures or uplight or the slots in there that don't have any ribs in it?

A. We did at one time. We do not now.

Q. How long ago was that?

A. Oh, I would say, sir, until about a year ago, six months ago.

Q. Was it as late as March of 1960 of this year?

[fol. 252] A. Yes, it could have been.

Q. And what did you call that product?

A. An industrial reflector.

Q. Did you have a particular name for it?

A. If you are referring to a specific product and if the product you are referring to is a sample that you have there, we just call it an Economy Industrial Reflector, I believe.

Q. So, you did make such a product that has no ribs, cross-ribs in it at all, and sold it?

A. That is right.

Q. Do you think it required a cross-rib of some sort, Mr. Zagel?

A. That is why we stopped manufacturing that thing.

Q. How long did you make it?

A. Oh, we made it intermittently for a number of years.

Q. Now, who designed the reflector here, Plaintiff's Exhibit 5?

A. I don't know.

Q. Did you make any changes in it when Compco took over the jigs and dies and so forth?

A. We made no changes, no.

Q. You continued the exact same design?

A. Right.

Q. Now, how do you sell your industrial fixtures? By that I mean through what media do you sell?

A. Well—

Mr. Mullin: Excuse me. Has this been identified?

Mr. Ooms: I am going to identify it, Counsel, along with a few other items.

The Witness: We sell our equipment. We approach the sale of our equipment through specifications of architects and engineers, through electrical distributors, and, of course, the ultimate purchase is selected by the purchasing [fol. 253] agent or by a contractor. It is invoiced through an electrical distributor.

By Mr. Ooms:

Q. Do you call him a jobber?

A. He can be called a jobber, yes.

Q. How many salesmen do you have? The jobber isn't an employee of your company, is he?

A. No. He is a distributor. You asked who we sold to.

Q. He is independent?

A. We sell to a distributor or a jobber.

Q. How many salesmen do you employ in the industrial fixture line?

A. We sell through or we have people whom we call manufacturer's representatives who acquaint our customers with our merchandise.

Q. How many people does the company employ?

A. Approximately 60, 65.

Q. I am talking about sales, for industrial fixtures.

A. Manufacturer's representatives for fluorescent lighting fixtures.

Q. Are they on your payroll, Mr. Zagel?

A. No, they are not. They are manufacturer's representatives.

Q. How many are on your payroll, Mr. Zagel?

A. None of them.

Q. How many men do you have on your payroll selling industrial fixtures other than yourself and your brother?

A. If you refer to manufacturer's representatives, we have 65. If you refer to direct salaried employees selling our stuff, none on our payroll.

Q. These manufacturer's reps—that is what we call them, don't we, in the trade?

A. Yes.

Q. They sell more than just your product?

[fol. 254] A. They handle complementary lines.

Q. In other words, competitive products?

A. Not competitive as a rule. If we find that a man handles a competitive product, we have to ask for his resignation as a manufacturer's representative.

Q. They are exclusively manufacturer's reps?

A. They are manufacturer's reps who handle other lines which are not competing with ours.

Q. They are exclusive, in your exclusive files?

A. Yes, to our clients, plural.

Q. Now, how many of these manufacturer's reps do you give information and literature to in order for that rep to have your product specified in new construction?

A. All of them.

Q. They get the literature that has been handed here before, and in the booklet?

A. That's right.

Q. And that is all you supplied them with?

A. We supplied them with drawings. We supply them with whatever technical information they ask for.

Q. Have you ever gone in and tried to sell an architect an industrial fixture?

A. Yes.

Q. Do you always take with you the entire fixture?

A. Yes, I do.

Q. You have never sold it to him with just the reflector showing?

A. No.

Q. You have never done it?

A. I have never done it.

Q. Do you know of any of your people who have done it?

A. I don't control the actions of my men 24 hours a day. They are instructed to show a complete lighting [fol. 255] fixture. If our men choose to show a portion of that, that is up to them. They are independent contractors and they can do what they like as long as they bring in orders properly.

Q. They are independent contractors?

A. Yes, right.

Q. They can do as they like?

A. Right.

Q. They do as they like?

A. Yes.

Q. It is their prerogative?

A. Right.

Mr. Ooms: I would like to have this marked as Plaintiff's Exhibit 33, which is the Economy Line fixture.

(The said exhibit was thereupon marked Plaintiff's Exhibit 33 for identification.)

Mr. Mullin: What was the name?

Mr. Ooms: Economy Line fixture made by the defendant. Will you please mark this 34 and this 35 and 36.

(The said exhibits were thereupon marked Plaintiff's Exhibits 34, 35, and 36 for identification.)

By Mr. Ooms:

Q. These are brochures, insert sheets and catalogs put out by the Compco Company, is that correct?

A. That's right.

Q. Plaintiff's Exhibit 34 is the insert sheet used to advertise the Economy Line, is that correct?

A. Right.

Q. Plaintiff's Exhibits 35 and 36—35 is primarily for the sale of the accused structure, is that correct? You understand what I mean by that?

A. Yes.

[fol. 256] Q. And 36 is a catalog which includes other industrial and commercial fixtures, including the accused structure, is that correct?

A. Yes.

Q. Can you tell me whether this a baked enamel or a porcelain?

A. I would have to look at it. This is a porcelain enameled reflector.

Q. The same as the Plaintiff's Exhibit 5 is a porcelain?

A. That is porcelain also.

Mr. Ooms: No further questions.

Mr. Mullin: I have just a few questions, your Honor.

Redirect examination.

By Mr. Mullin:

Q. This Plaintiff's Exhibit 33 for identification, which is the reflector that you referred to as the economy line—

A. Yes.

Q. How much does that sell for? I am talking about the unit.

A. It is a very cheap fixture. It sells, I believe, in the neighborhood of—this is just an approximation of it—$11, $12.

Q. Now, Mr. Vogel, could you step down here and look down at these two fixtures and tell me—compare these two by looking at them, looking down straight.

The Court: Which two fixtures are they?

Mr. Mullin: I am referring now to Plaintiff's Exhibit 5 and Plaintiff's Exhibit 33 for identification, one being the reflector in suit and the other being this economy line fixture.

By Mr. Mullin:

Q. Now, will you take a look at those and see if you see anything unusual about them?

A. Yes. Exhibit 33, or Plaintiff's Exhibit 33, is badly warped. Plaintiff's Exhibit 5 is not warped.

[fol. 257] Q. By "warped" you mean that it is—

A. Twisted.

Q. Twisted?

A. Right. I believe it is apparent to the Judge.

Q. And this one is not twisted? (Indicating)

A. It is not twisted. It is straight.

Q. And how about the sides, the stability of the sides?

A. Well, from where I stand here, it looks like one end of the reflector is smaller in dimension, in cross dimension, than the other end of the reflector, which is larger, and there seems to be a larger dimension across the center of the open end of the reflector.

Q. In other words, the dimensions across vary all the way along here? (Indicating)

A. They vary laterally.

Q. What does that do to it?

A. It does not make that a suitable piece of merchandise, which is why we stopped manufacturing that piece of equipment.

Mr. Ooms: If the two of you stop talking at the same time maybe I can hear what is going on, too.

The Witness: Of course. We would be happy to oblige.

Mr. Mullin: Would you like it repeated? Mr. Reporter, please read it back.

(Record read.)

By Mr. Mullin:

Q. Now, will you try to see if you can flex those inwardly? I am pointing now to the sides of Plaintiff's Exhibit 5. Can you flex those sides inwardly, as I am doing with this one? (Demonstrating)

A. Just by exerting a very slight amount of pressure you can flex this thing appreciably.

[fol. 258] The Court: He has emphasized that the ribs are missing in the new exhibit and those are necessary to fortify or reinforce the fixture.

The Witness: Right.

By Mr. Mullin:

Q. And that this one is warped and the other one isn't?

A. That is right.

The Court: I do not mind telling you you are a long ways from convincing the Court that these are not infringements, a long ways from it.

Mr. Mullin: Well, we are—

The Court: I am not talking about this one, I am talking about the other one (indicating). You may find a little thing different here and there, but not of any consequence to make them different in appearance.

Mr. Mullin: No, but this testimony was for the purpose of emphasizing the functionality.

The Court: I know the purpose. I am talking about generally.

By Mr. Mullin:

Q. And you say that you are no longer making this economy line?

A. That is right.

The Court: He said that, as late as March.
Mr. Mullin: That is all, your Honor.
Mr. Ooms: Just one question.

Recross examination.

By Mr. Ooms:

Q. There is a difference is the gauge of metal here, isn't there?
A. I don't recall.
Q. Couldn't you tell by looking at it that Exhibit 33 is a lighter gauge metal and, therefore, it will tend—
A. No, I would need a micrometer to say that, sir.
[fol. 259] Mr. Ooms: I think the exhibits here will show that. No further questions.

The Court: All right.

(Witness excused.)

The Court: Do you want to take a five minute recess?

(Thereupon a short recess was taken.)

Colloquy Between Court and Counsel re Exhibits

The Court: Go ahead.
Mr. Mullin: I thought we might dispose of the prior art. These documents have all been stipulated to.
The Court: It is all right.
Mr. Ooms: I do not think we will have any problem.
Mr. Mullin: We offer into evidence the Defendant's Exhibit B, comprising a catalog or a reproduction of the catalog of the Day-Brite Corporation called, "The New CF! Day-Line," and showing—which is the catalog of the physical exhibit which has been introduced and showing a fixture with slots and cross ribs, four cross ribs across the top.
Mr. Ooms: Your Honor, I do not mind him introducing this, but I don't see why he has to identify each and every single one by saying what they show. They show what they show.

The Court: I welcome it.

Mr. Ooms: Well, if the Court welcomes it then I withdraw my objection.

Mr. Mullin: We offer into evidence Defendant's Exhibit C, which is a drawing—

The Court: This is as of what year?

Mr. Mullin: That is of the old fixture or the previous fixture.

The Court: What year?

Mr. Mullin: They have stipulated that that is prior art and goes back before the conception of the new fixture.

[fol. 260] The Court: All right.

Mr. Ooms: No, no, that is wrong.

Mr. Mullin: It is prior art?

Mr. Ooms: Right.

Mr. Mullin: It is immaterial if it is before the inception or any other date.

Now, this is Defendant's Exhibit C, your Honor, which is a production drawing of the Day-Brite Lighting Company of the open end reflector which you just saw in the catalog, that is dated December 19, 1950.

This goes here. This is a top view or part of a top view. These are the ribs. These are the slots. This is an end view or part of the view which shows the ribs and the slots.

Mr. Ooms: I want to be sure that that is what we stipulated to, Mr. Mullin.

Mr. Mullin: All right.

Mr. Bradway: What is the number?

Mr. Mullin: PI-27424.

Mr. Ooms: That is not prior art, your Honor.

That is part of the series of drawings which led up to the conception of the patent in suit.

Mr. Mullin: It says, "Open end reflector, 8 Slot Slim Line Day-Line." Is this a drawing of that fixture, the Day-Line, or isn't it?

Mr. Ooms: No, it is not.

Mr. Mullin: Well, what is this? (Indicating) Is this the Day-Line?

Mr. Ooms: Counsel, you will see that this is in 1950 and it is called Day-Line and it wasn't until '54 that we brought this up and dreamed up the name CFI-15.

Mr. Mullin: I did not introduce this as a drawing of the fixture in suit, this is of the prior one which is identified here as CFI "Day-Line."

Mr. Ooms: Then that is not correct.

[fol. 261] Mr. Mullin: This is not a "Day-Line"?

Mr. Ooms: This is not a "Day-Line".

Mr. Mullin: This is a "Day-Line" fixture? This is a drawing of a portion of a "Day-Line" fixture, is that right?

Mr. Ooms: It is a drawing leading up to the conception of the particular structure of the patent in suit. We have an earlier one introduced, as early as May, 1950, Counsel. It is marked. Even on yours it is marked "Void." It is something that was never made, used, or anything else.

Mr. Mullin: But you handed this to me as a drawing of a "Day-Line" fixture. This is among those that you gave me. I am now asking, is this of a "Day-Line" or isn't it?

Mr. Ooms: What do you mean by "Day-Line?"

Mr. Mullin: Well, it says here "Day-Line."

Mr. Ooms: That is what we were going to call the fixture when they finally got out with it, but they called it the CFI-15. That is three years earlier, Counsel. Here is the earlier drawing. It is not prior art by any means.

Mr. Mullin: Is this Exhibit B? You did not object to that?

Mr. Ooms: No.

Mr. Mullin: Is that a catalog sheet of the CFI "Day-Line" fixture?

Mr. Ooms: That is right, but that is not the same as that (indicating). They called it a "Day-Line" in '52. The names don't mean anything.

Mr. Mullin: This is in '50.

Mr. Ooms: That is 1950, and here is the May, 1950. That was introduced as the first conception of the structure in suit.

[fol. 262] Mr. Mullin: Do you object to the introduction of this drawing, the CFI, entitled "Open-end Reflector, eight-foot slim line Day-Line, No. I-27424"?

Mr. Ooms: No, but not as prior art by any means. It was never made or anything else. It says "Void" on the print.

Mr. Mullin: We offer into evidence Defendant's Exhibit D, which is entitled "The Day-Briter," April, 1952, showing on the cover, "The New Modern Day-Line."

The Court: All right.

Mr. Ooms: We have agreed that these exhibits can go in but not all of these for the purpose of prior art.

The Court: I understand.

Mr. Ooms: All right, your Honor. I did not want to interrupt. I wanted him to get through with this as fast as possible.

Mr. Mullin: He raised a point. Some of these have been stipulated as prior art. Well, we will take that question up later, your Honor. We will just continue with these. Now, this is Guth catalog No. 44. The copyright date is 1944. Pages 31 and 32 show the industrial "Quick-Liter," the Guth industrial "Quick-Liter," and the Guth "Mazelite."

Mr. Ooms: No objection.

Mr. Mullin: Is that stipulated to as prior art?

Mr. Ooms: Yes, that catalog is.

Mr. Mullin: The catalog itself is?

Mr. Ooms: Oh, yes. There is no question about that.

Mr. Mullin: Yes. We offer into evidence Defendant's Exhibit F, which—

The Court: What about this prior art?

Mr. Ooms: That is a catalog and we stipulate that that is part of the prior art, your Honor. It is what the witnesses have been testifying to.

[fol. 263] The Court: You will differentiate between this and the patent in suit?

Mr. Ooms: Oh, yes, very much so. As a matter of fact, we had our expert do that.

The Court: All right.

Mr. Mullin: This is Defendant's Exhibit F, which is another reproduction of still another Guth catalog in 1947,

Catalog No. 44-A. These are just two pages of that new catalog showing substantially the same. That has been stipulated to as prior art?

Mr. Ooms: There is no question about it, it is prior art.

Mr. Mullin: This is Defendant's Exhibit G, a sheet of a Guth catalog called "Guth Mazelite." It was issued 1/51, "Replaces Form 817."

This is Defendant's Exhibit G-1, which is merely a blowup of that fixture.

This is Defendant's Exhibit H, comprising a production drawing of the Edwin T. Guth Company of St. Louis, dated 10/5/45, and also bearing the date 11/3/48, and showing the same fixture.

This is a group of four invoices of the Guth Company, Defendant's Exhibits I-1, I-2, I-3 and I-4, and these were selected from suitcases full of invoices.

The attorney for the Guth Company at the deposition of Edwin Guth offered any or all of these that we wanted and it was stipulated by counsel that the Guth fixture and the sale of the same throughout the United States would be stipulated to.

Mr. Ooms: We did stipulate that a Guth structure was sold; we don't know which one because they made several changes in it, but they did sell some Guth structure having these types of ribs shown here (indicating).

[fol. 264] Mr. Mullin: Your Honor, I would like to read the stipulation if I may:

> "Mr. Ooms: We will stipulate to the fact that the types shown in Defendant Guth Deposition Exhibits 1-A and 1-B—"

and that refers to these two catalogs, this one and this one—

> "were made and sold generally through channels of trade throughout the United States or at least the greater part of the United States from the period at the end of 1944 until whatever period the witness says they discontinued the line, which I believe his testimony shows to be 1952. Unless you want to clutter up the record with all these—"

Mr. Ooms: That is what I stipulated to.

Mr. Mullin: Right.

Mr. Ooms: Of that type.

Mr. Mullin: "Of the types shown in those catalogs."

Mr. Ooms: It does not say catalogs, does it?

Mr. Mullin: It certainly does.

Mr. Ooms: All right, that is correct, of the types shown.

Mr. Mullin: "in those catalogs."

Mr. Ooms: I just did not want to have it mixed up with something else.

Mr. Mullin: Oh, certainly not.

Defendant's Exhibit J, which is a copy of a catalog sheet —incidentally, these are obtained from the Patent Office— of the Benjamin general catalog issued 10/31/52—or, no, issued September 19, 1949.

This is Defendant's Exhibit K, a Wheeler catalog C-200, July 14th, 1952, and showing a complete line of industrial fixtures.

[fol. 265] Your Honor, we have, I believe, on the opening day handed you a catalog of the Westinghouse Company which was a two-page catalog. That was identified as Exhibit L.

The Court: Here is another one that you ought to have.

Mr. Mullin: That is Plaintiff's Exhibit.

The Court: Here is one that is a Defendant's Exhibit.

Mr. Mullin: Yes. Oh, this is the original of the first exhibit, the Defendant's. That was Defendant's Exhibit B. I handed you a photocopy. May we substitute that? I inadvertently failed to introduce this physical exhibit, which is marked Plaintiff's Exhibit 12 for identification.

Mr. Ooms: I introduced it.

Mr. Mullin: Has it been introduced into evidence?

The Court: It may be received.

Mr. Mullin: All right, it will be introduced as Plaintiff's—did you say you already introduced it?

Mr. Ooms: I introduced it.

Mr. Mullin: It is marked just for identification.

Mr. Ooms: The Reporter has not gone around and marked them off yet,

Mr. Mullin: But it has been introduced?

Mr. Ooms: Yes.

Mr. Mullin: Then getting back to the Westinghouse catalog, which is Defendant's Exhibit L, comprising two pages:

On the first page, referring to the reflectors, "Formed steel with open ends and rigidized flanges and ribs."

The date is September 1, 1953.

On the second page is an illustration of the prior art reflector. Now, this is merely a blow-up of the catalog. It isn't a very good reproduction of the photograph and [fol. 266] it does not show the ribs as prominently as this one does. (Indicating.)

The Court: The last exhibit, Defendant's Exhibit 2—is it?

Mr. Mullin: No, L.

The Court: —L has a lot of red arrows pointing to ribs.

Mr. Mullin: Yes.

The Court: That was inserted?

Mr. Mullin: That was inserted and it was inserted on theirs and in the front we have also underlined the wording.

The Court: All right. I will hear you on it.

Mr. Ooms: I think you will find a lot of the exhibits marked calling your attention to the areas. That is just to call your attention to the areas. I am not objecting to the fact counsel has done that.

Mr. Mullin: Yes, and I think we tried to mark them on your copies.

Mr. Ooms: Oh, I am not saying you didn't.

Mr. Mullin: Now, this is Defendant's Exhibit M, comprising the Abernathy patent, No. 233,270, which was the only reference cited during the prosecution of the design patent application. We have some markings on there in red pencil. That was put on there during the preparation of the case.

Now, we also have a group of prior patents, most of which, or all of which, have either been pleaded or are a part of the file wrapper.

Mr. Ooms: Just a moment.

Mr. Kraus: There is no file wrapper.

Mr. Ooms: Your Honor, I am going to ask that clean exhibits be introduced here. They have been marked and everything else and I don't think that is a way an exhibit [fol. 267] should be put in, unless there is a witness on testifying about it. I have no objection to him introducing exhibits but when he uses it the same as testimony and they are marked up, then I think I must object. If we are going to brief this he can call the Court's attention to something like that.

The Court: I will disregard counsel's remarks about it. Proceed.

Mr. Mullin: This is prior art patent identified as Defendant's Exhibit N-1, Patent 2,261,187, issued to K. R. Scribner in 1941.

Now, the next is Defendant's Exhibits N-2—

The Court: Are these all design patents?

Mr. Mullin: No, these are all mechanical patents, showing the configurations. As Defendant's Exhibit N-2, the Darley patent issued December 29, 1942. I don't know if you want me to explain the drawing or point out—

The Court: No, you had an expert on the stand.

Mr. Mullin: Not a patent expert.

The Court: I do not care who it is, but somebody who understands these things.

Mr. Mullin: All right. The next is Patent No. 2,338,077, Defendant's Exhibit N-3, issued December 28, 1943, to Scribner.

Defendant's Exhibit N-4, prior art Patent 2,413,505, issued to Kilduff.

Defendant's Exhibit N-5, Patent No. 2,420,943, dated May 20, 1947 to H. Freeman.

Patent 2,423,884, issued July 15, 1947 to W. Glass as Defendant's Exhibit N-6.

Patent No. 2,678,380, issued May 11, 1954, filed December 9, 1950 to S. B. Westby, as Defendant's Exhibit N-7.

[fol. 268] Patent No. 2,833,916, dated May 6, 1958, filed May 25, 1953 to J. P. Foulds. We do have some markings on there. Do you want to see them?

Mr. Ooms: Let the references speak for themselves and not mark it up.

Mr. Mullin: I am sorry it is marked up. As I say, the papers were marked during preparation of the case.

Defendant's Exhibit N-9, and this is a British Patent, 114,518, issued to the Benjamin Electric, Ltd.

Defendant's Exhibit O-1, comprising the house organ of the Day-Brite Lighting, entitled "Day-Briter," dated October, 1956. We are particularly interested in pages 6 and 7.

The Court: That would not be prior art, would it?

Mr. Mullin: No. Now, we are going into the admissions by the Plaintiff that the ribs are for strengthening purposes or functional. That also we have some marks on that the Court may see the particular pertinent parts.

Mr. Ooms: We have already had testimony on it, counsel.

Mr. Mullin: This is Defendant's Exhibit O-2.

The Court: This is the 380 pounder?

Mr. Mullin: Yes.

Mr. Ooms: On the CFI-25.

Mr. Mullin: Defendant's Exhibit O-2 Illuminating Engineering, November, 1954, the page has been marked there also.

Mr. Ooms: Well, now—

Mr. Mullin: That had testimony on also.

Mr. Ooms: I understand, but do you want me to start objecting to some of these things now?

The Court: No, I think I will reserve my ruling on [fol. 269] all of them and I will hear you on it.

Mr. Ooms: Some of these are on the CFI-25.

The Court: I understand. You have objections to prior art too.

Mr. Ooms: Not as to legitimate prior art, only as to that one, your Honor.

The Court: Yes.

Defendant's Exhibit O-3, comprising a reproduction of an advertisement in Business Week, October 23, 1954.

Defendant's Exhibit O-4, comprising another advertisement.

Now, this has been stipulated as to the date, October 1954. It isn't marked on there.

Mr. Ooms: We stipulated?

Mr. Mullin: Yes, we did.

Defendant's Exhibit O-5, which is a catalog sheet of the Day-Brite Lighting, Inc., copyrighted in 1954 and showing the CFI-10 and, we have marked in the corner some of the language used by the plaintiff in describing the reinforcing ribs.

O-6 is another one dated September, 1954, Day-Brite Lighting, Inc., copyright 1954 of the CFI-10 showing the same thing.

Defendant's Exhibit O-9 which is entitled "Day-Brite's CFI Industrial Lighting Fixture for Power-grooved Lamps," copyright 1957, by Day-Brite, Inc.

Defendant's Exhibit P-1, which is the certified copy of the design patent file wrapper which is the history of the patent.

Defendant's Exhibit P-1, which is a reproduction of the first office action in that file wrapper in which the Patent Office said:

[fol. 270] "The four cross-ribs on the under side as shown in Fig. 1 have been considered but these appear to be purely for the mechanical purpose of stiffening the reflector and no ornamental significance can be attributed thereto."

That is P-1.

Defendant's Q, which is the file wrapper of the mechanical patent application with identical fixture, Serial No. 482,212.

Defendant's Exhibit Q-1, which is a reproduction of Page 4 from that file wrapper and of the patent application in which the defendant stated that the transverse stiffening ribs which—in which the plaintiff stated—

Mr. Ooms: Your Honor, can't we have these go in—I don't like to have counsel testifying as to what was stated without my having an opportunity to examine them.

Mr. Mullin: I am not testifyiflg. I am just reading this for the benefit of the Court.

The Court: It was offered before.

Mr. Mullin: Yes.

The Court: It was offered.

Mr. Ooms: It has never been offered.

Mr. Mullin: They have been identified.

Mr. Ooms: None of these have been offered, as I understand.

The Court: It was read into the record already.

Mr. Kraus: No, not much of it, just one or two pages.

The Court: He can introduce it. You can object to it when your times comes.

Mr. Ooms: Okay.

Mr. Mullin: This is in the application.

"And transverse stiffening means which take the [fol. 271] form of flanges along the margins of the light emission openings and ribs directed across of transversely of the reflector body so that stiffness and rigidity in both longitudinal and transverse directions of the reflector bodies may be obtained without detracting from the appearance and clean, unobstructed surface of the reflector."

Q-2. The rib elements. That is Page 8 of the file wrapper from the same application:

"The rib element has an approximate uniform shape in section. The rib, 17 is—"

It has been interlined here.

"The rib is the relatively narrow—"

"—are located in the relatively narrow web of material provided between the vents 15 and not only restore the strength of the reflector body which is caused by the formation of the vents, but also hold or set the curvature of the side walls 12, so that stiffness or resistance to warpage and flexibility in the body 10 can be created."

Q-3, which is Page 12 of the file wrapper, and reading from a portion of the claim:

"And means adapted to stiffen said reflector body against warp and twist, including flanges formed about said body openings and ribs extending across said longitudinal light-reflecting wall and into each of said side walls."

Q-4, which is Page 25 of the file wrapper, reading from a portion of Claim 17:

"Means adapted to structurally stiffen said body against twisting and warping, said last means including rib portions extending into and conforming to the formation of

[fol. 272] each of said lateral surfaces and directed transversely of the length of said body, rib elements extending transversely of said central light reflecting surface and located between said rib portions."

Q-5, Page 11, which is Page 11 of one of the Office actions, Page 32, rather, of the file wrapper:

"Claim 17 calls for body stiffening means including rib portions extending into the lateral surfaces. Thus Claim 17 calls for the lateral and central reflecting surfaces in a reflector unit body having stiffening means comprising transversely directed ribs and flanged vent openings wherein the transversely directed ribs extend across the reflector body with a pronounced stiffening effect on the otherwise unstiffened surfaces."

Q-6, which is Page 47 of the file wrapper:

"The unit is provided with means to retain the spacing of the side surfaces in fixed relationship, such means including rib portions in each side surface extending transversely from the space between the apertures outwardly and downwardly into the side surfaces to substantially fix the form thereof."

Q-7, which is Page 48 of the file wrapper:

"Guth's Quick-Liter and Mazelite, Pages 31 and 32 also illustrate the failure to appreciate the need for fixing the spacing of the side reflectors, since there is nothing disclosed to prevent these sides from relative movement."

Q-8, which is Page 106, reading from Claim 33:

"A plurality of ribs directed transversely of the body length and spaced apart along the length thereof and fixedly,"

and then skipping a portion,—it isn't important to what [fol. 273] I am driving at here—

"—and fixedly supported by said ribs in spaced relation"—

and then skipping another portion,

"—said ribs extending between said openings and fixing the spacing of said side reflecting surfaces."

Q-9, which is page 181 of the File Wrapper.

"We are convinced"—this is a decision of the Board of Appeals in rejecting the appeal.

"We are convinced that the Examiner is correct in his position that no invention was involved in providing the elongated reflector of Abernathy, with transverse stiffening ribs or corrugations located between the openings and extending the width of the elongated reflector. It seems to us, in view of the state of the metal working art as it existed prior to the time when Appellants made their present disclosure, no invention was involved in merely using a reinforcing rib or corrugation to strengthen or stiffen a sheet metal member, whether it was an elongated reflector or any other article, especially where the secondary references recognized that such means could be used to strengthen or stiffen such an elongated reflector at points where it was decided that strengthening or stiffening was desirable."

Q-10 which is the affidavit made by James F. Whitehead, President of the Plaintiff, and which we have already, I believe, read into the record and which states that the commercial success was due to the function, to overcoming the objections that existed in their prior CFI Day-Line fixture.

Mr. Ooms: I don't mind him reading, your Honor, but when he argues this—

The Court: I have read it before.

[fol. 274] Mr. Mullin: All right.

Defendant's Exhibit OO, comprising a complete fixture of the accused—I am sorry, but these won't be in alphabetical order. It will be faster this way.

Defendant's Exhibit EE, comprising carton of the Mitchell reflector fixture.

Defendant's Exhibit NN, comprising the complete fixture of the Day-Brite.

Defendant's Exhibit FF, comprising the carton of the Day-Brite fixture.

Defendant's Exhibit U-1, comprising the Mitchell catalog dated, copyrighted 1949.

Defendant's Exhibit V-1, which is the letter from the Plaintiff's attorney to the Defendant, dated March 30, 1956, with two photocopies of previous letters, one dated December 21, 1955 from Day-Brite to the Cory Corporation and another dated November 28, 1955, which is a letter from the Day-Brite Lighting, Inc. to the Cory Corporation, with a letter to Mr. Bernard A. Mitchell, Glencoe, Illinois.

Defendant's Exhibit V-2, which is a copy of the letter answering the Plaintiff's charge of infringement dated April 9th, 1956, denying the infringement and denying the validity of the patent.

Defendant's Exhibit V-3, which is a letter dated June 7th, 1956 from myself to the Defendant, stating that I am—well, I will read it because it is short:

"I am enclosing a copy of Day-Brite's Design Patent No. 177,532, which recently issued. I assume that since we have heard nothing in reply to our letter of April 9th that the matter is closed. At any rate, I suggest that you keep this patent in your file."

[fol. 275] Incidentally, that patent is not the patent in suit.

Defendant's Exhibit W, comprising a drawing of the Day-Lite Lighting, Inc. No. PI-30990 of the Day-Brite Lighting, Inc.—PI-30990, and referring to the change marked "D"—"rib depth reduced."

Mr. Kraus: Wasn't that read in with the deposition?

Mr. Mullin: Yes, that was read in with the deposition. So, that is already in evidence.

Mr. Ooms: Just a moment. Isn't that our exhibit?

Mr. Woodruff: It may be.

Mr. Ooms: It was the one I was looking at.

Mr. Woodruff: Defendant's Exhibit 19.

Mr. Ooms: It is our exhibit. It has been received.

Mr. Woodruff: We put it in with our 21.

Mr. Mullin: Along with that batch?

Mr. Woodruff: Yes.

Mr. Mullin: It is already in? All right, as long as it is in.

The Court: Will you take these exhibits and keep them. Will you be responsible for them?

Mr. Ooms: Your Honor, would you want me, sometime during the recess, to look at these and I will specifically state—

The Court: I want them to have them in their custody. They are subject to your inspection.

Mr. Ooms: Oh, yes, and then I will give you my objections and the reasons for them.

The Court: All right. We will recess until two o'clock.

(Whereupon the trial of the above-entitled cause was recessed until 2:00 o'clock p.m. of the same day, Wednesday, October 5, 1960.)

* * * * * * * *

[fol. 276] Court convened pursuant to recess.

(And thereupon the following further proceedings were had herein:)

The Clerk: Case on trial.

Mr. Mullin: We have one more prior art patent, your Honor.

The Court: All right.

Mr. Mullin: Will you mark this Defendant's Exhibit N-10 for identification.

(The said document was thereupon marked Defendant's Exhibit N-10 for identification.)

Mr. Mullin: This is a British patent No. 638,796.

The Court: Has that been submitted to counsel?

Mr. Mullin: No, no, your Honor. I will show it to him now. That is a picture showing a cross-rib all the way across and down the sides.

Mr. Ooms: As long as counsel made the statement, that [fol. 277] is not a rib, that is a bead for the end cap.

The Court: All right.

Mr. Mullin: And this is Defendant's Exhibit BB, which is the production drawing of the defendant's fixture.

The Court: All right.

Mr. Mullin: All right. Now I will call to the stand Mr. Hammer.

HY HAMMER, called as a witness on behalf of the Defendant, having been first duly sworn, was examined and testified as follows:

Direct examination.

By Mr. Mullin:

Q. What is your full name, please?

A. My name is Hy Hammer, H-a-m-m-e-r.

Q. And what is your residence address, please?

A. Itasca, Illinois.

Q. Do you have a street address?

A. There is a county address, if it means anything; 6 N 130, Route 53, Itasca, Illinois.

Q. And how old are you, Mr. Hammer?

A. Fifty-two years old.

Q. What is your present occupation?

A. Well, I am occupied as a consulting design expert. I am in the manufacturing business of metal specialties and the tool and die business. Various businesses and occupations.

Q. What is your manufacturing business? What is the name of it?

A. Hammer Brothers, Incorporated.

Q. And your tool and die business?

A. The Illinois Advance Tool and Die Corporation.

[fol. 278] Q. You say that you are a consultant on metal forming and design?

A. That is right, sir.

Q. What is your academic training?

A. Well, I attended the Art Students' League in New York, the National Academy of Design in New York, the Cooper Union Institute, Pratt Institute, the Art Institute of Chicago, and several other institutions.

Q. Did you attend any foreign institutions of learning?

A. Yes, sir, L'Ecole Beaux Arts in Paris, France.

Q. And do you have any degrees?

A. Not in arts, no.

Q. What degrees do you have?

A. I don't have any degree.

Q. And can you tell us something about your background as a design consultant?

A. Well, I have worked with many prominent designers, men like Henry Dryfus, Raymond Lowey, Norm BelGetti, Walt Lipky & Associates, and various others.

Q. In what capacity did you work with them?

A. As a designer.

Q. And can you name a few of those who have retained you as a consultant?

A. Well, the Westinghouse Elevator Company, the Otis Elevator Company, the Coca-Cola Company, the Joseph Schlitz Brewing Company, and many others.

Q. Have you ever received any honors or mentions for your—

A. Yes. I won an exhibition at the Congressional Library in Washington some years back. I won the Abbott prize in 1939 and several other academic prizes.

Q. Have you ever designed any lighting fixtures.

A. Yes, I have.

[fol. 279] Q. Have you ever designed any industrial lighting fixtures?

A. Yes, I have.

Q. You have mentioned that you also are consultant on metal forming?

A. Yes.

Q. Do you know anything about the manufacture or forming of metal reflectors?

A. Yes, I do.

Q. What do you know about them?

A. Well, if there is anything specific you would like to get an answer on—

Q. In other words, do you know all phases of the forming of metal reflectors?

A. General practice, yes.

Q. Do you know anything about the coating of reflectors?

A. Yes, sir, in a general way.

Q. Do you know anything about the porcelain enameling of reflectors?

A. I have had some experience with it, yes.

Q. Will you tell us, Mr. Hammer, why ribs are used in the design of various articles?

A. Well, fundamentally, they are used for structural purposes. They are similar to—well, a rib forms an arc or a beam in a thin metal. Where a thin metal is used and reinforcement is required, one of the ways is by ribbing it.

Q. And that, then, strengthens the metal, is that it?

A. Yes. It forms a peripheral arc in a reflector of this sort.

Q. Well, referring to some of the reflectors here, and I am referring to Plaintiff's Exhibits 4, 5, 33, 12, do you think that ribs are necessary in these reflectors?

A. Yes, I should think they are.

[fol. 280] Q. Why are they necessary?

A. Well, in the length of that material, the length of that thin sheet metal, there is, naturally, a warping and a buckling of metal as it is bent and, to take up the warping and the buckling, ribs are generally resorted to, small ribs.

Q. In the application of the porcelain enameling, what temperatures are these fixtures subjected to?

A. Generally between fifteen and sixteen hundred degrees Fahrenheit if it is a vitreous porcelain, yes.

Q. Do you know what would happen to a reflector having weakened areas, for example, as this, with metal slots removed in the porcelain enameling?

A. Yes. It would buckle and warp.

Q. Would the same thing happen if you had these cross ribs formed in there?

A. To a much lesser degree.

Q. Well, directing your attention to the Plaintiff's Exhibit 4 which is their reflector, what is the purpose of these ribs and I am referring to these cross ribs here (indicating).

A. They appear to me to be used for strengthening and reinforcing purposes.

Q. Would they have any other function or purpose?

A. Not in my opinion. No. I see no other purpose for them.

Q. How long a rib would you need in order to prevent the warpage and buckling that you describe?

A. Well, to help prevent the warping or buckling, you would need as much as you could get. I mean, if you could

get the entire periphery of the arc or curve, it would be that much more rigid, that much more longer.

Q. If you had the rib extending just from this first red line here (indicating), across the top and to the same distance on the other side, would that be enough?

[fol. 281] A. No, it would not. It would not stiffen the sides at all.

Q. If you had it extending down to this point (indicating)? I am pointing to the second red line.

A. It would begin, along the spring line of the curvature, it would begin to have its effect and the farther you went, the more effect you would have.

Q. And if you had this down to this point (indicating) where you have it here (indicating)?

A. Yes, it would have its effect to that degree. If it went further into that and tied into the lower rib, it would be even more effective.

Q. In other words, if you extend this all the way to this flange (indicating)?

A. Yes, sir.

Q. Then you would have even a stiffer rib?

A. Yes, sir.

Q. And more resistant warpage?

A. Yes, sir.

Q. Now, I show you Plaintiff's Exhibit 33 which as you can see, is a reflector. Will you examine this?

A. Yes.

Q. Would you say that is a good reflector?

A. As of that structure?

Q. Yes.

A. No, it is not as good as the rib, you know.

Q. Well, is there anything wrong with this?

A. Well, it has lineal ribs, as we see. There is a channel rib here (indicating) an angle rib here (indicating) which tends to stiffen the length, the lineal dimension, but does not stiffen the sides of the transverse—as the transverse ribs do.

Q. Well, is this a good straight reflector or is it formed—

[fol. 282] A. No. I would say it was dimensionally unstable.

Q. And warped?

A. And warped, buckled, yes. Yes, it is warped.

Q. What would happen if you put ribs just across the top here (indicating) between the slots?

A. You would take the buckle and warp that occurs in these areas and if you place the ribs symmetrically, the transverse ribs symmetrically, evenly spaced apart, perhaps, which is an ideal situation, you would get the buckles out. You would pick up the curvature in the deflection of the material as you ribbed it.

Q. I am talking about ribs across the top.

A. You would stiffen the back, the top.

Q. What would you have to do to stiffen the sides and to fix their relationship to each other?

A. You would have to reinforce the periphery of the shape as far as you can. One of the ways you can do it is by indenting the rib, causing a gusset to appear or a beam similar to a gothic arc. You would be forming an arc.

Q. How far would you have to extend it?

A. As far as you can. The further the better.

Q. You are talking about down the side?

A. Yes.

Q. The ideal way would be to extend it all the way to the bottom flange?

A. Yes.

Q. You would have a good stiff rib that would resist warpage?

A. Yes.

Q. That would resist warpage even after porcelain enameling?

A. Yes. It would strengthen it generally, under any conditions.

[fol. 283] Q. Now, as a designer, and speaking strictly from the aesthetic point of view of a designer, is it or is it not desirable to have ribs extending down into the sides?

A. Aesthetically?

Q. Just aesthetically.

A. Aesthetically, I would not think so.

Q. Why not?

A. Well, I would rather, if I was designing the reflector, I would rather have it clean and smooth, if I could. The ribs in this, in the reflector you are holding, appear to me to cause other things besides stiffening and reinforcing.

They are dirt catchers. On the reflective side, on the inside, I imagine they disturb the light beams and they are grease holders under a roof. That is quite obvious. So, I would rather not have them, aesthetically.

Q. In your opinion, do these ribs add anything to the artistry of these fixtures?

A. Not at all. In my opinion, they detract from the cleanness of the design, the pureness.

Q. Is that what designers strive for, a clean appearance?

A. Yes. I think that is the ultimate, a clean pure feeling when we can get it.

Q. Well, then, why do they use these ribs?

A. As I stated a moment ago, for reinforcing purposes, structural purposes, quite obviously.

Q. And is that the only reason, then?

A. I see no other reason.

Q. Now, I direct your attention to Plaintiff's Exhibit 12 which is the plaintiff's prior reflector, called the "Day-Line." Will you compare that—I guess I will have to stand back here—will you compare that with Plaintiff's Exhibit [fol. 284] 4 which is their present fixture and tell me which of the two you would prefer, from an aesthetic viewpoint.

A. Well, the one to the left, without question, the one to my left.

Q. Which is Plaintiff's Exhibit 12?

A. That's right.

Q. Without question?

A. Definitely.

Q. Why would you prefer that?

A. Well, it is cleaner. It is smoother. It is purer. The less we have there, the better off we are.

Q. From a structural standpoint, do you see any defects in this?

A. Obviously. I would prefer the one that was to my right a moment ago.

Q. From a structural viewpoint, you are talking about?

A. Yes. I would find that this has a lot of flex in it and is unstable, dimensionally (indicating).

Q. You just flex these sides (indicating)?

A. It is difficult to hold the dimension.

Q. It is difficult to hold the dimension?

A. Yes.

Q. It has ribs or beads across the top. Is that sufficient to do that?

A. It is not sufficient to do it to the sides.

The Court: I think he has covered that several times.

Mr. Mullin: Not this expert hasn't, your Honor.

The Court: In general.

By Mr. Mullin:

Q. Do you think that it is unusual, or, is it obvious to lengthen these ribs to the size shown and, I am pointing now to Plaintiff's Exhibit 12, to the size shown in Plaintiff's Exhibit 4?

[fol. 285] A. Well, there would, of course, if the idea is to throw light to the ceiling,—probably the longer aperture would be more desirable, but would weaken the structure as you went along, lengthening the aperture.

Q. You are removing more metal?

A. Of course, and you are shortening the bridges, the supporting bridges.

Q. Well, would you consider it obvious or unusual to extend these ribs down further into the side?

A. Structurally?

Q. No. Well, in your opinion, would it be an obvious thing for a designer or would it be an unusual thing for a designer to do that?

A. It would be unusual for him to extend them, from an aesthetic point of view.

Q. From an aesthetic point of view?

A. That is right. From structural viewpoint, from a support point of view, an engineer would be inclined to bring them down.

Q. Would it be an obvious thing?

A. Yes; it would be quite obvious to me.

Q. Now, do you know how these reflectors are made?

A. Yes, I do.

Q. How are they made, by what process?

A. Well, there is a combination of processes. There is

stamping, forming and debossing, in this case forming, breaking.

Q. The stamp?

A. Or bend or break. They are pierced with dies and formed with drawing dies.

Q. Now, directing your attention, again, to Plaintiff's Exhibit 4, I note that the rib at the corner or at the [fol. 286] curve seems to be widened. Could you explain the reason for it?

A. Why it is widened?

Q. Yes, at that particular point?

A. Well, that is the point of the spring line where the bend begins and, of course, that is where all your trouble begins and the more reinforcing, the more support we could get there; the deeper the beam—I refer to it as a beam, or, I refer to it as a rib—it would be stronger, the more support would it give.

Q. So, the main thing is to get a wider rib at that point, is that right? I am pointing now to this drawing, Defendant's Exhibit AA and these are the points of curvature (indicating).

A. I would say a deeper rib, sir, if possible.

Q. Now, are you familiar with any of the prior art in this case?

A. Not very much, sir. Just from what I have heard this morning.

Q. But, you do know something about patents, do you?

A. In a general way, yes, sir.

Q. For example, if I show you this Defendant's Exhibit M, which is a patent to Abernathy, could you describe what the essentials are?

A. Yes.

Q. Would you describe that to the Court, please?

A. Well, it shows a perspective view, a cross-section, and a top view of a reflector, apparently of this sort. It shows the various apertures, rib apertures at the top portion of the reflector, similar to those apertures, many more of them, proportionately more of them on this drawing than there is on the fixtures and they are seemingly higher flanged than the ones I see before me. The shape is somewhat similar. It is about what I see here in general.

[fol. 287] Q. What type of shape is it? Is there a word to describe that shape or curve that you see there?

A. Well, the curve I see here, the curves appear to be, on this drawing, circular, that is, part of a circle. They appear to be a quarter circle, the ends do.

Q. How would that compare with the shape here?

A. Well, the shape I see before me appears to be more parabolic than circular.

Q. But, are they similar, then, in shape?

A. They are similar in shape, yes. I believe the circular shape on this drawing is not as deep or as long as the subject matter.

Q. But, it is of generally the same shape?

A. Yes.

Q. But on that Abernathy patent, are there any ribs shown?

A. I see only a lineal rib across the bottoms.

Q. What does that mean? Point that out to me.

A. Across the very bottoms there is a lineal rib on both sides. There are no lateral ones.

Q. Would that compare to this (indicating)?

A. That would compare to that.

Q. Now, on this CFI "Day-Line" Plaintiff's Exhibit 12, would you call these ribs (indicating)?

A. Well, they could be called ribs, yes.

Q. Are there other words used to describe it?

A. Yes, sir. Sometimes they are called embossings or debossings or grooves or reeds, ribs.

Q. Have you ever heard the word "beads" used?

A. Beads, perhaps, yes.

Q. Now, I hand you Defendant's Exhibit 3 and refer your attention to Page 31 and ask you if you can describe for the Court the configuration of the shape of that particular reflector.

[fol. 288] A. Well, I see a reflector fixture here that apparently is of the same length and obviously of a similar width and similar shape and probably is the same—used for the same purpose or similar purpose.

Q. Do you see any ribs or embossings or beads on there?

A. Yes. I see the lineal ribs, the lineal reinforcements

and the peripheral ones, the four ribs similar to the fixture that I am looking at.

Q. Do those ribs extend down into the sides?

A. Yes, they do.

Q. Could you term those transverse ribs?

A. Well, yes, they could be termed that.

Q. Transverse or lateral?

A. Yes.

Q. What was that other one?

A. Or peripheral.

Q. Peripheral?

A. That's right. They are all synonymous.

Q. This is Plaintiff's Exhibit 12. Did you testify that it would not, from an aesthetic point of view, from an artistic point of view—it would not be unusual to extend these ribs down into the sides?

A. I say it would be unusual from an aesthetic point of view.

Q. And from a structural viewpoint?

A. From a structural viewpoint the rib that I am looking at now does, in my opinion, nothing for the sides.

Mr. Ooms: Unless he is cross-examining the witness, your Honor, I do not see any further purpose in—

The Court: You have gone over that four or five times.

By Mr. Mullin:

Q. Now, if a designer had this in front of him, and I am looking now at Plaintiff's Exhibit 12, and had the Guth in [fol. 289] front of him, would it be obvious to extend the rib down into the sides?

A. A designer aesthetically?

Q. Yes.

A. I don't think he would want to, no.

Q. And a designer wouldn't? But would a manufacturer, for example?

A. As a manufacturer I probably would want to extend them. As a designer, I would rather omit them.

Q. Why?

The Court: He has explained that several times.

Mr. Mullin: All right. Okay. Strike that.

By Mr. Mullin:

Q. This is Defendant's Exhibit N-10, which is a prior patent of July 6, 1948. Will you look at that and tell the Court whether or not you see a cross-rib there or a bead, or whatever you term it.

A. Well, without reading it, just looking at the illustration, I see a rib, yes, I see a cross-rib.

Q. And where does that extend, from where to where?

A. It extends across the entire periphery.

Q. From one end—

A. From one edge of the metal to the other edge.

Q. All the way around?

A. Yes, with the exclusion of the channel.

The Court: Is that a drawing or merely a section?

Mr. Mullin: That is a drawing of the end portion of a reflector.

By Mr. Mullin:

Q. Now, directing your attention to Figure 4—

Mr. Mullin: I have another copy, your Honor, if you would like to look at that.

The Court: No.

[fol. 290] By the Witness:

A. The same thing?

By Mr. Mullin:

Q. Yes, the same thing. Directing your attention to Figure 4, what does that show?

A. Well, Figure 4? I have not read the comments here on the figures, but it appears to me to be a reinforcing angle.

Q. Does that have any relationship to this bead 5? (Indicating)

A. Well, again, I say without reading it I would say that it fits over the bead 5.

Q. So then this rib 5 serves a double purpose, doesn't it?

A. The rib 5, yes. It apparently is a strengthening and reinforcing rib and also a fastening device.

Q. For this end piece? (Indicating)
A. Apparently for No. 4, yes.

The Court: Is that readable in the patent?
Mr. Mullin: Oh, yes.

By Mr. Mullin:

Q. All right. I now show you Defendant's Exhibit N-9, which is another prior art patent, dated 1941, of a fixture. Can you describe that generally to the Court?

A. From the diagram I see various shapes, some angular, some round, of apparently a reflector section, sections through reflectors, and I see that across the top of it there are eight openings.

Q. Do you mean four on each side?
A. Four on each side of the length, that is right.
Q. And are those uplight slots, would you say?
A. Apparently they are.

Mr. Ooms: What was that patent, counsel?
Mr. Mullin: That is N-9.

[fol. 291] By Mr. Mullin:

Q. And is the shape of those slots similar to Plaintiff's Exhibit 4 for identification?

A. Yes, they are.

Q. I now show you Defendant's Exhibit L, which is a two-page catalog of the Westinghouse Company, and direct your attention to the second page, to the limitation on the upper right-hand corner. I ask you what that shows.

A. Well, I see a fixture along these general lines of what we have been talking about, with apertures in the top. Here I see twelve apertures, six on a side.

There is no way of knowing how long this is, but there are six apertures on each side of the top. (Indicating.)

Q. Are there any ribs present?

A. It is very difficult to see from this photograph. This is a very light half tone photograph, but I would assume that they are there. They appear to me to be there.

Q. Where are they located, if you can tell?

A. Across the top of the reflector.

Q. Is this a little better for you? This is a blow-up of that.

A. I see. Yes, they appear to be angled. They are turned up or extruded, commonly referred to as extruded openings.

Q. And what about the ribs; where are they positioned there?

A. The ribs, as far as I see, are lineal.

Q. Are there any transverse ribs?

A. There don't appear to be any here, no.

Q. You can't see them, is that it?

A. They don't exist here on this photograph.

[fol. 292] Q. Well, this may help you. (Indicating.)

A. That shows that, but this photograph—I see no ribs here, no.

Q. You can't tell from this photograph, is that it?

A. That is right.

Q. Just so that the Court will appreciate the true function of a rib, can you make any demonstration of what a rib does to a thin sheet of metal?

A. I think it would be simple to demonstrate with a sheet of paper. Here we have a sheet of ordinary writing paper. If I attempt to hold this up, that is what would happen to it. (Demonstrating.)

However, if I were to rib it, fold it, in effect ribbing it or arcing it, I could very easily hold this thing up. (Demonstrating.)

Q. It makes it rigid?

A. There it is. If I was to take part of it out probably that part might flop.

Mr. Mullin: That is all. Now, just for the record, a sheet from a yellow pad, a legal pad, was used, a ruled pad.

Cross examination.

By Mr. Ooms:

Q. Mr. Hammer, I believe you said you are generally familiar with the prior art.

A. Yes, sir.

Q. When did you become familiar?

A. Well, I don't—

Q. Just a moment. I did not even finish my question. Do you want to make an answer?

A. I said, from what I heard about it this morning.

Q. Oh, that is all your familiarity with the prior art?

A. With the prior art in this case.

Q. And is that the first time you became familiar with this case?

A. That is right.

[fol. 293] Q. That was this morning?

A. That is right.

Q. You were not here then when the Westinghouse man testified about the Westinghouse fixture, that it in no way indicated the design of any of the accused structures here?

Mr. Mullin: I object to the characterizing of the testimony of the witness.

By the Witness:

A. No, I wasn't here.

The Court: Sustained.

By Mr. Ooms:

Q. Look at these fixtures, Mr. Hammer. When was the first time you saw them?

A. This morning, sir.

Q. You never saw any of these fixtures before?

A. No.

Q. I believe you testified that you designed industrial fixtures.

A. I have designed industrial fixtures.

Q. How long ago was that?

A. I think perhaps we ought to qualify what industrial fixtures means. I think that industrial fixtures, as I understand them, is merely a semantic that is used in your trade, in the trade of making. Now, what do we mean by industrial fixtures?

Q. Well, you said that you design industrial fixtures; what do you mean?

A. Well, industrial fixtures—I have designed fixtures for elevator cabs, for corridors, for buildings—

Q. Lighting fixtures?
A. Lighting fixtures.
Q. And how long ago was that?
A. The last one?
Q. Yes, sir.
[fol. 294] A. Probably 60 days ago, 60 or 90 days ago.
Q. And for whom was that?
A. For a firm I am with.
Q. Who is that?
A. Hammer Brothers, Incorporated.
Q. It is a sheetmetal company?
A. A lighting fixture company.
Q. What type was that?
A. This was a lighting fixture to produce light downward.
Q. So anything that throws light is an industrial fixture?
A. Well, I don't know just what we mean. Do we mean industrial fixtures literally? If it is used in industry it is industrial.
Q. How do you mean in the lighting industry, such as is involved with the parties here?
A. I don't know. I gathered this morning that it means something specific. It never meant anything specific to me before.
Q. Have you ever designed a lighting fixture that had this general configuration of these particular exhibits here, that is, 4, 5, 12—
A. Pardon?
Q. I was just giving the numbers for the record to be clear.
A. All right.
Q. Have you ever designed any fixtures with that general configuration?
A. With what general configuration?
Q. The general configuration of these particular reflectors (indicating).
A. In a general way, yes.
[fol. 295] Q. Well, in a specific way have you?
A. In a specific way, yes.
Q. All right, will you tell us about it?
A. Well, I designed and engineered a fixture called the focal light.

Q. For whom?

A. For a firm I was connected with at the time, a firm called Price Brothers, Incorporated.

Q. Yes.

A. This was a fixture that was widely used by many of the department stores.

Q. And did they hang it from the ceiling, is that it?

A. Yes, yes.

Q. And how long ago was that?

A. Well, I believe the patents on that thing were issued in the middle 30's.

Q. And did it have any uplighting in it?

A. It varied. There were fixtures that we made that had uplighting, side-lighting, down-lighting, end-lighting, and so on.

Q. I believe you used the same words, "rib" and "bead", in the same general sense, is that correct?

A. I think they can be used in this instance.

Q. Isn't it generally understood that a rib is something that has an indentation into metal and a bead is pushed out?

A. Well, it depends on which side the metal was lying at the time.

Q. I am talking about the usual circumstances.

A. No, I don't think so, not in my own vocabulary.

Q. Well, you testified about this British patent, isn't that correct, on direct examination?

A. Yes.

[fol. 296] Q. Now, this area called 5, I believe you said that was a bead or rib—

A. Yes, it is.

Q. That is merely a fastening means for this end plate, isn't it?

A. I believe I said it was a fastening means and also for reinforcing.

Q. If you will read that patent—can you find anywhere in that patent where it refers to a rib or any reinforcing means or find any rib across the entire length except for the means for fastening the end cap?

A. You understand I was testifying from a drawing? I have not read this.

Q. You did not read it then?

A. No.

Q. Now, have you ever made tests on ribs to determine where they are functional and where they are non-functional?

A. Oh, yes.

Q. Have you made them with these type of reflectors?

A. No, no, I haven't.

Q. You have not made them at all?

A. I have never seen these reflectors before this morning.

Q. I see. So you don't know actually where a rib here becomes functional and where it becomes non-functional?

A. No, I could not at this moment tell you where it becomes functional but it is a general practice to rib a piece of thin sheet metal.

Q. Yes.

A. Now, oftentimes— May I go on?

Q. Certainly.

A. Now, oftentimes the diemaker or the designer or the draftsman that is drawing it will take an arbitrary [fol. 297] depth which he apparently has become acquainted with in his experiences and decide to go down some depth, and from his experiences that it will hold, it will reinforce.

It is quite fundamental that the shallower it is, the less stable.

Q. In other words, if you took a deeper draw and a longer draw you would have a much bigger problem with the tearing of the metal when you formed it, isn't that true?

A. That is right. You can only draw to the extent of the properties of the metal, that the properties will allow or permit.

Q. Is it not ideal, therefore, to only use that amount of ribbing depth and length which you would normally want just for the function to give it rigidity and stability that you desire?

A. Well, I don't know whether it would be ideal. I think that we would, engineering-wise, want to take insurance and if you felt that perhaps a quarter inch was enough, you might go three-eighths and then you would have that additional insurance.

Q. And even though if you took an extra two or two and a half inches your tooling costs would run you much more?

A. Are we speaking peripherally now?

Q. I am speaking of the entire rib. Do you know how they formed this rib in here? (Indicating.)

A. Sure. I don't think the tooling charge would be much more.

Q. Of course, you were not here to hear or have the benefit of depositions but that is neither here nor there. Do you know how they make this particular rib (indicating)?

A. I believe so.

[fol. 298] Q. How do they make it?

A. I believe it is formed in the male portion of the die.

Q. It is punched out, is it not?

A. It is drawn.

Q. Is it one or two stages?

A. Well, I don't know how the people who did this did it, but I believe it could be done in one stage and, depending on the person's knowledge of what he was doing, he might resort to two or three stages.

Q. And that, of course—

A. But I would assume—

Q. You are only assuming?

A. I am sure this could be done in one stage.

Q. And that is your experience?

A. That is my experience as a tool and die designer.

Q. If you had to go to the second stage, your tooling expense would be greatly increased?

A. Not the tooling; the operational expense.

Q. The operational and tooling. You would need more tooling?

A. No. You might go down part way and then come again, using that vernacular.

Q. Right.

A. With the same tool.

Q. You think you could?

A. I think a lot of it, if I may say so, depends on the nature, the temperature and the molecular quality of the steel they are using. I don't think you could put that in any type of thin steel but there are types of thin steel on

the market, deep drawing stock, for example, which is self-evident in its own expression, that you could draw deeper, and the various tempers of the steels, as you know,—

[fol. 299] Q. Now, you said aesthetically speaking, putting those ribs down the side would be unobvious, is that correct?

A. Yes, to me, in my opinion, and my aesthetic sense, absolutely.

Q. And tell me in your aesthetic sense if no one in the market—assuming no one in the market has taken ribs and put them all the way down to the side, as in these exhibits, for what purpose would they do it?

A. Well, they would do it for dimensional stability mostly in their fitting, if they are fitting to something, and probably in this case where they are going through a high temperature oven for vitreous enameling.

Q. Have you had an opportunity to examine Plaintiff's Exhibit 12?

A. Well, I viewed it from here a few minutes ago and scanned it.

Q. And would you say this is a structurally sound reflector in your opinion?

A. I would say in its degree, sir—I mean, there are degrees of soundness.

Q. I am talking about a good commercial, saleable product.

A. Well, not being acquainted with what the dimensional stability calls for—

Q. You have never tested these for stability, dimensional or otherwise?

A. I would say if it were a critical dimension it would be unstable.

Q. Then as a designer it would appear to you to be foolish, aesthetically speaking, to run those ribs the way they have been done?

A. Yes, it would to be as a designer, aesthetically speaking.

Mr. Ooms: No further questions.

[fol. 300] Redirect examination.

By Mr. Mullin:

Q. But as an engineer or as a person skilled in the art, would it be foolish to extend these down (indicating)?
A. No, it would be wise.

The Court: He answered that several times.

By Mr. Mullin:

Q. So that when you are saying that it is unobvious to a designer, do you mean that a designer would not do that ordinarily?

The Court: He has emphasized it and I have got it clearly that according to his point of view esthetically it is better without them and that mechanically it is helpful in its reinforcement.

The Witness: Exactly, sir.

Mr. Mullin: That is all.

Mr. Ooms: No further questions.

The Court: I guess that is all. Thank you.

The Witness: Thank you.

(Witness excused.)

Mr. Mullin: Your Honor, there was a request for admissions made during the pleadings and that has been answered. The request for admissions was for the admission of the genuineness of four pages from a deposition of a Bernard Geering, one of the Plaintiff's employees, taken in another case. Now, that has been stipulated to as being genuine and we would like to introduce that into evidence by reading it into the record.

Mr. Ooms: We admitted its genuineness, your Honor, but as to its materiality—this gentleman was present and available to counsel here to take his deposition in this case. I had no opportunity to cross examine and, therefore, I don't think it is material.

The Court: You admit its accuracy?

[fol. 301] Mr. Ooms: Its accuracy, but I had no part in that case, your Honor, so I was deprived—

The Court: Is it stipulated to?

Mr. Ooms: It is stipulated that he did so testify in another case.

The Court: All right, I will let it go in.

Mr. Ooms: That is the only thing. I don't agree that it is material. I never had a chance to cross examine or anything else.

The Court: Well, wait a minute. Let's talk about it a little bit. Make an objection to it.

Mr. Ooms: I have made an objection, your Honor, as to its materiality and, secondly—

The Court: Who is the witness?

Mr. Mullin: The witness is their own employee.

Mr. Ooms: But it was taken in another lawsuit.

Mr. Mullin: This is the cross examination portion of it, your Honor, and we have a case here which says specifically:

"Depositions taken by other Defendants in prior infringement suits brought by the same Plaintiff on the same patent are admissible in evidence under RCP 26(d)."

The Court: Do you admit that this is another infringement case but the same patent?

Mr. Ooms: Yes, absolutely.

The Court: I will let it go in.

PORTIONS OF CROSS-EXAMINATION OF DEPOSITION OF BERNARD GEERING TAKEN IN ANOTHER CASE READ INTO RECORD

Mr. Mullin: My co-counsel, Mr. Kaufman, will answer as he did yesterday. This is cross examination.

"Q.32 Now, confining your attention now to the CFI-10, what sort of sales argument did you give about the ruggedness of the construction?

A. Well, the problem that manufacturers have had with porcelain enameled fluorescent fixtures has been the [fol. 302] fact that they do not hold their shape and this is caused by two things—generally, either the forming of it, or, No. 2, when they get it formed it comes out correctly and when they put the porcelain on at high temperature it distorts the shape of the reflector.

So, what Day-Brite did, of course, was to design these ribs in their reflector so that they could, No. 1, get the shape, the form properly, and then when it was heated up it would maintain that shape to give the guys straight even lines, and also from any rough handling it would not have a tendency to distort itself.

Distortion is not too bad except with porcelain on it it could pop a lot of porcelain off, and this rib helped to prevent that from happening."

Mr. Mullin: Cross examination Question 33:

"Q.33 You say called your customers in the course of your"—

No, that is wrong.

"Q.33 You so told your customers in the course of your sales arguments to them that these ribs prevented the fixture from distorting or popping the porcelain off, is that right?

A. That is right. Nothing can make this impossible. It just went a long way to prevent it from happening.

Q.34 In any normal usage?

A. That is right. If you took the thing and threw it 50 feet down off the ladder you could pop some porcelain off certainly.

Q.35 Now, you had another fixture, the CFI Day-Line fixture in which you had some difficulty of that nature prior to the time that this CFI-10 came out, isn't that true?

A. Oh, sure.

Q.36 And the ribs were put in the CFI-10 fixture in [fol. 303] order to prevent those troubles that you had with the CFI Day-Line, isn't that right?

A. Of course, but let me explain this: the so-called trouble we had was nothing unusual. In other words, we sold great numbers of these reflectors and our product was superior to most even without—

Q. I am not trying to make you run down the company, Mr. Geerling.

A. I know. I don't want you to get the impression that the ribs were in there to correct a defect in the other. It was to make it a much better product.

Q. But it was to prevent this trouble you had with distortion and the porcelain popping off that had occurred in some instances with the Day-Line fixture that led to the putting of these ribs in the CFI-10 fixture, is that right?

A. To make it a better product, that is right.

Q. So my statement is essentially correct, is that right?

A. Well, except if you want to infer that the previous Day-Lite product was inferior, and that the ribs had to be put in to make it a standard or regular standard product.

Q. Well, the ribs had to be put in to overcome the difficulties you had been having so far as you had been having them with distortion and enamel popping off; is that right?

A. I don't think they had to be put in there at all. Very frankly, I think that we—this, again, is my recollection—again, it had not been at that time a great deal of experience in the field, but that our fixtures without the ribs were better lined up, better held in shape, better than any product on the market that I had observed, put it that way, that I had seen installations, see, and this particular product with the ribbing made it superior, made it better, made [fol. 304] it more sure, let us say that.

"For the occasions where we may have had some difficulty, and you can have this in steel, for example, you don't get the exact perfect type steel every time, and if you do this without ribs then you could have a tendency, although you buy the best type steel you know how, you could still have a problem and enamel the same way—you could still have a little bit of a problem.

"So with ribs, of course, this would take care of this additional possibility where your steel is not quite as it should be, the mill tolerances, and so forth, you can't hold them that closely, and if you get something a little bit bad you can have a problem and the ribs will help to overcome that."

Mr. Mullin: I would like to correct the reading here where counsel read:

"So with ribs"—It should be, "So with this rib."

Now, I would like to offer into evidence, your Honor, Defendant's Exhibit AA.

Mr. Ooms: I have no objection except as explained by the witness.

The Court: It may be admitted.

(The said document, so offered and received in evidence, was marked Defendant's Exhibit AA.)

Mr. Ooms: I wanted to say, namely, this cross-sectional rib is not found in the patent.

The Court: You made that observation last time.

Mr. Mullin: I would like to offer into evidence all the exhibits previously identified that were offered this morning and this afternoon.

Mr. Ooms: I obviously have not had a chance to look at them, your Honor. I can make a general objection to those paper exhibits which refer to the CFI-25, which is not here in the case, and to the mechanical patents.

[fol. 305] The Court stated yesterday they could be used for purposes of impeachment. He read those portions into the record for that purpose. I, of course, have no objection, but as to any other purpose, it has no place in this design patent case.

The Court: I would like you to explain to me, and I have been a little bit confused, about the mechanical patent and the design patent, not with respect to the evidence before me so much as with respect to the law.

As I understand it, the design patent originally questioned by the Patent Office was during the hearings in the process, and as shown by the file wrapper, limited or modified or extolled or embraced by the assurances that the ribs extending beyond the upper surface to the side wings was purely aesthetic and for design purposes and not for any structural, practical reinforcing value.

Mr. Ooms: I would agree with that statement except when you use the word "purely," that means 100 per cent. It might be 98 per cent.

The Court: I know.

Mr. Ooms: That is substantially correct.

The Court: I am not an expert.

Mr. Ooms: Right. That is correct.

The Court: I have followed your testimony and I know it. Now, when you went to the Patent Office subsequently —I lost track, probably a year or two later—

Mr. Ooms: The same time. They were filed at the same time.

The Court: All right, simultaneously; in pressing your patent for the mechanical features, they declined the patent?

Mr. Ooms: That is correct.

[fol. 306] The Court: Because of that very thing—and see if I am right, that there was nothing inventive in the form of ribs from a structural point of view?

Mr. Ooms: That is almost a correct statement. Mechanically speaking, there was no patentability in the ribs associated with the other items, and in it was that CFI-25, methods of tying that in, and so forth. It just wasn't on the ribs.

The Court: They declined the patent or the issuance of a patent because they were firm in their position, and you prosecuted your claims all the way up to the highest court of appeals in the Patent Office?

Mr. Ooms: The first one anyway, yes.

The Court: I beg your pardon?

Mr. Ooms: That is correct.

The Court: Mechanical?

Mr. Ooms: Yes.

The Court: And you lost on the same theory, that there was nothing inventive or patentable mechanically and, therefore, you were not entitled to the protection?

Mr. Ooms: The mechanical patent, yes, sir, that is correct.

The Court: Now, I am confused on the law as to where the line of demarcation begins on the design patent. I might say now on the question of infringement I have already declared myself. I am convinced beyond any shadow of a doubt of the similarity of the products. I could go a step further and say that Mitchell bought your product, took it over and had it before it when they designed their product and, regardless of the petty differ-

ences—and our Supreme Court has repeatedly said in the patent law a man who steals a patent or copies a patent or infringes on a patent does not usually go whole hog, he resorts to some cheap change upon which to hang his hat [fol. 307] when he comes into Court and says, "Well, that little switch is different; this little opening is larger; this little thing is differently shaped."

In the main, from all of the evidence so far, I am duty bound to hold that there is infringement, that there is similarity almost in its entirety, almost to the naked eye. I say that will all due regard to what they have pointed out to me.

The function is the same, the shape is the same, the openings are the same, the number of them are the same, the ribs are the same in number, the ribs extend beyond —whether they have a little round curve on the top or have a little more of a straight curve, I am not concerned with. In the main it is the same.

I am disturbed about if the mechanical feature of it isn't patentable, is the design patent protected?

Mr. Ooms: My answer to that, very briefly, is that—

The Court: I am not asking for your answer now. That is what is disturbing me. It seems to me that they are awfully close, awfully close.

I also might say this to you: I am inclined to agree that the extension, or, the extending, the protruding of the rib into the sides has more than an ornamental value. It has a strengthening and reinforcing value. It will take some testimony to overcome that. But, the thing that is disturbing me—and, I am trying to think out loud.

Mr. Ooms: Right.

The Court: I have followed the case.

Mr. Ooms: I appreciate it.

The Court: I think I understand it. If I did not, I would study the record more closely. But, I have followed your witnesses. I have followed your exhibits. I am emphatic in my expressions. I am equally emphatic on the question of law.

[fol. 308] You will have to convince me that the design patent, merely because of the extension of the rib—that is all I have got before me so far—the only difference be-

tween the two designs is from a design point of view and not from a mechanical point of view and, I am distinguishing the two because I want you to know I am very mindful of it.

I am not clear in my own mind—legally, not factually, but, I will follow the law, whatever it is—whether or not the mere extension of a rib is strengthening. I think your witness said, somewhere in the record, at least one of them said that it has some strengthening effect.

I think it is somewhere in the record, that inference that I have from one of your witnesses; I don't know which one. Somewhere in the record you will find that there is that admission on his part, that while it was primarily, principally ornamental, artistic, aesthetic, it could have the effect of being a stronger reinforcement on the defects which it had prior to the introduction of the entire rib into the industry. Is that right?

Mr. Ooms: I don't recall it.

The Court: I am not asking you to say whether I am right or wrong.

Mr. Ooms: That's right.

The Court: But, that is what is going through my mind now. If the law, the design patent law can protect you on it, I will follow it, but, if it doesn't, I can't.

I haven't gone into the prior art and I haven't touched much on it. I have seen some little ribs stretched into the side walls—not too many, one or two patents. I haven't given much thought yet to the prior product of the plaintiff, before the patent which they have been harping on as prior art. I don't know where they get that phase of it except for the rib on the surface, at the top, not extended.

[fol. 309] Then there is a little bickering between the witnesses on how far that rib is extended on the side, between the side wall and the upper surface. There was considerable weight given, at least in my judgment; the further it goes into that, the more strengthening effect there is to the fixture.

That is where I am now.

Mr. Ooms: All right, your Honor. Thank you for the benefit of your thinking.

Mr. Kraus: Are these exhibits being admitted, your Honor?

The Court: Which exhibits?

Mr. Kraus: All of the exhibits that I had.

The Court: All exhibits are being admitted subject to your pointing out, in any one of them at any time, irrelevancy and, I haven't found very many in the prior art where they have a strong relevancy.

The mere fact that—I will tell you why—the mere fact that they cover a fixture of a similar nature, means nothing to the Court. The mere fact that the shape of the fixture is almost similar doesn't bear much on this Court because that is not the controversy. The shape of the fixture is not the controversy. The fact that you must consider in all of them, is the artistic feature of having the ribs going to the side.

Mr. Ooms: In conjunction with—

The Court: Not the flapping over, not the side walls, not the upper content, not the fact of whether it is the unit with the mechanism attached to it.

I see one there in dark brown or light brown (indicating) and some in white enamel. That doesn't affect the Court in the least. I don't care what color it is; it is the same in substance.

The function and performance are for the same purpose. I don't find very much in the prior art except enough to [fol. 310] find in there that ribs have been extended in at least one or two designs, into the sides, prior to the date of your patent.

Now, I haven't paid any attention to the reading of those patents. I don't know how much emphasis was placed on the reinforcement of it. Nothing has been read to me, so far, along that line, but that is what I am thinking about.

Mr. Kraus: There is only one point that I might make, your Honor, this observation:

The question of lengthening the ribs, if it was a new thing to begin with, your Honor, assuming it was, the big question for this Court to decide is, was that invention as defined by the Supreme Court and by the Court of Appeals and by the Courts around the country? It

must be invention to do that. That is the question for your Honor to decide.

The Court: That is exactly what I said.

Mr. Mullin: And the test of invention is the same in both mechanical and design patents.

The Court: That is what I said before.

Mr. Mullin: The test is exactly the same.

The Court: That is the impression I had. I can't find a line of demarcation where the inventability, the patentability begins and where it ends between the mechanical and the decorative.

Mr. Ooms: We will bear that in mind and brief it.

Your Honor, I have only one other objection. That is that 1950—I don't have the number but it is the drawing which uses the words "Day-Line". Of course, you cannot admit that as prior art.

The Court: I am not impressed by the word "Day-Line". I distinguish it from the name of a product, the one prior to it.

[fol. 311] Mr. Ooms: I can take care of that in one minute of rebuttal, too.

The Court: It's all right.

Mr. Kraus: Maybe we will withdraw that.

The Court: Does the defense rest?

Mr. Kraus: All right. The defense rests.

Thereupon the Defendant rested its case.

Mr. Ooms: May I have about a few minutes recess? I think I can pare this down to about ten or fifteen minutes.

(Thereupon a short recess was taken.)

Thereupon the Plaintiff, to further maintain the issues on its behalf, introduced the following evidence in rebuttal, to-wit:

Mr. Bradway: Your Honor, I would like to read two or three pages into the record.

The Court: It is all right.

Mr. Bradway: This is the Guth Deposition. We are reading this into the record to clarify the correlation between this Guth fixture that we have produced here and the several catalog sheets that your Honor has seen. Mr. Woodruff will read the answers. These questions are by Mr. Mullin.

DEPOSITION OF EDWIN F. GUTH, JR., READ INTO RECORD

(Thereupon the questions were read by Mr. Bradway and the answers were read by Mr. Woodruff as follows:)

Mr. Bradway: (Reading):

"Mr. Mullin: Mr. Guth, are you here pursuant to a subpoena duces tecum?"

[fol. 312] Mr. Mullin: Could you tell me where you are reading from?

Mr. Bradway: I am starting at page 3. I am skipping.

Mr. Mullin: You are not going to read it all, just parts of it?

Mr. Bradway: There are just two or three pages.

"A. Yes, sir.

"Q. Do you have that subpoena duces tecum with you. You have no objection to this being admitted into the record, this subpoena duces tecum?

"A. No.

"Q. All right. Will you state your full name?

"A. Edwin F. Guth, Jr.

"Q. And your address?

"A. Home or factory when you say address?

"Q. Your home address.

"A. 2106 South Warson Road, Ladue 17.

"Q. And that's in St. Louis, Missouri?

"A. City of Ladue.

"Q. City of Ladue?

"A. Yes, sir."

At that point we are skipping over to line 10 of page 13.

"Q. Now, I ask you again, have you ever seen fixtures other than those which are the subject matter of this patent which had such ribs in them?

"Mr. Ooms: This question is different from your prior one, you said similar before and now you say such. I just want to be sure.

"A. Well, very frankly, I have only seen it in my own filling station, it so happens, of a fixture that has ribs like that, transverse ribs."

[fol. 313] Your Honor, just to clear the record there, I believe that they have been discussing, talking about the patent. Will counsel for the Defendant agree with me?

Mr. Mullin: I would have to read it.

Mr. Bradway: Read the page.

Mr. Mullin: Just a minute if you want me to read it. I will read it and I will let you know.

The Court: All right.

Mr. Mullin: Yes, referring to the patent in suit?

Mr. Bradway: Yes, that is the only document that had been referred to at that time.

Mr. Mullin: Yes.

(Reading):

"And do you know whose fixture that is?

"A. No, can tell you right now. I really can't. I don't know.

"Q. You said before that you saw ribs like that in fixtures that were made by the Edwin F. Guth Company, is that correct?

"A. Well, that's why I asked you what transverse meant because—

"Q. Yes.

"A. —because ours did not carry all the way across.

"Q. I see. How far did they carry across?

"A. We just carried it around the corners.

"Q. Around the corners?

"A. Yes, sir.

"Q. And over the top?

"A. Partly into the top.

"Q. Partly into the top and partly—

"A. Into the sides."

And at that point we will skip over to Page 15, Line 17:

"Q. Did you in any way alter or change the design [fol. 314] during this period, 1944 to 1952?

"A. Yes.

"Q. How did you change the design?

"A. Well, we ended up, I know, eliminating the two center reinforcing members.

"Q. By reinforcing members what do you mean?

"A. These corners.

"Q. Now, you are referring to these—

"A. Around the radius.

"Q. These cross-ribs along the radius?

"A. Yes.

"Q. In the middle?

"A. The middle two.

"Q. But you retained the others?

"A. We retained the outers.

"Q. And do you recall the approximate time you made that change?

"A. It could have been—I don't know—approximately three months after we originally manufactured them.

"Q. And you referred to those cross-ribs as reinforcing members?

"A. Yes.

"Q. How did they reinforce?

"A. They stiffened the radius.

"Q. And was that the only purpose in incorporating them in your design?

"A. No, it also looked good from the sales angle. It had appearance to it of sturdiness, you know.

"Q. Could you have made them without any reinforcing ribs?

"A. Oh, yes.

"Q. How would it affect the fixtures structurally if you had taken out all the ribs?

[fol. 315] "A. It would have been slightly weaker, a little more spring to it."

From there we will skip over to Page 27, Your Honor. Those excerpts are just to show that they start out with four ribs and, two or three months after that they shifted to the two-rib construction, you see there (indicating).

Now, starting with the second complete paragraph on Page 27—

The Court: Was that, the last Exhibit for that brown one?

Mr. Bradway: Yes, your Honor. That is Plaintiff's Exhibit 6.

Mr. Mullin: What is that page number?

Mr. Bradway: 27, the second full paragraph.

(Reading):

"Mr. Mullin: We are asking the witness who is qualified as a designer of fixtures to tell us whether he has made and/or sold any fixtures which he considers similar in appearance, and he has a right to so testify if he knows.

"Mr. Ooms: Similar in appearance to what?

"Mr. Mullin: To the fixture shown in Design Patent 176,367."

And then we have an objection by Mr. Sutherland, who is the attorney for Mr. Guth.

(Reading):

"Mr. Sutherland: I am going to object and instruct the witness not to answer unless the question be limited to the period prior to the filing date of the application for the patent in suit.

"Mr. Mullin: I will so limit my question.

"A. Then the answer is no.

"Mr. Mullin: And do you know of any fixtures made or sold on the market by anyone other than Guth or Day-[fol. 316] Brite or Compco which had transverse ribs?

"A. No, I am not familiar with it." From there we skip over to Page 43, down to Line 10.

(Reading):

"Q. If you will, will you explain to me the difference in design between those fixtures shown on Defendant—Guth Deposition—Exhibit One A and One B, if any?

"A. Excuse me, how did you say that?"

Mr. Bradway: Just for correlating the record, your Honor—

Mr. Mullin: What page?

Mr. Ooms: Give him the page. He didn't get it.

Mr. Bradway: Page 43, Line 10.

Mr. Mullin: Page 43?

Mr. Bradway: Yes.

Your Honor, just for correlation in the record, these exhibits here are Guth Deposition Exhibits 1-A and 1-B of the defendant in that deposition and we would like to mark them as plaintiff's exhibits. I will have them marked 37-A and 37-B here.

Mr. Mullin: They have already been introduced.

Mr. Bradway: All I want the record to show is correlation between what we are talking about in this deposition and what—

Mr. Mullin: They have already been introduced by the defendant.

Mr. Bradway: If you will give me the numbers you have assigned to them, why, we will not introduce them.

Mr. Mullin: The number is F.

Mr. Kaufman: It is F.

Mr. Bradway: All right. Your Honor, Exhibits 1-A and 1-B that we are talking about in this deposition correspond precisely to Defendant's Exhibit F.

[fol. 317] The Court: All right.

(Reading):

"Mr. Sutherland: He wants to know if there is any difference between those two.

"A. No, there is no difference between these two.

"Mr. Ooms: They are the same?

"A. Yes.

"Q. I notice they bear a different trade-mark.

"A. Yes.

"Q. Is there any reason for that?

"A. That's because of the transformers.

"Q. Transformers, I see.

"A. Yes.

"Q. And I believe you stated you had in your possession yet physical specimens of the most recent design of these type of lighting fixtures which we have shown on these photostats?

"A. Of this model here (indicating).

"Q. And that's the model you point to showing on Defendant's—Guth Deposition—Exhibit 1A, is that correct?

"A. Yes.

"Q. Will we be able to purchase one of those from you or obtain it from you?

"A. There is none for sale, I mean, they are no longer being sold.

"Q. And you discontinued the sale of them about 1952 or '53?

"A. Yes.

"Q. Can we obtain one from you and if necessary we will be happy to reimburse you for one of those fixtures.

"Mr. Sutherland: That's up to you, you told me you had them hanging out there, didn't you?

"A. Yes, I have one hanging.

[fol. 318] "Mr. Ooms: If you send someone over would you turn it over to us so we can use it in this lawsuit?

"A. Sure, be glad to."

And, that is the fixture they obtained as a result of that.

Mr. Mullin: I would like to read in just a short paragraph on page 28 which was omitted by the Plaintiff.

(Thereupon the following was read by Mr. Mullin:)

"Mr. Mullin: Do you know of any fixtures manufactured and sold on the market prior to December 13th, 1955, which had cross ribs in then other than those of Guth and Compco?

"Mr. Ooms: I will have to raise an objection unless you define what you mean by cross ribs. We have been talking about cross ribs, transverse ribs—

"Mr. Mullin: Transverse ribs, I will correct the question to read transverse ribs.

"Mr. Ooms: The type shown in any place or are you asking the question broadly?

"Mr. Mullin: Transverse ribs, that's right.

"Mr. Ooms: If the witness understands I have no objection to this question.

"Mr. Mullin: Thank you.

"A. I am still not familiar with what the others have made so I haven't seen them and I don't know."

(The reading of the deposition was concluded.)

Mr. Ooms: I will call Mr. Stahlhut for several questions, your Honor.

The Court: Supplementing what I said to you before, I used the word "confusion" as to where the demarcation begins between esthetic and design patents, and mechanical patents.

The question that disturbs me most in my mind—legally, not factually—if a competitor has a right, mechanically, [fol. 319] to put on the market a certain fixture that carries with it a mechanical advantage, is he prohibited or restricted from marketing it because it has a design infringement?

Mr. Ooms: That is the point I think I am going to get into right now, your Honor. He has been sworn in.

The Clerk: You may be seated.

Leo George Stahlhut, having been previously duly sworn, called as a witness on behalf of the Plaintiff herein, in rebuttal, was examined and testified further as follows:

Direct examination.

By Mr. Ooms:

Q. Mr. Stahlhut, you were here this morning when the first Office action to the design patent in suit application was entered, were you not?

A. That is correct.

Q. And the Patent Office denied it because of a reference to Abernathy with certain statements?

A. That is correct.

Q. Now, in answering his Honor, will you read the Patentee—and you were one of the Patentees, were you not?

A. That is correct. I am the co-inventor.

Q. (Continuing)—Patentee's response beginning on the bottom of page 1?

Mr. Ooms: I think this may answer it.

The Court: The design patent?

Mr. Ooms: Yes, sir, your Honor, the design patent. It is the only patent.

By the Witness:

A. (Reading): "Thus Applicant's design is characterized by a few elongated low flanged slots separated by [fol. 320] transverse ribs on the under surface, Figure 1, and channels on the outer surface, Figure 2, all in a pleasing arrangement of balanced size, spacing and form which gives the article a new and ornamental appearance. The Examiner's opinion as to the mechanical purpose of the cross ribs, transverse ribs, may be correct if the issue were on the mechanical features of the article. It is obvious and well known that articles may have utility and ornamentality at the same time and a patent on each would be proper, provided the ornamental significance were independent of the utility. In design patent cases, of course, the question of utility is not involved.

"Gorham versus Sweit, 14 Wall, 511; In re Faustman, 33 CCPA 1065, 155 F (2) 388, 69 USPQ 541.

"The mere fact that the design sought to be patented may involve some mechanical or utilitarian function, however, will not render it unpatentable.

"In re Lon LeMontang, 55 F (2) 486, 12 USPQ 187."

The Court: Well, if that is the law, then, hasn't the Patent Commissioner defeated his very denial of granting a mechanical patent?

Mr. Ooms: He did not grant one.

The Court: I say, he defeated his purpose of denial when he granted on this one, insofar as the entire world is concerned. He granted you a patent exclusively—all right, call it for design purposes—but, his denial of the patent for the extension of the rigs, for the mechanical ribs, was denied, so, he obviated his own denial by his granting this patent on the other one.

Mr. Ooms: I think after this argument was presented, that's right.

The Court: I am not deciding it now.

Mr. Ooms: No, I know, your Honor.

The Court: I am merely trying to help both sides in telling you what I am thinking about so that in your final [fol. 321] briefs you can elaborate on it and clarify those things to me.

Mr. Ooms: Right.

The Court: But you know what I am talking about.

Mr. Ooms: I certainly do.

The Court: With his right hand the Commissioner says, "You can't have a mechanical patent." He says, "The world can use it as it wishes."

With his left hand he says, "I will stop them because it has a design value."

Mr. Ooms: That is right, your Honor. That is right.

The Court: That is awfully clashing.

Mr. Ooms: Well, we do have some of those peculiarities in law, as you know.

The Court: I am learning them as I go along.

Mr. Ooms: I might say here, rather than read, have the witness read further that after that—

The Court: The reference is in the record, the whole thing. It is in the record. You better refer to it in your briefs.

Mr. Ooms: That is right. I wasn't sure I was going to have that opportunity.

The Court: Oh, no. This is an important case. It is important because I am impressed by the volume of sales of the plaintiff, over twenty-five million dollars worth a year, which is no chicken feed. It is important business and I am not inclined to do it harm unless I know what I am doing.

Mr. Ooms: I appreciate that.

The Court: Unless I give you every opportunity to protect yourself.

Mr. Ooms: I appreciate that.

By Mr. Ooms:

Q. A drawing has been referred to, offered by the plaintiff as a "Day-Line" drawing. Do you know how long the [fol. 322] plaintiff has been using the word "Day-Line" on industrial fixtures?

The Court: I don't think that enters into it in any way at all.

Mr. Ooms: I just want to be sure it isn't prior art.

The Court: Let the record show it.

By the Witness:

A. Well, we originally started using the "Day-Line" trademark in 1941 to identify our industrial lighting fixtures.

By Mr. Ooms:

Q. And you used it on a numerous number of fixtures?

A. That is correct.

Q. When Exhibit 12 came out, did you call that a "Day-Line" fixture?

A. What is Exhibit 12?

The Court: The one with an upper rib and none lower.

The Witness: That is correct. That was known as our CFI "Day-Line" fixture.

By Mr. Ooms:

Q. And then, when the one covered by the patent in suit came out, you called it a what?

A. We called it a CFI-10 fixture.

Q. So you no longer called that fixture a "Day-Line" fixture, is that correct?

A. That is correct.

Mr. Ooms: I have no further questions.

Cross examination.

By Mr. Kraus:

Q. Your counsel just read you the argument that he presented before the Patent Office in connection with the design application, is that correct?

A. I read it here.

Q. And then the Patent Office allowed the design patent [fol. 323] in suit, is that correct?

A. That is correct.

Q. Now, the only reference that was cited by the Patent Office examiner was that Abernathy patent which was alluded to before, is that correct?

A. I believe—well, that is the only one that was shown in the first action.

Q. Was there any other action by the Patent Office?

A. It doesn't appear.

Mr. Kraus: Will you stipulate that there were no other actions?

Mr. Ooms: No question about it, Mr. Kraus.

By Mr. Kraus:

Q. Now, at that time, the Day-Brite Company was manufacturing its fixture, No. PX-12, is that correct?

A. That is correct.

Q. And for how long a period prior to that action had Day-Brite been manufacturing this fixture?

A. Well, that fixture was originally manufactured in 1952. I am assuming that it is beyond the one year that—

Q. In other words, insofar as that patent was concerned, this was prior art, is that correct?

A. Well—

Mr. Ooms: We stipulated that.

The Witness: The similarity of the design.

By Mr. Kraus:

Q. Now, in the Abernathy patent, are there any ribs shown in the fixture?

Mr. Ooms: Your Honor, I think we are getting past the direct on rebuttal.

Mr. Kraus: No. This is a very important point.

The Witness: I don't have the copy of the Abernathy. [fol. 324] Mr. Ooms: Counsel may be right on his importance, but—

The Court: Which point is he asking on now?

Mr. Ooms: I don't know. He is going into the Abernathy patent. We didn't go into that at all.

Mr. Kraus: If your Honor will indulge me for a few minutes, I think I will prove the point.

Mr. Ooms: But, I can't see how this is proper cross in rebuttal.

The Court: What is the question? Will you read it, please.

(Thereupon the pending question was read as above recorded.)

Mr. Ooms: We didn't even talk about Abernathy in rebuttal.

The Court: I don't think he is a patent expert. I don't think I want him qualified. I think the document is in evidence and it speaks for itself. The objection is sustained.

By Mr. Kraus:

Q. Did you call to the attention of the Patent Office Examiner the prior fixture that you had been making with ribs on it?

A. No. The over-all effect is completely different.

Q. I am asking you a specific question. Did you call to the Patent Office Examiner's attention the fact that you had been manufacturing, since 1952, a fixture with cross ribs?

A. We had no occasion to do so.

Q. Did you call to the attention of the Patent Office Examiner any of the other fixtures which showed ribs and which you are familiar with?

A. In our opinion, they had no bearing on the patent there. The over-all design was completely different from [fol. 325] what we were—from what we were applying for.

Mr. Ooms: I will ask him to explain, anyway, if you don't.

By Mr. Kraus:

Q. Now, in the argument that your counsel presented to the Patent Office, the discussion was limited specifically to ribs, was it not?

A. No.

Q. That that was the distinction?

A. Definitely not.

Q. Will you read it again, sir?

The Court: My impression is, as I have said before—and, if I am wrong, I want to be corrected—that up to

the time of the extension of the ribs into the side walls as being decorative and ornamental, a design which was esthetic, the patent would have been denied, artistically. It was allowed just because of that one phase of it.

Mr. Kraus: Yes.

Mr. Ooms: That is what we intend to show, that that is not a correct impression.

The Court: That is not a correct interpretation?

Mr. Ooms: No.

The Court: Well, what was it?

Mr. Ooms: If he may be permitted to answer the question.

The Court: Go ahead.

By the Witness:

A. (Continuing) We stated that:

"The Applicant's design as characterized by a few elongated low flanged slots, separated by transverse ribs on the undersurface, Figure 1 and channels on the outer surface, all in a pleasing arrangement".

The Court: Hasn't that been amended? Hasn't it beeen denied on that?

[fol. 326] The Witness: No, sir. That is what it was allowed on, your Honor.

Mr. Ooms: This is what was told to the Patent Office. The Patent Office said that is all that was involved, the ribs. For mechanical purposes, we pointed out what was more involved than just the ribs was an arrangement of slots in a configuration.

The Court: At what point was the Patent Application denied, when it was amended?

Mr. Ooms: It was amended and then allowed.

The Court: I understand it was amended and then allowed. At what point was the amendment put into effect?

Mr. Ooms: Right after the Patent Office made their objection. The application is filed, the Patent Office—

The Court: What were the objections of the Patent Office up to that point?

Mr. Ooms: The Abernathy Patent said that the ribs were purely mechanical.

The Court: That's right.

Mr. Ooms: And the answer came back.

The Court: That is what I am talking about and they said it was purely mechanical and they couldn't allow it.

Mr. Ooms: That is right.

The Court: And then you came back. Well, up to that point, as I understand the law on patents, when you filed the amendment, you admitted the accuracy of that statement.

Mr. Ooms: No, your Honor. We specifically controverted the accuracy of that statement. We stated that that isn't all that is involved, that much more was involved.

The Court: In your amendment?

Mr. Ooms: Oh, yes, your Honor. The Court might [fol. 327] read, beginning at the bottom of page 1 of the amendment.

The Court: Well, isn't it true that everything you said here on the bottom of page 1 is embraced in your prior art, Exhibit 12? How much of it isn't?

Mr. Ooms: Well, practically the whole thing, your Honor. You find here a rib, yes.

The Court: That is right. You also find—

Mr. Ooms: The slots, but, you don't find the proportion of ribs enveloping four places.

The Court: The only thing I see there is the extension of the ribs into the sides.

Mr. Ooms: No, no, your Honor.

The Court: You haven't anything else in there.

Mr. Ooms: The number, the arrangement, the form, the shape, the proportion. This is the esthetic quality that we have been talking about; not purely the functional thing of putting a couple of slots in.

The Court: Well, let us analyze it point by point, in argument, not evidence.

What is there about your Exhibit 4?

Mr. Ooms: Right here, your Honor.

The Court: The product in suit, right?

Mr. Ooms: Right.

The Court: Now, take it side by side with Exhibit 12. What is there in Exhibit 4 that isn't in Exhibit 12, except the extension? It has the sides, the openings, the number.

Mr. Ooms: No. The number is different. The proportion is different.

The Court: It has the ribs down below it. It isn't extended into the side.

Mr. Ooms: No. It has the two ribs. You see, it has the enveloping effect.

The Court: You have added another rib to it, admittedly, for the strengthening.

[fol. 328] Mr. Ooms: Two more ribs, not for strengthening purposes, your Honor.

You see, here, in the design patent where one goes into the esthetics. Now, if the Defendant came out with something like that, we wouldn't be here at all because it doesn't have the same over-all eye appeal that it has in its design.

It is the combination of these elongated slots in conjunction with these wrap around ribs that gives it that pleasing effect.

The Court: Well, mechanically, not artistically, but, mechanically, how much of it have you thrown open to the public in your prior art by Exhibit 12?

Mr. Ooms: This whole thing.

The Court: That's right. What does the whole thing consist of—the openings, the ribs, the sections, the side walls?

Mr. Ooms: Precisely. They could make this until Dooms Day and we wouldn't be in this court today, but, when they take our artistic arrangement of these slots and of these ribs which identifies it as a Day-Brite product, that is why we are here and that is what we have got the design patent on. It is the shape, form and the proportion.

The Court: All right.

Mr. Ooms: May I point out one other thing to your Honor? A design patent is not quite like a mechanical patent where you present claims and then you file an amendment and limit your claims further and further. It is all determined by this picture here because the claim in every design patent is, you claim what is shown in the drawing as your patent.

The Court: You mean that in design patents you can go beyond the amendment, you can go to the claim before the amendment, is that what you mean?

[fol. 329] Mr. Ooms: When you submit the application, you put at the bottom:

"The ornamental design for a reflector for tubular lamp lighting fixtures substantially as shown."

The Patent Office then comes back and says:

"Well, Abernathy has got uplights in it, slots in it and those ribs just look to be mechanical."

And then you come back and say:

"Well, no, you haven't fully appreciated what this is,"

as the Court read, and then the Patent Office says,

"After careful consideration"

that they believe it does show ornamental design.

The Court: Had you not had the ribs extended to the walls, what would have been the result of the Commissioner's—

Mr. Kraus: That is the point I am bringing out.

Mr. Ooms: I wish I could really second-guess the Commissioner.

Mr. Kraus: That is the point I was trying to bring out by this witness, that they knew they had ribs and they didn't disclose it to the Patent Office. Now, they make this significant remark—

The Court: Well, nobody stopped you on that.

Mr. Kraus: No, I didn't say your Honor stopped me.

The Court: Well, go ahead, if you want to bring that out.

By Mr. Kraus:

Q. Your counsel made the statement is his argument to the Patent Office—

The Witness: Is this the same—

By Mr. Kraus:

[fol. 330] Q. Yes.

"The instant design is characterized in one respect by the presence of ribs in the light reflecting surface. This is not the expected or usual provision to make."

Now, you will note that in the Abernathy patent, which was the only patent cited by the Patent Office, there were no ribs, is that correct?

A. No, there were no ribs. I can't see any—

Q. Now, Day-Brite was manufacturing a reflector with ribs at that time, is that not so? These transverse ribs?

A. We didn't consider them ribs. I believe you will find on the drawings they were beads. To us they had no appearance value, no—

Q. You don't consider these ribs, these cross members ribs?

A. As co-inventor or co-designer, these did not have a similar effect that the over-all design of the fixture, which we applied for.

Q. But, they are depressions in the metal, are they not, and they extend across the top of the reflecting surface, do they not?

A. Well, I normally go over these arguments with our patent attorney, Mr. Woodruff, and I probably had in mind when we claimed that this was not unusual, because, when we extended them into the side, one of the characteristics of the reflector, which ties in exactly with what Mr. Hammer said this morning,—that it would be unusual for a designer to run them into the side reflecting surface.

Q. At the time the Commissioner, at the time the Patent Office examiner considered your design application, you did not inform him that you were manufacturing this PX-12, is that correct?

The Court: He said "No."

[fol. 331] The witness: No, no. We didn't think it had a bearing on the case. They are two totally different designs.

By Mr. Kraus:

Q. Now, your mechanical application for patent was denied by the Patent Office, wasn't it?

Mr. Ooms: Your Honor—

Mr. Kraus: I just want to ask him one or two questions.

The Court: That has been gone into fully.

By Mr. Kraus:

Q. Now, is it not a fact that the drawing in the mechanical application covers the same fixture—

Mr. Ooms: If your Honor please—

By Mr. Kraus:

Q. (Continuing) —as was covered in the design application?

Mr. Ooms: This is going way beyond.
Mr. Kraus: Well, if he will admit, that's all I want.
Mr. Ooms: Well, it's in the record already.
The Court: It is already in evidence.
Mr. Kraus: That's all, your Honor.

(Witness excused.)

Mr. Ooms: Just one more short witness.
The Court: You have got some close questions here.
Mr. Ooms: It is an interesting question, your Honor.
The Court: If it is not interesting it is close. What is disturbing to me is that in the Commissioner's office, that there it was accomplished by the design patent but declined by the mechanical patent.
Mr. Ooms: No. They are two separate things, your Honor. We will brief that.
The Court: That is what I am thinking about.
Mr. Ooms: Right.
[fol. 332] The Court: From all the evidence in the case.
The Court: If they cannot manufacture or reproduce your design patent, they cannot manufacture and reproduce your mechanical patent.
Mr. Ooms: No. I think you will find—
The Court: You have a point there.
Mr. Ooms: —a good legal argument there.

LAWRENCE BLAZEY, called as a witness on behalf of the Plaintiff in rebuttal, having been previously duly sworn, was examined and testified further as follows:

Direct examination.

By Mr. Ooms:

Q. You are the same Mr. Blazey who testified yesterday?
A. Yes, sir.
Q. Or, was it the day before? We have been here so long. Now, we have had marked as Plaintiff's Exhibit 31—

The Court: He is about the meekest little witness I have had on the witness stand.
The Witness: I am?
The Court: Yes, the meekest.
The Witness: Oh, is that right?

By Mr. Ooms:

Q. That is the rendition by you of the Guth Reflector, is it not?
A. That is right.
Q. Now, have you checked to see whether the proportion of those ribs that are shown there are accurate from, A, the drawing which has been put into evidence by the defendant here, the print of the so-called Mazelite and the other name that they call it by; B, the reflector here in suit, and, C, Page 31 and 32 of the Guth catalog?
[fol. 333] A. That is right.
Q. That is an accurate presentation of what those ribs look like on the Guth reflector?
A. So far as can be drawn in a perspective view, yes.
Q. Now, you have, have you not, seen all of the prior art exhibits here?
A. Yes.
Q. Including Exhibit 12, the Guth fixture, the Westinghouse fixture, and so forth?
A. Yes, sir.

Q. Can you tell the Court, can you aid the Court in telling him what the differences are from a design or styling point of view, with the structure of the patent in suit?

A. In the instances related, it shows a difference of number, proportion and rhythm and identity in the fixture itself, in other words, the obvious similarity of the two cannot be misconstrued because of the differentiation of the design elements that we call—the design elements including ribs, upslots and curvatures and details.

Q. Now, you used the words "rhythm" and "proportion."

What do you mean by that, precisely? If you will refer to Plaintiff's Exhibit—

The Court: Haven't you gone far enough on the question of infringement?

Mr. Ooms: This is not for infringement. This is for validity.

The Court: For what?

Mr. Ooms: For the purposes of validity, showing inobviousness of the particular design in suit over these [fol. 334] prior art structures that they have claimed; not for infringement.

By Mr. Ooms:

Q. Will you describe to the Court what you mean by the difference in form, proportion and rhythm over, let us say, Plaintiff's Exhibit 12?

A. The difference, as exemplified from a designer's view would be such that he would look at the picture as the fixture would be installed in operation and, therefore, attempt to make some individuality between the portions that are visible from the floor and give them some characteristic, identity, as well as proportion in relation to a whole strip down the plant's ceiling and, therefore, come to the conclusion that although not perfect aesthetics is involved, there would be an advantage in elaborating on the mechanical requirements inherent in the tooling and exaggerate them to the point where they become a decorative motive beyond the function of its purpose.

Q. Now, tell me this: If I were to look at the top of this reflector and without paying any attention to these elongated ribs on the side, would you still say, aesthetically, the reflector of the patent in suit is different, say, from Plaintiff's Exhibit 12?

A. It is definitely.

Q. And what about the Guth fixture, Plaintiff's Exhibit 6?

A. It is different, also.

Q. Would you say obviously different?

A. Obviously different.

Q. Do you agree with their expert that the aesthetic quality of moving the ribs into the side is unobvious to a designer?

A. I do.

[fol. 335] Mr. Ooms: I have no further questions.

The Court: Was it you who told me, was it you or wasn't you who said somewhere in the testimony that the extending of the ribs into the sides has some strengthening value?

The Witness: I didn't say that.

The Court: Was it you?

The Witness: No, sir. I said it was done for the purpose of designing only.

The Court: Has it any strengthening value?

The Witness: It is obvious it strengthens the sides a little bit but it is not a requirement of the—

The Court: It is obvious that it strengthens it a little bit. And then, we went over to the question of how far it goes over on the side line.

The Witness: Yes.

The Court: (Continuing) To determine the amount of the additional strength.

The Witness: Yes.

Mr. Ooms: Did your Honor ask him if it was necessary at all?

The Witness: It wasn't necessary to put it down here for strength because no strength was needed this way. It was merely redundant, a redundant point.

Cross examination.

By Mr. Kraus:

Q. Now, yesterday you testified the rib across the top, up to this point of the red line in the curve was functional?

A. Right.

Q. Was it functional up to the second red line?

A. Well, that is my mark.

Q. Was it functional?

A. That is right, in order to deviate into the plain surface.

[fol. 336] Q. With that being functional, would it be obvious to any man in the art to extend the same rib another two inches?

A. It would be obvious if he was determined to make an identity for the purposes of identifying the fixture. That would be one direction of point.

Q. The point I am asking is, assuming this to be functional, from there across to the points of the red line—

A. Yes, sir.

Q. —would it be obvious to any man trained in the art, to extend the same rib another two inches?

A. Now you are talking about obvious to a designer?

Q. To a designer schooled in the art, who works with this thing all the time. That is to which the patents are directed.

A. It would not be obvious. It would be selective. Let us put it that way.

Q. Could he do it?

A. He could do it.

Q. Would it require much thinking to do it?

A. It isn't the purpose, of the one rib. It is the purpose to coordinate all of the ribs.

Q. I am asking you, this being functional, as you admitted, would it be obvious to any man in the business to extend the same rib another inch and a half or two?

A. I would say, truthfully, it might be, yes.

The Court: Let me ask you one question if I may on this very same thing.

Referring to your red line, one of them was inched up about an inch, under your guidance, is that right?

The Witness: Yes.

The Court: Now, mechanically, if you can answer it, [fol. 337] mechanically, could that rib be abrupted sharply at the second red line?

The Witness: No, sir.

The Court: Therefore, you couldn't have put the rib in there without carrying it to some point?

The Witness: It is purely an indeterminate point. It has to taper to blend in with the curvature.

The Court: It has to taper. You couldn't abrupt it?

The Witness: You couldn't abrupt it without distorting the metal and—

The Court: Therefore you couldn't, mechanically, create a rib with a limited length within the red lines?

The Witness: I would say it is not an impossibility. It can be done but, specifications, costs, tooling, equipment determine the point of stoppage and, naturally, the least amount of cost is involved in the design in all cases.

Mr. Kraus: That's all.

Redirect examination.

By Mr. Ooms:

Mr. Ooms: I just have one or two questions.

By Mr. Ooms:

Q. When you say it might be obvious, am I asking an obvious question when it is always obvious after it is done? But, you agree with Mr. Hammer, that it is unobvious to do it aesthetically, is that correct?

A. There are more opportunities to do other things.

Q. Now, directing my question to what his Honor just asked you, would you say that this is the type of tapering off that you are talking about, this little bead here?

A. That is right.

The Court: How far does that go beyond the turn?

Mr. Ooms: Just barely, your Honor.

[fol. 338] The Court: About an inch.

Mr. Ooms: Not past the radius—about a half an inch.

The Court: Beyond the turn.

Mr. Ooms: It goes slightly beyond the turn.

The Court: My question was could it be abrupted sharply without any tapering off?

The Witness: It can be, with changes in the specifications of the metal and the requirements of the tools, I would say, which would determine how far you want to go.

By Mr. Ooms:

Q. Now, let me ask you one thing: Do you think this would have any esthetic value here at all, a rib just as in Guth here?

A. I would not consider it as such. It is a point— It is a point of half way—is the half way point. You either go all the way or you don't put any in.

Q. You either put it in there to make it obvious or you don't?

A. Certainly if you eliminate it in the center of the fixture and only put it on the side, it is not symmetrical.

Mr. Ooms: Thank you. No further questions.

The plaintiff rests.

Thereupon the Plaintiff rested its case.

The Court: Both sides rest?

Mr. Kraus: Both sides rest.

Thereupon the Defendant rested its case.

COLLOQUY BETWEEN COURT AND COUNSEL

The Court: I have enjoyed listening to you fellows. I always learn something. I have got a lot to learn here. I try to think out loud as I run along so you folks won't be in the dark as to how my mind is functioning and what I expect you to answer.

[fol. 339] I think I was clear in my expressions.

Mr. Ooms: Extremely so.

The Court: There is no question in my mind that there was an infringement of a violent nature.

Mr. Mullin: Well, we are going to argue that, your Honor.

The Court: It was just taken and copied and all the king's horses and all the king's men cannot put Humpty-Dumpty together again.

To the naked eye, it is a similar product and I don't know what difference it makes whether it is bought by the contractor, by the jobber and not purchased by the consumer.

I presume that from the standpoint of beauty in nature, it's for the attractiveness and the appeal to the common man who goes into the factory and he sees an attractive fixture and an unattractive fixture and I suppose the contractor and the jobber aims to satisfy the account in that respect, also.

I don't know whether it is unnecessary to be able to or whether it is required to make attractive to the lay eye or to the expert, which I am not concerned with here, but, I am concerned with here, as I said to you before, about the law, as I have pointed out.

I know you must have some law on the subject. I have just taken a glance at your briefs. You are touching, also, upon the question of unfair competition.

Mr. Kraus: We have no proof here.

The Court: I haven't gone into that phase of it. I haven't heard any arguments on it. I don't know how much unfair competition has been proven or disproven—hardly any because I do know that there are numerous other companies on the market making it, some in suit, [fol. 340] some not in suit, some who have been sued and some who have discontinued it.

My judgment would be and you have to point out to me, that if they have a right to manufacture them because mechanically it isn't restricted and because the Commissioner cannot prohibit it mechanically by his directing a patent on the aesthetic art.

The question here is, prior art—prior art not mechanically because that patent is out, but, prior art on ribs extending into sides, prior art mechanically, again. The patent he is talking about is a mechanical patent, is that right?

Mr. Ooms: The Abernathy.

The Court: I have no patents on prior art before me on design patents.

Mr. Kraus: We can use prior art patents and mechanical patents to defeat a design patent. That is well established.

The Court: I would presume that would follow.

Mr. Kraus: Yes.

Mr. Ooms: Yes. There is no question about that. Your Honor, I will concede that readily.

The Court: You contradict it?

Mr. Ooms: No, sir. I concede that readily that they can use a mechanical patent as well as a design patent to defeat.

The Court: Of prior art.

Mr. Ooms: Surely.

The Court: I can see that clearly. What is it that the Commissioner accomplished by denying him the mechanical patent?

Mr. Ooms: We will try to point that out. Now, your Honor, as to briefing, I am going to make an unusual request. We usually go 30 days and so forth, but, I would [fol. 341] like longer because I am leaving the country on the 18th and will not be back.

The Court: To take depositions?

Mr. Ooms: Yes, sir. It is a business trip. It is an international club, your Honor.

Mr. Kraus: Does your Honor want to set a date for briefs?

The Court: How much time do you want?

Mr. Ooms: I would like at least 45 days.

The Court: Forty-five days, 25 days and 15 days to reply to theirs, and I will render my report and submit, include in those briefs your proposed findings of fact and conclusions of law.

Mr. Ooms: Yes, your Honor.

The Court: And I will follow it and I will draw my decree and send you a copy.

Mr. Ooms: Thank you for your close attention, your Honor.

Mr. Mullin: Thank you very much, your Honor.

Mr. Kraus: The most recent decision of the Court of Appeals on design patents, reviews the patent situation on designs for the last 25, 30 years. I have a full copy of that so I can hand it to the Clerk to give to your Honor.

Mr. Ooms: Is it completely underlined, too?

The Court: Do you want to take it home with you until I render my decision?

(Thereupon an informal discussion was had, which was reported but not here transcribed.)

(Which were all the proceedings had and evidence taken in the above-entitled matter on the days above described.)

[fol. 342] Reporter's Certificate to foregoing transcript (omitted in printing).

[fol. 343] CLERK'S NOTE

Plaintiff's Exhibit 1—Patent No. Des. 176,367 is omitted from the record here as it appears at page 9.

[fol. 344]

IN THE UNITED STATES DISTRICT COURT

Civil Action No. 58 C 1300

FINDINGS OF FACT AND CONCLUSIONS OF LAW—
February 6, 1962

This matter having been fully tried before the Court, and the Court having read the pleadings filed herein by the respective parties, and the Court having heard and examined all the testimony, documents and exhibits presented by the respective parties and admitted into evidence, and the Court having read, heard and considered the briefs, memoranda and oral arguments submitted by counsel in support of their respective positions, and the Court being fully advised, the Court hereby enters its Findings of Fact and Conclusions of Law as follows:

Findings of Fact

1. Plaintiff, Day-Brite Lighting, Inc., is a corporation organized and existing under the laws of the State of Missouri, with its principal office at 5411 Bulwer Avenue, in the City of St. Louis.

2. Defendant, Compco Corporation, is a corporation organized and existing under the laws of the State of Illinois, with its principal office at 1800 North Spaulding Avenue, in the City of Chicago.

3. Jurisdiction over the patent infringement claims of this suit is founded upon the patent laws of the United States, and over the common law claim is founded on diversity of citizenship.

4. The design patent in issue is United States Patent no. Des. 176,367, issued on December 13, 1955 for a period of fourteen years to Carl X. Meyer and Leo G. Stahlhut on an application filed on January 17, 1955. Said patent is entitled "Reflector For Tubular Lamp Lighting Fixture" [fol. 345] and is owned by plaintiff DayBrite, Inc.

5. Simultaneously with the filing of the design patent in suit on January 17, 1955, an application for a mechanical

patent on the identical reflector was filed in the United States Patent Office by plaintiff's assignors. This application was identified as serial no. 482,212, was identically titled, and Figs. 1, 2 and 3 of the design patent drawings are identical with Figs. 4, 5 and 6 of the mechanical patent application drawings.

6. On November 13, 1956, the Patent Office examiner finally rejected the claims of the aforementioned mechanical patent application, serial no. 482,212; and on February 26, 1959, the United States Patent Office Board of Appeals affirmed the rejection by the examiner.

7. The DayBrite CFI DayLine reflector, comprising an arcuate reflector with uplight slots and ribs across the top (Def. Exh. 4), the Guth Mazelite reflector with ribs extending down into the sides of the reflector (Plf. Exh. 6), the Guth catalog nos. 44, 44a and sheet no. 889-151 showing the Guth Mazelite and Quick-liter reflectors (Def. Exhs. E, F and G), and the Westinghouse catalog section 61-230, pages 11-14, dated September 1, 1953, and showing Westinghouse fixture type 2 SDP-58 reflector with uplight slots and cross ribs extending across the top of the reflector between adjacent uplight slots (Def. Exh. L), comprise prior art which plaintiff did not disclose to the Patent Office until after the design patent in suit had been issued.

8. The only prior art before the Patent Office during the prosecution of the design patent in suit was U. S. Patent Abernathy no. 2,332,770, issued on October 26, 1943, for a lighting fixture having a reflector with similar general figuration to that of the patent in suit, and also having uplight slots with flanges encircling the same.

[fol. 346] 9. Plaintiff commenced manufacturing, advertising and selling lighting fixtures having reflectors of the same appearance shown in Des. patent no. 176,367 on or about October 1954. Plaintiff sells its reflectors for lighting fixtures embodying the appearance of Design patent no. 176,367 under the name CFI-10.

10. Defendant, Compco Corporation, did not itself design or introduce the allegedly infringing Mitchell Dyna-

lite fixture reflector, but acquired the tools, drawings and rights to manufacture and sell the same by the purchase of the Mitchell Lighting Division of the Cory Manufacturing Company on or about March 9, 1956.

11. After acquiring the assets and good will of Mitchell Lighting Division of Cory Manufacturing Company, defendant manufactured, advertised and sold reflectors for industrial lighting fixtures under the names of "Mitchell" and "Dynalite", and is still manufacturing, advertising and selling such reflectors under such names.

12. Written notices of infringement were sent to defendant's predecessor Cory Manufacturing Company on or about December 31, 1955, and to defendant Compco Corporation on or about March 30, 1956. Defendant denied infringement and the validity of plaintiff's patent in a letter dated April 9, 1956, and there was no further communication or action by plaintiff concerning the alleged infringement for approximately two and one-half years until the filing of this action.

13. The design of the various elements of plaintiff's reflector is functional, and it is only in the number, size and specific placement of those elements that there are non-functional features.

14. The prior art disclosed reflectors of arcuate cross-section with uplight slots encircled by upstanding flanges, [fol. 347] and cross ribs, some extending down into the sides of the reflector. Every element of the reflector design in suit is disclosed in the prior art.

15. The function of the cross ribs in the reflector is to strengthen and stiffen the reflector against warp and twist, to fix the spacing of the side surfaces in fixed relationship to minimize distortion and warpage due to the heat of the porcelain enameling process and thereby prevent the chipping of the porcelain enamel finish after cooling.

16. The design of the cross ribs, particularly the size, shape and length, is dictated by the limitations of the manufacturing process.

This Finding is particularly material to this appeal since the shape of the cross ribs was represented as the distinctive feature of the design patent (Deft's. Ex. P, Pl's. Ex. Vol. 84).

Plaintiff recognized the functionality of the design by filing a mechanical application on the same day the application for the design patent in suit was filed (Deft's. Ex. Q—also omitted by plaintiff in its reproduction of the record in this case).

In an effort to obtain favorable action on the mechanical application, the plaintiff's President presented an affidavit averring that the increased sales of fixtures resulted from the correction of the faults of the plaintiff's prior art unit:

> "(In the Day-Line, there was) an excessive rate of factory rejects attributable to warpage of the reflector unit during burning of the coating and chipping of this coating in the packages. . . . (When the ribs were extended, there was increased sales) which to Day-Brite indicated correction of the faults found in the 'Day-Line' units and customer acceptance of the CFL." (Deft's. App. 16)

Notwithstanding an extensive prosecution of the mechanical application, it was abandoned after the Examiner's final rejection was affirmed by the Board of Appeals of the Patent Office.

17. Neither the addition of reinforcing ribs nor the extension of ribs disclosed in the prior art is invention, although the resultant overall appearance of the design of plaintiff's patent no. Des. 176,367 is distinctive from any one piece of prior art offered by defendant in this action.

18. The design disclosed by the claim of plaintiff's patent no. Dec. 176,367, is neither so novel, original, distinctive, artistic or unobvious as to rise to the character of invention.

19. The overall appearance of defendant's Mitchell "Dynalite" fixture reflectors is the same, to the eye of the ordinary observer, as the overall appearance of plaintiff's

CFI-10 reflectors which embody the design of the patent in suit.

20. Purchasers of lighting fixture reflectors of the type here involved are likely to be confused between the Mitchell "Dynalite" reflector and the CFI-10 reflector.

21. Actual confusion has occurred. One user of fixtures of the type here involved, having an installation of plaintiff's CFI-10 fixtures and an installation of the defendant's Mitchell "Dynalite" fixtures, requested plaintiff to service some defective Mitchell "Dynalite" fixtures because they thought all of their fixtures were plaintiff's fixtures.

[fol. 348] 22. Within several years after plaintiff came on the market with its CFI-10 reflectors, a large number of competitors were offering fixtures with reflectors having the overall appearance of plaintiff's CFI-10 reflector design.

23. In the two years following introduction of plaintiff's CFI-10 fixtures to the trade, plaintiff's sales of these fixtures increased much more rapidly than plaintiff's sales of other fixtures. The design of plaintiff's CFI-10 fixtures, the reflector of which is constructed in accordance with patent no. Des. 176,367, has enjoyed marked commercial success, but plaintiff has introduced no evidence showing that its commercial success was the result of the design in suit rather than of its functional improvements or plaintiff's advertising and marketing efforts.

24. The appearance of plaintiff's CFI-10 reflector design has the capacity to identify plaintiff in the trade and does in fact so identify plaintiff to the trade.

25. The concurrent sale of plaintiff's CFI-10 fixture reflectors and defendant's Mitchell "Dynalite" fixture reflectors is likely to cause confusion in the trade.

Conclusions of Law

1. This Court has jurisdiction of the subject matter of, and parties to, this suit.

2. Plaintiff's patent Des. 176,367 is invalid.

3. The standard of invention in design patents is equally as high as in mechanical patents. A valid design patent must disclose creative originality and artistry which rises to the character of invention.

4. Plaintiff's patent is invalid because any change or improvement of the design over the prior art does not comprise invention, and it is merely the result of the exercise of the skill of the ordinary skilled designer.

[fol. 349] 5. The presumption of validity arising from the grant of the patent does not exist as against prior art not cited before the Patent Office.

6. Were the plaintiff's patent no. Des. 176,367 valid, defendant's accused reflectors are so constructed that they would constitute infringements of the claim of the said patent.

7. Defendant is guilty of unfair competition in the sale of the Mitchell "Dynalite" fixtures in suit.

8. Defendant is entitled to a decree dismissing the complaint on its merits insofar as the charge of patent infringement is concerned.

9. Plaintiff is entitled to an injunction enjoining defendant from unfairly competing with plaintiff by the sale or attempted sale of reflectors identical to or confusingly similar to plaintiff's CFI-10 reflector and defendant's Mitchell "Dynalite" reflector.

10. Plaintiff is entitled to an accounting for damages resulting from defendant's unfair competition.

Julius H. Miner, Judge.

Dated: February 6, 1962.

IN THE UNITED STATES DISTRICT COURT

Civil Action No. 58 C 1300

JUDGMENT ORDER—February 6, 1962

This matter coming on for entry of judgment in the above-entitled case, and the Court having entered its Findings of Fact and Conclusions of Law herein, and the Court being fully advised,

It Is Hereby Ordered, Adjudged and Decreed, as follows:

[fol. 350] 1. Plaintiff's patent no. Des. 176,367 is invalid.

2. Defendant is guilty of unfair competition in the sale of the Mitchell "Dynalite" fixtures in suit.

3. The complaint is dismissed on its merits insofar as the charge of patent infringement is concerned.

4. Defendant, its agents, representatives and employees, are hereby permanently enjoined from unfairly competing with plaintiff by the sale or attempted sale of reflectors identical to, or confusingly similar to plaintiff's CFI-10 reflector, and to defendant's Mitchell "Dynalite" reflector in suit.

5. Defendant shall account to plaintiff in open court for damages resulting from defendant's unfair competition.

6. Proceedings for the accounting hereinabove ordered shall be continued generally pending the disposition of such further or other proceedings as the parties may initiate in this cause.

Enter:

Julius H. Miner.

Dated: February 6, 1962.

IN THE UNITED STATES DISTRICT COURT

Civil Action No. 58 C 1300

ORDER—February 9, 1962

It Is Hereby Ordered that paragraph 13 of the Findings of Fact heretofore entered by the Court on February 6, 1962, be amended so that the second from the last word in the said Finding reads "non-functional."

It Is Further Ordered that Finding 13 of the said Findings of Fact entered in this proceeding shall be so amended on its face as of this date.

[fol. 351] It Is Further Ordered that the Judgment entered by this Court on February 6, 1962, be and the same is hereby entered as the Judgment of this Court on this date.

Enter:

J. H. Miner, Judge.

Dated: February 9, 1962.

IN THE UNITED STATES DISTRICT COURT

Civil Action No. 58 C 1300

NOTICE OF APPEAL OF COMPCO CORPORATION—
Filed March 1, 1962

Notice is hereby given that Compco Corporation appeals to the United States Court of Appeals for the Seventh Circuit from so much of the judgment entered on February 6, 1962 as holds defendant guilty of unfair competition permanently enjoins defendant, and that defendant shall account to plaintiff for damages.

Compco Corporation, By Dawson, Tilton, Fallon, Lungmus & Alexander, By: Jerome F. Fallon, 209 South LaSalle Street, Chicago 4, Illinois, Its Attorneys.

Serve:

Owen J. Ooms, Esq., 1 North LaSalle Street, Chicago, Illinois (2), Attorney for Plaintiff.

[fol. 352] Certificate of Mailing (omitted in printing).

IN THE UNITED STATES DISTRICT COURT

Civil Action No. 58 C 1300

NOTICE OF APPEAL OF DAY-BRITE LIGHTING, INC.—
Filed March 7, 1962

Notice is hereby given that Day-Brite Lighting, Inc. appeals to the United States Court of Appeals for the Seventh Circuit from so much of the judgment entered on February 6, 1962, as holds that plaintiff's patent No. [fol. 353] Des. 176,367 is invalid and as dismisses the complaint on its merits insofar as the charge of patent infringement is concerned.

Day-Brite Lighting, Inc., By Ooms, Welsh and Bradway, By Donald L. Welsh, Its Attorney, One North LaSalle Street, Chicago 2, Illinois.

Serve:

Jerome F. Fallon, Esq., Dawson, Tilton, Fallon, Lungmus & Alexander, 209 South LaSalle Street, Chicago 4, Illinois.

Certificate of Mailing (omitted in printing).

[fol. 355] Clerk's Certificate to foregoing transcript (omitted in printing).

[fol. 356] [File endorsement omitted]

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

Appeal Nos. 13,699 and 13,700

DAY-BRITE LIGHTING CO., Plaintiff-Appellant,

vs.

COMPCO CORPORATION, Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

HONORABLE JULIUS MINER, Judge Presiding.

Defendant's Appendix—Filed August 8, 1962

Industrial QUICK-LITER . . . Cold-Cathode Lighting

"QUICK-LITER" is Trade Marked by the Guth Company, St. Louis

FEATURES ARE:

1. Quick, Positive Starting
2. No Starter Switches
3. Starts at 0° Temp.
4. Starts at Lower Voltages
5. Low Power Losses
6. Min. Stroboscopic
7. High Lumen Output
8. Min. Radio Interference
9. Quiet Operation
10. High-Power-Factor

QUICK-LITER is Powered by New "SUPER BALLAST"

QUICK-LITER'S ADVANTAGES

NO STARTER SWITCHES: Nearly complete elimination from users of accompanied maintenance expenses now directly attributed to Starter Switch trouble. QUICK-LITER does away with the Starter troubles and Starter replacement costs—as QUICK-LITER does not use Starter Switches.

LOW VOLTAGES: Today, many plants operate with heavy electrical loads causing low and irregular Voltages. QUICK-LITER starts and operates at as low as 85-Volts, assuring constant illumination in these plants.

LOW TEMPERATURES: Where heavy coats, due to Cold Temperature, or where cold "drafts" blow cool breezes, use QUICK-LITER which will start at 0° F.

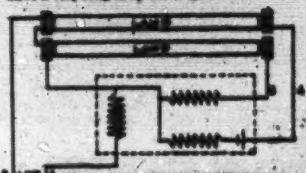
QUICK-STARTING: Lamps turn on instantly. Theoretically each time a lamp is turned on, one hundredth hour of Lamp Life is consumed. The heavy times any Fluorescent lamp is turned on, the longer the lamp life and the more light output.

USED LAMPS: QUICK-LITER will operate burned-out, Fluorescent lamps that have undamaged electrodes. Try a burned-out lamp in QUICK-LITER.

GOOD LAMP OFF: When one lamp burns out in a QUICK-LITER, the other lamp will continue to operate although the burned-out lamp is removed, the other lamp goes out; still maintaining the Super-Ballast.

LAMP LIFE: The lamp companies now sell a 40-watt lamp for use in the QUICK-LITER. Instead is same as for the standard F lamp. Lamp companies guarantee the new lamp in QUICK-LITER for 2000 hours burning for average performance" as guaran of hamps less than guaranteed).

QUICK-LITER owes extra long life for the standard F lamp in QUICK-LITER, as in Conventional Fixtures. The new lamp will no doubt have a very long lamp life in QUICK-LITER.



SCHEMATIC WIRING DIAGRAM: Chart to left illustrates the simple wiring hookup of QUICK-LITER'S Super-Ballast. Starter Switches are entirely omitted. Spaded lampholders with automatic shunt are furnished.

ELECTRICAL CHARACTERISTICS

Following is test data long experienced on the 2-40 watt QUICK-LITER Ballast. The test was conducted by Dr. Fred L. Hunter, of the Guth Laboratories, Engineering Dept., Guth Tower of Architects Building, St. Louis, Mo. The original copy of this test is in the files of the QUICK-LITER Ballast Manufacturer.

Current, Voltage and Power Tests were made using a sine wave, 60-Cycle Voltage. The results are summarized by the following table. Current and Voltage values are R.M.S. and Power values are average.

LINE	LAG TYPE			LEAD TYPE		
Volts	Amps.	Watts	Pr. Fac.	Volts	Amps.	Watts	Pr. Fac.
110	0.91	99.1	99.7%	113.0	.520	58.8	99.2%	110.2	.906	98.1	98.2%
115	1.06	81.6	99.1%	113.0	.555	58.7	93.9%	115*	....	....	....
110	1.11	83.8	99.1%	115*	....	....	....	110.5	.891	98.3	99.8%

*Tube removed, i. e., this is open circuit voltage with tube not in socket.

QUICK-LITER is a new super-powered lighting unit that efficiently operates standard 40-watt Fluorescent lamps. Quick, positive, mechanical starting without the use of Starter Switches, insures economical maintenance. Further, QUICK-LITER starts and operates at lower voltages (as low as 85-Volts), and at as low as 0° F. temperature.

With PORCELAIN CHASSIS Ballaster

Cat. No.	Lamp Wtg.	Line Volts	Shg. Wt.	List Price	Code
M2000	2-40W	110-125	32#	$81.50	PIOPY
M2001	2-40W	220-250	33#	$2.50	PIORZ
M2002	4-40W	110-125	48#	$3.50	PIPAY
M2003	4-40W	220-250	50#	$3.50	PIPEZ

With "GOP" WHITE" CHASSIS Ballaster

M2006	2-40W	110-125	29#	$80.50	PIPIB
M2008	2-40W	220-250	30#	$0.50	PIPOC
M2007	4-40W	110-125	46#	$1.50	PIPUD
M2008	4-40W	220-250	47#	$4.50	PIRAZ

LISTED BY [illegible] LABORATORIES, INC.

FIXTURE DESCRIPTION: Reinforced sturdy construction of heavy-gauge steel. All exterior surfaces finished "Permanent Gray." Reflecting surfaces are white enamel, while Porcelain Enamel (70% R. F. or higher), or "GOP" WHITE" synthetic enamel (80% R. F. or higher), as ordered.

MOUNTINGS: Five K.O.s for ½" Conduit (3 on 90°, and 2 on 30° centers) in top of housing. Also K.O.s on 30° centers permit direct attachment to Wyo-Chain-Hangers. Can be installed as individual units, or linked-together and run continuously, end-to-end.

HOW WIRED: Are High-Power-Factor (90% avg. min.) for 60 Cycle, A. C. Also available for 110-125 Volt, 25 Cycle, A.C.; if desired, quickly on order and add $1.00 to 2-40 watt, 110 volt units, and $10.00 to 4-40 watt, 110 volt units.

GUARANTEED: QUICK-LITER ballasts are guaranteed for one-full-year against defective workmanship or materials. Defective ballasts will be replaced by the ballast manufacturer (through the Guth Company) within one-year from the date of shipment from the Guth factory, providing they have been properly installed on correct line-voltage and under normal conditions. Replacements are made f. o. b. St. Louis.

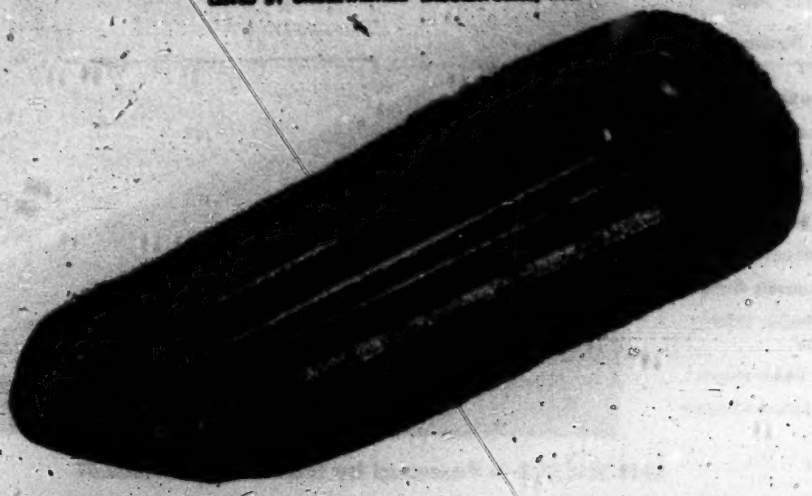
DIMENSIONS: 2-40 Watt QUICK-LITERS are 48¾" long by 13¾" wide by 7" high; 4-40 watt units are 48¾" long by 16¼" wide by 9" high.

See Page 28 for Mounting Accessory-Parts

MAZE-LITE... For Unit and End-to-End Mountings

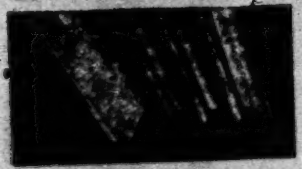
TRADE MARK REGISTERED

LISTED BY UNDERWRITERS' LABORATORIES, INC.

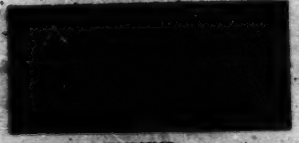


With PORCELAIN ENAMEL or "300° WHITE" Reflectors

LAMP-MISER SOCKET
MAZE-LITES provide exposed sockets for lamp-adjustment, usually 1/2" from the bottom of the 1-40 and 1-60 watt lights, and 1/4" for the 2-100 watt MAZE-LITES.



HEAT-PROOF ENDS
Allow ideal protection to Lamp-holders during transportation, installation and at servicing. Also serve to "guide" reflectors to proper position. Assure upright Lamp-holder positioning at all times.



MOUNTING BRACKETS
MAZE-LITES can be mounted by direct attachment to Ceiling, Beams, or to Conduit. They can be installed as individual fixtures, or linked together in Continuous-Arrangements to provide high foot-candle lighting levels.

MAZE-LITES, now available with Steel Reflectors, are listed in 2-40, 3-40 and 2-100 watt sizes. Two reflector-finishes are available—either 3-coat PORCELAIN ENAMEL or "300° WHITE" synthetic enamel (see Page 5 for description-of-finishes). Strong, rigid construction and modern styling keynote MAZE-LITES; their other advantages include: 1. "Bump-Proof" Endplates; 2. "Side-of-Channel" starters; and 3. "Easy-On-Off" reflector-attachment.

EASY INSTALLATION: MAZE-LITES can be mounted Singly, or in Continuous-Runs; in the latter case, knockouts in Channel-Ends permit locking-together of two or even three units on the bench, then are mounted in 8' or 12' lengths—reflectors engaged after channels are in final position. Four knockouts in top of channel (2 on 23" and 2 on 38" centers) permit attachment with lock-nuts to ½" conduit. Knockouts on 28" centers permit hooking-on No. 8 Jack-Chain direct-to-channel—no angles or other parts need be screwed on at the job for this easier method chain-mounting.

WITH PORCELAIN ENAMELED STEEL REFLECTORS

Cat. No.	Lamp Wtg.	Lgth.	Width.	Depth	Ship. Wt.	List Price	Code
M3070	2-40W	48¼"	13¼"	6¼"	28#	$36.00	PIMEX
M3071	3-40W	48¼"	13¼"	6¼"	32#	38.75	PIMOS
M3073	2-100W	60¼"	16¼"	7¼"	44#	46.50	PIMUB

WITH "300° WHITE" ENAMELED STEEL REFLECTORS

M3076	2-40W	48¼"	13¼"	6¼"	25#	$32.50	PINAX
M3078	3-40W	48¼"	13¼"	6¼"	29#	34.75	PINEV
M3077	2-100W	60¼"	16¼"	7¼"	39#	41.50	PINIZ

DESCRIPTIONS: Top-Housings are of 20-gauge steel; End-plates of 18-gauge; Reflectors of 22-gauge. See paragraph ("Easy Installation") above for mounting-hole locations atop housings. Exteriors of all units are finished "Industrial Grey"; reflecting-surfaces of 3-coat, white Porcelain Enamel (75% R. F. or higher), or "300° WHITE" synthetic Enamel (86% R. F. or higher), as ordered.

HOW WIRED: All are wired High-Power-Factor (95% avg. min.), ready-to-install on 110-121 Volt, 60 Cycle, A. C. All units available for 220-250 Volt or 199-216 Volt, 60 Cycle, A. C., at same prices as listed above. The two-lamp units are available for either 110-125 Volt or 220-250 Volt, 50 Cycle, A. C.; for 2-40 watt sizes add $2.50 list, and for the 2-100 watt sizes add $5.00 list. For Watchdog No-Blinks, add 70c list for each 40-watt Starter, and 80c for each 100-watt Starter.

LIGHTING-DATA

The Coefficient Table to right, is for the M3070. Same Table can however be used for all other MAZE-LITES: after computing illumination values from the Table, multiply results by the following Correcting Factors:

Fixture	Factor	Fixture	Factor
M3070	1.00	M3076	1.09
M3071	0.96	M3078	1.05
M3073	0.92	M3077	1.01

COEFFICIENTS OF UTILIZATION

LIGHT CURVE

M3070 MAZE-LITE

Ceiling	75%			50%		
Walls / Room Index	50%	30%	10%	50%	30%	10%
J	.37	.32	.28	.37	.32	.28
I	.44	.41	.38	.43	.40	.37
H	.50	.46	.43	.49	.46	.43
G	.54	.50	.47	.53	.50	.47
F	.58	.54	.50	.56	.52	.50
E	.62	.59	.56	.61	.58	.56
D	.67	.64	.60	.65	.63	.60
C	.69	.66	.63	.67	.64	.63
B	.72	.69	.67	.70	.68	.66
A	.74	.71	.69	.72	.69	.68

See Page 28 for Mounting Accessory-Parts

EXHIBIT E—(Page 32)

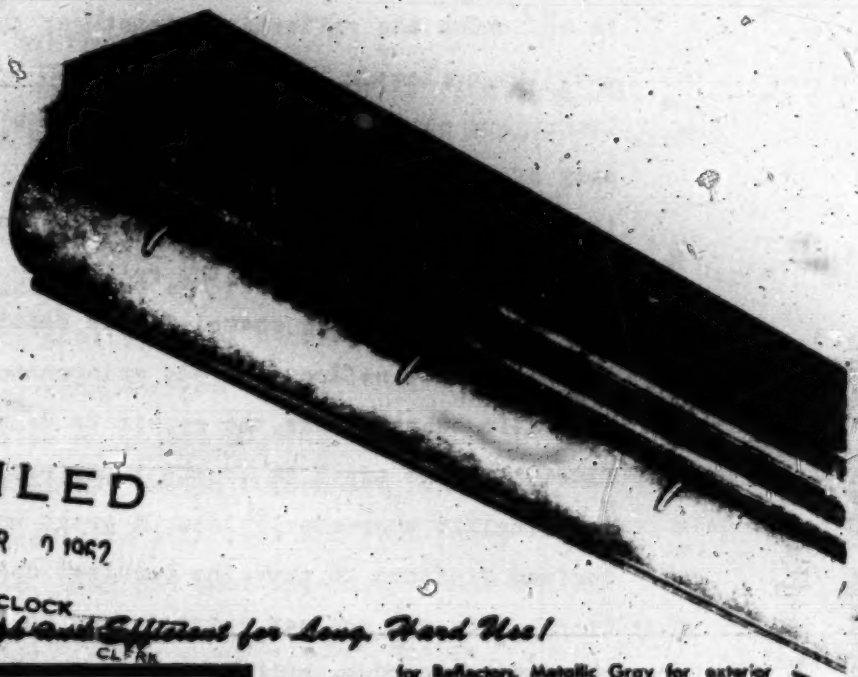
[fol. 358]

FILE NO. 3
SECTION 11
Issued 1-51
Supersedes Form 817

GUTH MAZELITES

(R) - Patents Pending
LISTED BY UNDERWRITERS' LABORATORIES, INC.

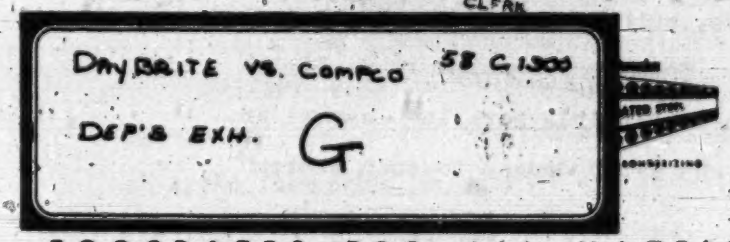
STANDARD MAZELITES
have conventional Bi-pin Lampholders. Reflectors are removable for cleaning and servicing. Knurled latches, permanently attached to the Reflector, lock Reflectors in place with a simple quarter turn.



TURRET MAZELITES
feature Turret Sockets that speed lamp changes and hold lamps securely under spring tension. Reflectors are hinged and open and hang to either side or may be completely removed for easy servicing and cleaning.

FILED
APR 9 1952
AT O'CLOCK
CLERK

Rugged and Efficient for Long, Hard Use!



for Reflectors, Metallic Gray for exterior surfaces—is used and dried by a new Infra-Red High-Bake Process.
The GUTH 300° PERMALUX Finish is a durable surface that far out-performs other finishes in severe salt-spray, humidity and corrosion tests—it will not crack, check, chip, peel or craze. The 300° WHITE PERMALUX Reflectors used in MAZELITES provide 10-15% more light.

EGGCRATES FOR ALL MAZELITES, OTHER SIDE

DEF'S EXH. 5 Def'ts Guth Depo Ex #2 TMK 12-16-58

A. I. A. FILE No. 31-F-23

FORM No. 889-1-51

[fol. 359]

IN THE UNITED STATES DISTRICT COURT

EXHIBIT G—(Front page)

the structures and efforts have been made to eliminate the heat and dirt accumulation by vent-openings.

The current practice is to incorporate apertures in the top wall of the channel or reflecting structure to permit an uninterrupted flow of air, whereby to increase the rate of escape of heat. These apertures permit a certain percentage of light to be emitted upwardly which is a desirable feature as it reduces the overhead gloom prevalent with the older lighting systems. Desirable as is the current practice, the addition of apertures in sufficient number and size to obtain adequate upward lighting results in weakening the reflecting structure; that is to say, the reflector structure is caused to become more limber and pliant. The increased flexibility or pliancy of such reflectors is undesirable. For example, it is recognized and is the accepted standard for lighting fixtures to have the reflecting surfaces coated with porcelain enamel. This coating is ideal for both light reflectance and maintenance, but the porcelain enamel lacks the requisite degree of flexibility to adapt it to the light reflectors having flexible characteristics. A great number of surface finishes do have the required degree of flexibility and are not damaged when applied to a flexible structure, but they are generally not good light reflectors. Thus, the problem is to limit the flexing of the inflexible porcelain enamel in order to prevent and avoid damage to such finish

because of chipping. Porcelain enamel finish also raises another problem because it is applied to the reflector body surfaces at temperatures of approximately 1500° F., and this heat approaches the critical point (loss of strength or stiffness) of the material of the reflector body, which is usually steel. Furthermore, the high temperature range at which the porcelain fuses to the reflector body introduces a tendency in the body to distort or warp, especially around openings and along sharp bends. This latter tendency increases the percentage of rejected parts and is not satisfactory to purchasers who must bear the burden and expense of service maintenance.

The present invention is primarily directed to the economical production of reflectors for lighting fixtures which are provided with apertures for emitting light and heat, but which will also maintain a predetermined shape and resist deformation and flexing during the fusing of porcelain enamel to the light reflecting surface thereof.

It is also an object of this invention to provide light reflectors having a form and construction which will result in stiffness and resistance to warpage so that light and heat emission openings may be provided.

It is a further object of this invention to form reflector bodies for lighting fixtures with simple and easily constructed stiffening means so that the foregoing objections and undesired effects heretofore experienced may be overcome.

Fig. 14 is a greatly enlarged transverse sectional elevational view taken at line 14-14 in Fig. 13; and

Fig. 15 is an enlarged fragmentary sectional elevational view as seen at line 15-15 in Fig. 13.

Referring to Figs. 1, 2 and 3, one form of the present invention is exemplified by a reflector body 10 having a longitudinally directed centrally located light reflecting wall 11 and oppositely curved downwardly directed side walls 12, with longitudinal flanges 13 formed along the lower free margins 14 of the side walls 12. The area of the central reflector wall 11 adjacent the curved side walls 12 is formed with light and heat emitting openings or vents 15 arranged in longitudinal spaced relation. The reflector body is provided with two series of such vent openings 15 in which each opening is relatively narrow in relation to its length.

An important feature of this invention is found in the provision in a reflector as just described of means for stiffening and making the body rigid so that the light reflecting surface thereof may be treated with a porcelain enamel coating and so that the reflector will not warp during the high temperature fusing process or be limber or flexible to the degree which will result in chipping of the porcelain enamel coating. These important objectives are obtained by arranging the vent openings 15 in laterally spaced relation with the longitudinal axis parallel with the length-wise dimension of the reflector body.

Each of the vent openings, at the time the reflector body is formed in a suitable draw-die or by other forming means, is provided with an upturned flange 16 about its periphery. The flanges 16 contribute to longitudinally stiffening the reflector body.

In addition to the flanged vents, a series of transversely directed longitudinally spaced ribs 17 are formed in the reflector body. These ribs are substantially identical and a description of one thereof is believed sufficient to convey an understanding of all of such ribs. It is desirable to provide the ribs 17, or a major portion thereof, as integral parts of the reflector body 10. This is accomplished at the time the reflector body is formed so that each rib 17 has a channel-shape in section (Fig. 5) which varies in depth and in width according to the requirements dictated by the contour of the body 10. For example, referring to Fig. 3, the rib 17 originates well down in each of the curved side walls 12 at the portions 18 and, as the rib progresses upwardly in the side walls 12, its section deepens to a maximum at the portion 19 which is approximately at the maximum point of curvature of the side walls. Fig. 5 discloses the shape of the rib at approximately its deepest section. The rib is characterized by a bottom wall 20 and angularly divergent side walls 21 which are integral with the side walls 12 of the reflector 10. Each rib 17 extends transversely of the body 10, and in the disclosure of Fig. 3, the rib portion 22 which extends

transversely of the central reflecting wall 11 has an approximate uniform shape in section. The rib portions 17 are located between the vents 15 and not only restore the strength of the reflector body which is caused by the formation of the vents, but also hold or set the curvature of the side walls 12, so that stiffness or resistance to warpage and flexibility in the body 10 is created.

Referring now to Fig. 6, the modified reflector body 30 formed of suitable sheet material is provided with downwardly directed side walls 31 whose free lower margins 32 are stiffened by flanges 33. In the modified body 30, instead of providing two series of laterally spaced and longitudinally directed openings, the body is formed with a plurality of larger openings 34 which are arranged in longitudinally spaced relation and are separated by relatively narrow web portions 35 which extend transversely of the body 30. This construction is desirable where a V-shaped central reflecting wall is called for, and the reflector body 30 is suitably stiffened in the following manner.

Referring now to Figs. 10 and 11 in particular, it can be seen that ~~each of~~ the transversely directed webs 35 which form the portions of the body which separate the openings 34 ~~are provided~~ with outstanding tabs 36 oppositely directed and angularly twisted so that the plane of each of the tabs 36 is approximately in the plane of the walls 37 of the V-shaped central wall 38. It is noted that each web 35 is provided

claim 15 is directed to the Figs. 8 or 14 characteristics, and claim 16 is directed to the Fig. 8 structure. These claims are also directed to equivalent structural characteristics and should not be construed as limited precisely to what is shown in the drawings. Certainly the prior art does not require such precise limitations, for what applicants have disclosed is believed to be new and usefully novel.

Claim 17 is directed to the reflector unit embodying the inventive features hereof in a body having laterally spaced oppositely formed reflector surfaces and a central reflecting surface located in the body parallel to the lateral surfaces, with elongated vent openings between the central and lateral surfaces. Claim 17 calls for body stiffening means including rib portions extending into the lateral surfaces and conforming to the space thereof and directed transversely of the length of the body, rib elements extending transversely of the central surface and located between the rib portions extending into the lateral surfaces, and marginal flanges formed about the openings. Thus, claim 17 calls for the lateral and central reflecting surfaces in a reflector unit body having stiffening means comprising transversely directed ribs and flanged vent openings, wherein the transversely directed ribs extend across the reflector body with a pronounced stiffening effect on the otherwise unstiffened surfaces. This is believed to be a patentable construction which is not disclosed by Abernathy or found by combining Guth with Abernathy. It has been

to $2,446,000.00 which represents a sharp drop of business and coincided with an excessive rate of factory rejects attributable to warpage of the reflector units during burning of the coating and chipping of this coating in the packages, and also rejects in the field from shipping and installation procedures.

That the public acceptance of the "Day-Line" unit with the uplighting feature was enough in 1953, measured by the dollar volume of business, to show a sharp increase over prior years in production in the industrial lighting fixture department.

That the sharp drop in industrial sales for the year 1954 is substantially due to the rise in factory rejects and customer rejectance.

That the drop in business in 1954 in the industrial lighting fixture came at a time when the overall business of Day-Brite increased 5% over the year 1953.

That the dollar volume of business in the first full year, 1955 of sales of the reflector unit disclosed in the subject patent application of O. W. Klingsick and L. G. Stahlhut, Serial No. 482,212, and identified to the trade as the C.F.I.-10 and C.F.I.-25 industrial fixtures, was about $2,793,000.00 which to Day-Brite indicated correction of the faults found in the "Day-Line" units and customer acceptance of the C.F.I.

That the business done in 1956, the second year of sales of C.F.I. fixtures, amounted to about $4,029,000.00, and that this represents a 44% increase over the year 1955, whereas the total sales of Day-Brite increased only 26% over 1955.

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322 [fol. 872] EXHIBIT Q—(Page 130)

previous claims 11, 17 and 21, and, in addition, the revised claims have been recast to bring out the structure which is believed to be entirely unexpected and novel in this art. For example, only Guth (Catalog, Number 44-A, pages 31 and 32) shows ribs in the side surfaces, but these have no connection of any kind whereby the reflector is held fixed as to width. Subsequently, Guth itself abandoned the ribs, as shown by Reference 8.

The new claims are believed to patentably distinguish from all of the references of record as well as the eight (8) additional references suggested to the Examiner.

Claim 23 is directed to the reflector unit in which the spaced side reflecting surfaces have a downwardly directed relation with a central surface between the side surfaces, set off by longitudinal spaced, elongated apertures. The unit is provided with means to retain the spacing of the side surfaces in fixed relationship, such means including rib portions in each side surface extending transversely from the spaces between the apertures outwardly and downwardly into the side surfaces to substantially fix the form thereof, and elements extending transversely of the central surface between the side surfaces to interconnect and/or act in cooperation with the ribs to substantially fix the spacing of the side surfaces. The means herein defined serves to retain the width of the unit substantially constant.

The references which disclose this general arrangement of reflecting surfaces are Abernathy, Guth, Wheeler, Westinghouse, Iliffe and Forth, but none of these references of record, or suggested herein for the record, have the equivalent of applicant's means for fixing the position

GUTH WYTE-LINERS

HIGHER QUALITY PRODUCTION LIGHTING

GUTH WYTE-LINERS are engineered efficient light producers with features to provide the proper brightness ratios, contrasts, shielding and light control required for the various seeing needs of production.

ALL WHITE FINISH

White on the inside — White on the outside. THIS is the latest for Production Seeing. Even under the worst Plant conditions WHITE is recommended, for an all-white fixture helps lift ceiling gloom, provides better brightness contrasts and improves fixture maintenance. ALL-WHITE Fixtures are a new step forward more efficient visual conditions in the Plant and GUTH WYTE-LINERS lead the way to more productive Lighting.

300 WHITE or PORCELAIN REFLECTORS

Both WYTE-LINER Reflectors have tough, durable, efficient surfaces. The 300 WHITE PERMALUX Reflector with the Refrigerator Finish will not crack, chip, pale or craze, it washes well and easily, and delivers 85½% efficiency. The GUTH WHITE PORCELAIN Reflector is a hard porcelain Finish that resists flaking and is 82½% efficient.

ALZAK ALUMINUM REFLECTORS

Formed in same contour as standard reflectors. Finished ALZAK in and out. Specify by using prefix "AL" to Porcelain Reflector Cat. Nos. Same prices as for Porcelain Units.

CHOICE OF SHIELDING

WYTE-LINERS have good acceptable shielding as shown above, right. For extra Shielding, Longitudinal Baffles provide 27° side Shielding. Baffles fasten to Reflector Releases and can be used with 2-Lite Fixtures only. Eggcrate Louvres can be used for 30° lengthwise and 30° crosswise Shielding. Eggcrates may be used with 2- or 3-Lite models and hinge open to either side for easy relamping.

UP-LIGHT REFLECTORS

WYTE-LINER Reflectors can be had with "Up-Light" Slots, as shown at right. These Slots provide a 7% portion of upward light. Also available with 20% uplight reflectors; prices on request, dependent upon quantity.

LOW BRIGHTNESS MODELS

GUTH WYTE-LINERS can be had with Accessories for 40W, 60", T-17 Low Brightness Lamps. These Lamps reduce apparent brightness and cut down reflected glare.

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[fol. 367]

EXHIBIT Q—(Page 85)

new reflector unit of this application is equally forceful testimony of commercial success. The 1956 sales story, and the 1957 trend, shows that it is not a momentary success, but one having real substance.

Applicants' invention is claimed as " a reflector unit" for a lighting fixture. That is particularly appropriate, because everything which makes it useful and novel over the prior art is in the reflector unit, and this unit can be furnished to fit upon a wire box or header.

In the broadest claim 32, the first six lines state the environment or characteristics. The remainder of the claim may then be analyzed as follows:

1. a plurality of rib elements directed transversely of the body length and spaced apart along the length thereof,

   (a) certain of said rib elements having outer terminal ends near the opposite sides of the body,

2. side reflecting surfaces in the body fixedly supported by said rib elements in side by side spaced relation,

   (b) said side reflecting surfaces being arcuately formed in transverse section between remote outer and inner adjacent margins,

   (c) with the outer margins free of said outer terminal ends of said rib elements,

   (d) said side reflecting surfaces also having said inner adjacent margins formed with openings to provide light outlets,

3. and a light reflecting surface in said body disposed centrally between said side reflecting surfaces so as not to obscure said openings for light outlets.

Exhibit Q—(Page 117)

318 [fol. 368]

The Examiner has cited combinations of the prior art, but no single reference discloses the subject-matter of the broadest claim 32, and these references have been discussed above. Abernathy discloses a composite construction in which the box-section 14 and 32 enclosing the wires and the socket boxes 26 at the ends are relied upon to stiffen the reflector, but these parts, if they are stiffeners, function only on the central portion of the reflector, there being no stiffening function in the downwardly directed side reflector surfaces, or stiffening of one side relative to the other. Thus, Abernathy is an entirely different construction. The Examiner has stated that the ribs of Darley, Forth, or Guth Number 44-A Catalog would provide Abernathy with a desired "greater degree of stiffness". None of these secondary references, it is noted, has elements 1 and 2, and Abernathy fails also to have elements 1 and 2. It is, thus, mere conjecture on the Examiner's part to combine these references, because a "greater degree of stiffness", to use the words of the rejection, is already expressed in Abernathy and is found in an entirely different arrangement of parts than is set forth by this claim.

It is respectfully noted that the Examiner has pointed to elements 26 and 32 in Abernathy as if these were equivalent to applicants' elements 1(a). Abernathy has no elements which are close to element 1(a). Since the principal reference does not disclose the necessary elements, it seems unlikely that the secondary references can supply the vacancy in the exact manner required. It should not be overlooked that skilled workers in this art have tried and have failed to produce the reflector unit

[fol. 369]

Exhibit Q—(Page 118)

defined by claim 32. While the Examiner has taken the position that this combination of references does not involve invention, it is a faulty position, because he assumes that the function of parts which has been so clearly expressed in Abernathy can be changed to make way for an entirely different function of parts or elements selected from other sources. It is respectfully submitted that this combination would result in such a reorganization of all structures involved as to be beyond mechanical skill. The fact is that other skilled workers in this art did not do what the Examiner is suggesting, and the effort extended over a period of fifteen years, as has been shown above.

It is not necessary to consider in detail the other claims, as they are all more specific than claim 32. For example, claim 33 is more specific in the integrally formed ribs extending from side to side and having outer terminal ends free of the outer margins of the side reflectors. Claim 34 is more specific in the integral body of sheet material having two rows of apertures and the continuation of ribs from side to side to prevent flexing. Claim 35 is more specific in the central portion having oppositely directed reflecting surfaces. Claim 36 is more specific in the attachment of a separate reflector to the body.

APPLICANTS' INVENTION IS PATENTABLE

The Examiner's refusal to allow claims in this application is not based on the ground of anticipation, but is for lack of invention over Abernathy, in view of Darley, Forth, Guth Catalog 44-A, Marchisio, or Iliffe. The combination of references is, therefore, based upon

320 [fol. 370] Examr Q—(Page 119)

IN THE UNITED STATES PATENT OFFICE

Application of

Oswald W. Klingaiek and
Leo G. Stahlhut

Serial No. 682,212

Filed January 17, 1955

Reflectors for Lighting Fixtures

Last Office Action Nov. 13, 1956

Division 62

U. S. PATENT OFFICE

MAY 17 1957

DIVISION 62

AFFIDAVIT

State of Missouri :
: ss.
City of St. Louis :

I, James F. Whitehead, being duly sworn, depose and say that I am Executive Vice-President of Day-Brite Lighting, Inc. and in charge of sales, and that the following facts are true and correct to the best of my knowledge:

That Day-Brite, during the years 1952 and 1953, manufactured, offered for sale and sold reflector units of the "Day-Line" type in which apertures were formed to provide uplighting, and these units are shown in Reference Item 1 of the list of items offered by applicants and set forth on page 5 of the amendment dated May 9, 1957.

That the dollar volume of business done by Day-Brite in the first full year 1953 of sales of its "Day-Line" reflector unit amounted to approximately $2,857,000.00 (rounded off to the nearest thousand).

That the dollar volume of business in the next full year 1954 of its "Day-Line" sales amounted

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[fol. 371]

EXHIBIT Q—(Page 129)

821

[fol. 373] Clerk's Certificate to foregoing transcript (omitted in printing).

[fol. 374]

IN THE UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

September Term, 1962—September Session, 1962

No. 13699

DAY-BRITE LIGHTING, INC., Plaintiff-Appellee,

v.

COMPCO CORPORATION, Defendant-Appellant.

No. 13700

DAY-BRITE LIGHTING, INC., Plaintiff-Appellant,

v.

COMPCO CORPORATION, Defendant-Appellee.

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

OPINION—December 14, 1962

Before Hastings, Chief Judge, and Knoch and Castle, Circuit Judges.

Knoch, Circuit Judge. Plaintiff, Day-Brite Lighting, Inc., brought suit against defendant, Compco Corporation, for infringement of plaintiff's design patent and unfair competition.

The District Judge found that the patent was invalid and not infringed. He found the defendant was guilty of unfair competition, granted an injunction and ordered an accounting for damages. The defendant appealed this latter part

of the judgment. The plaintiff cross-appealed the finding of invalidity and non-infringement of the patent.

The design of the patent concerns reflectors in commer- [fol. 375] cial fluorescent lighting fixtures. The fixtures here involved are of the "uplight" type; 48 inches long; made of a housing, a ballast (transformer), a reflector, sockets and wiring for long lighting tubes; all sold, not in component parts but as a unit, ready for ceiling installation. The reflector, sandwiched, as indicated, between the housing and the light tubes, has elongated slots to allow light from the tubes to be directed upward against the ceiling as well as down toward the floor. The fixtures may be positioned end to end in a continuous line.

This type of fixture, popular in the early 1950's and marketed by a number of companies, including plaintiff's, used cross ribs between the elongated slots, the housings and over-all fixtures being similar in general appearance and size.

In 1954, after complaints of warpage in the reflectors, which caused the porcelain reflective coatings to chip, plaintiff altered its design by extending the cross ribs down the sides of the U-shaped reflector. Although this also presented an attractive appearance, it served to strengthen the reflector. The changed design was embodied in fixtures which the plaintiff began selling in or about October, 1954. These are sold under the name "C F I-10." The new appearance of the plaintiff's fixtures was the subject of its Patent No. Des. 176,367, issued December 13, 1955, which plaintiff sought to enforce in this action. Styling is considered important in the industry and such styling does provide product identification which increases salability of products.

In 1955, Mitchell Manufacturing Company manufactured fixtures with reflectors under the names "Mitchell" and "Dynalite," which were almost exact copies of plaintiff's C F I-10 design. On or about December 31, 1955, the plaintiff gave notice of infringement to Cory Manufacturing Company, which had then acquired Mitchell Manufacturing Company and was advertising the reflectors. On or about March 9, 1956, defendant acquired certain of the Mitchell assets from Cory, and defendant then manufactured the

Mitchell and Dynalite reflectors, using the same advertising and promotional literature put out by Mitchell and Cory.

On or about March 30, 1956, the plaintiff gave notice of infringement to the defendant. Defendant denied both infringement and the validity of the plaintiff's patent. Two of the plaintiff's other competitors who were offering [fol. 376] reflectors having the overall appearance of C F I-10 entered into consent judgments holding the patent valid and infringed. Others discontinued manufacturing such reflectors on notice of infringement.

The District Judge held that plaintiff's patent was invalid. He specifically found that the function of the cross ribs was to strengthen against warp and twist, to minimize distortion due to the heat of the porcelain enameling process, and to prevent chipping of the finish after cooling; that the size, shape and length were dictated by the manufacturing process. He also found that had plaintiff's patent been valid, it would have been infringed by the defendant's reflectors.

The evidence of infringement presents no substantial issue. We must agree with the District Court that if the plaintiff's patent is valid, it is also infringed.

The evidence clearly indicates that the change of design as shown in the patent in suit arose out of a need to meet complaints of warping. While a choice of ribbing to meet the need was available, any particular choice had to be made from those types of ribbing which would be suitable to the functional requirement. The rib design had to be of a type to strengthen the reflector against warp and twist. The plaintiff's Manager of Tools and Dies, Bert A. Kaeppel, testified that the depth and shape of the ribbing was dictated by production requirements. He stated that drawing the ribs "too deep" or making the side of the ribs "much more nearly parallel" would create a "problem of tearing the metal."

A design patent covering mere functional configuration does not meet the standard of invention for a design patent. *Spaulding* v. *Guardian Light Co.*, 7 Cir., 1959, 267 F. 2d 111, 113, cert. den. 361 U.S. 883; *Hopkins* v. *Waco Products, Inc.*, 7 Cir., 1953, 205 F. 2d 221, 224.

The District Court's decision that the design of the cross ribs was functional and dictated by the limitations of the manufacturing process is fully supported by the evidence. The Trial Judge also had before him prior art which had not been considered by the Patent Office. The Abernathy Mechanical patent (No. 2,332,770, October 26, 1943), the only reference cited, does not show cross ribs. The prior art reflectors listed by the Trial Judge in his Finding of Fact No. 7 do show transverse ribs. Thus the presumption of validity otherwise attaching to a patent was weakened [fol. 377] here. *Senco Products, Inc.* v. *Fastener Corp.*, 7 Cir., 1959, 269 F. 2d 33, 34, cert. den. 361 U.S. 932 (1960); *Hobbs* v. *Wisconsin Power & Light Co.*, 7 Cir., 1957, 250 F. 2d 100, 105, cert. den. 356 U.S. 932.

It is the plaintiff's contention that the Trial Court decided the question of validity purely on the premise that certain individual elements in the design were old, and failed to consider the "over-all appearance" with its subtle changes and arrangements of old lines and shapes. We cannot agree.

In *Amerock Corporation* v. *Aubrey Hardware Mfg., Inc.*, 7 Cir., 1960, 275 F. 2d 346, Chief Judge Hastings examined the entire line of decisions in this Court respecting design patents. At page 348 of that opinion, he said:

> It is settled beyond dispute that "[a] design patent, in order to be valid, must disclose a design that is new, original and ornamental, unanticipated and inventive in character, and beyond the skill of the ordinary designer or draftsman." [Citing cases.]

We are satisfied that the District Court applied the proper criteria and correctly found that the design patent in suit was invalid.

This brings us to the question of unfair competition. While the District Judge did not specifically find "secondary meaning" identifying the reflectors with the plaintiff as a source, he did find that the appearance of the C F I-10 has the capacity to identify the plaintiff in the trade and does, in fact, so identify the plaintiff to the trade. He found that concurrent sale of C F I-10 and Mitchell-Dyna-

lite fixture reflectors was likely to cause confusion in the trade, and that actual confusion had occurred. Therefore, although he dismissed the Complaint insofar as patent infringement was concerned, he did find the defendant guilty of unfair competition. He granted an injunction against unfair competition by sale or attempted sale of reflectors identical with or confusingly similar to the C F I-10 or the Mitchell "Dynalite," and ordered an accounting for damages resulting from such unfair competition.

Defendant contends that confusion of purchasers is impossible because those who buy this type of comparatively expensive product (which is always shipped in clearly marked containers) are skilled, experienced and discriminating purchasers. However, the District Court did find [fol. 378] confusion likely, and there is substantial evidence in the record to support that finding. We cannot characterize the finding as "clearly erroneous" and may not set it aside. Federal Rules of Civil Procedure, Rule 52.

The defendant argues that in the absence of a finding of either "secondary meaning" or "palming off," there can be no holding of unfair competition; that the essence of unfair competition is fraud. Defendant relies on statements in the opinion on petition for rehearing in *Day-Brite Lighting, Inc.* v. *Sandee Mfg. Co.*, 7 Cir., 1961, 286 F. 2d 596, 600, and similar expressions from this and other Circuits. In the *Sandee* case, the plaintiff in its petition for rehearing had sought clarification of the decision on the issue of unfair competition, the plaintiff having presumed that this Court intended to affirm the District Court on the issue of unfair competition, while holding that the patent in suit was invalid and not infringed. In clarification, the opinion on the petition for rehearing stated:

> We realize, of course, that a case of unfair competition may be made, separate and apart from that of infringement. In this case, however, we think the two issues were so closely allied that the former could not prevail in the absence of the latter and that holding the patent invalid and not infringed also disposed of the action for unfair competition adversely to plaintiff.

The opinion on petition for rehearing then cites *Zangele & Peterson Co.* v. *Venice Furniture Novelty Mfg. Co.*, 7 Cir., 1943, 133 F. 2d 266, 269; *General Time Instruments Corp.* v. *United States Time Corp.*, 2 Cir., 1948, 165 F. 2d 853, 854; and *Sinko et al.* v. *Snow-Craggs Corp.*, 7 Cir., 1939, 105 F. 2d 450, to the effect mere copying of the teaching of an invalid patent does not constitute unfair competition. This *was* the law in Illinois. It is not contested that Illinois law governs the case before us.

However, there has been a change in the law of Illinois on this subject, as analyzed by Judge Duffy in his opinion in *Independent Nail & Packing Co. Inc.* v. *Stronghold Screw Products, Inc.*, 7 Cir., 1953, 205 F. 2d 921. After stating the rule promulgated in earlier cases, Judge Duffy continues (at page 925):

> However, we think the rule announced in these cases is no longer the law of Illinois.
> [fol. 379] In 1942 the Supreme Court of Illinois in *Investors Syndicate of America, Inc.* v. *Edward J. Hughes, Secretary of State*, 378 Ill. 413, at page 422, 38 N. E. 2d 754, at page 759, stated, "Even in injunction cases between competing corporations the trend of decision is to place less emphasis on competition and more on confusion, as is evidenced by the following cases: (citing) 'The test should be whether the public is likely to be deceived'."

The defendant would limit the holding in *Independent Nail* to such "protectable" rights as trademarks. The plaintiff's reflectors, as found by the Trial Court, in findings supported by the evidence, do have the capacity to identify the plaintiff and do so identify the plaintiff in the trade. The capacity of the plaintiff's design to serve the plaintiff in somewhat the manner of a trademark does constitute a "protectable" right.

As noted, several choices of ribbing were apparently available to meet the functional needs of the product. The defendant did not avail itself of the other types but instead chose precisely the same design used by the plaintiff and followed it so closely as to make confusion likely. We are

constrained to agree with Judge Duffy's statement in *Radio Shack Corp.* v. *Radio Shack*, 7 Cir., 1950, 180 F. 2d 200, 206, as cited with approval so recently as November 21, 1962, in Judge Hastings' opinion in *G. Leblanc Corp.* v. *H. & A. Selmer, Inc.*, Appeal No. 13232-13233: The essence of "unfair competition" is that it be unfair, that "in all cases of unfair competition, it is principles of old-fashioned honesty which are controlling."

We have examined all the arguments advanced by both parties and have concluded that the judgment of the District Court must be affirmed.

Affirmed.

[fol. 380]

IN THE UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Before: Hon. John S. Hastings, Chief Judge, Hon. Win G. Knoch, Hon. Latham Castle, Circuit Judges.

No. 13699

DAY-BRITE LIGHTING, INC., Plaintiff-Appellee,

vs.

COMPCO CORPORATION, Defendant-Appellant.

No. 13700

DAY-BRITE LIGHTING, INC., Plaintiff-Appellant,

vs.

COMPCO CORPORATION, Defendant-Appellee.

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

JUDGMENT—December 14, 1962

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, Affirmed, with costs, in accordance with the opinion of this Court filed this day.

[fol. 381]

IN THE UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

No. 13699-13700

[Title omitted]

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

ORDER DENYING PETITION FOR REHEARING, ETC.—
January 18, 1963

It Is Ordered by the Court that defendant-appellee's (Compco Corporation) petition for rehearing in the above-entitled matter, as well as petition for clarification, and petition for modification of decision of December 14, 1962, be, and the same are hereby Denied.

[fol. 382] Clerk's Certificate to foregoing transcript (omitted in printing).

[fol. 383]

SUPREME COURT OF THE UNITED STATES

No. 1010, October Term, 1962

COMPCO CORPORATION, Petitioner,

vs.

DAY-BRITE LIGHTING, INC.

ORDER ALLOWING CERTIORARI—June 17, 1963

The petition herein for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit is granted, and the case is placed on the summary calendar.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

COMPCO CORPORATION, *Petitioner,*

vs.

DAY-BRITE LIGHTING, INC., *Respondent.*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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The Scheffer Press, Inc.—ANdover 3-6850

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1962.

No.

COMPCO CORPORATION,

Petitioner,

vs.

DAY-BRITE LIGHTING, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Compco Corporation prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered in the above-entitled cause on December 14, 1962, which was denied rehearing on January 18, 1963.

OPINION BELOW

The opinion of the Court of Appeals is reported at 311 Fed. 2d 26, and is reprinted as the Appendix, along with the judgment and denial of petitioner's petition for rehearing.

JURISDICTION

This Court's jurisdiction is founded under 28 U.S.C. 1254(1).

This petition is presented within ninety days from January 18, 1963, which is the date of the Court of Appeals decision denying rehearing of its original decision of December 14, 1962.

QUESTION PRESENTED

Is the freedom from confusion required by the Illinois law of unfair competition more important than the freedom of competition required by the United States patent and anti-trust laws so as to justify enjoining the selling, in properly marked containers, of the precise light fixtures of an invalid design patent?

STATUTES INVOLVED

The statutes involved include the pertinent sections of the Patent Act of 1952, Title 35 U.S.C., Sections 171 and 281; and 28 U.S.C., Section 1338:

35 U.S.C. 171:

> Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor. . . .

35 U.S.C. 281:

> A patentee shall have remedy by civil action for infringement of his patent.

28 U.S.C. 1338:

> (a) The district courts shall have original jurisdiction of any civil action arising under any act of Congress relating to patents. . . .
>
> (b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent or trademark laws.

STATEMENT

Respondent Day-Brite Lighting, Inc. started marketing a fluorescent light fixture designated CFI-10 in October, 1954. These fixtures are intended for ceiling installation and are 48" long, being made up of a housing and a reflector for the long lighting tubes. The fixture is sold as a unit, complete for installation, not in component parts.

The CFI-10 had a reflector of the "uplight" type, the reflector having elongated slots so that the light from the tube could be directed upwardly against the ceiling as well as downwardly. This eliminated shadows and unlighted areas. This particular type of fixture became popular in the early 1950's and was marketed by a number of companies.

The respondent's reflector differed from those being marketed as part of fixtures in 1954 by having slightly longer reinforcing ribs to prevent the reflector from warping.

Early in 1955, the petitioner's predecessor, Mitchell Lighting Division of Cory Manufacturing Company, started marketing a fixture having a similar reflector. A design patent was granted to respondent on December 13, 1955, and immediately thereafter a written notice of infringement was sent to Cory Manufacturing Company. Another notice of infringement was sent to petitioner on March 30, 1956.

Thereafter, two of respondent's other competitors entered into consent judgments holding the patent valid

and infringed, while a number of other competitors discontinued manufacturing after notice of infringement.

Respondent filed a complaint on July 14, 1958 alleging (1) infringement of the design patent under Title 35 U.S.C. 281 and (2) unfair competition under Title 28 U.S.C. 1338. The trial court held the design patent invalid.

The only activity of petitioner considered illegal was just the sale of fixtures incorporating the now-unpatented reflectors, there being no holding of "passing off"—the Court of Appeals stating that the defendant's products are "always shipped in clearly-marked containers". In its opinion, the Court of Appeal held that only the Illinois interest in "freedom from confusion" was involved here, and notwithstanding the invalidity of the design patent which literally covered petitioner's construction, there was enjoinable unfair competition. The holding of the District Court granting an injunction *in perpetuo* against sale or attempted sale of reflectors identical with or confusingly similar to the CFI-10, was affirmed, along with an accounting for damages resulting from the unfair competition.

REASONS FOR GRANTING THE WRIT

1. The Court of Appeals has decided an important federal question which has not been, but should be, settled by this Court. The question involves the exclusive application of the federal anti-trust and patent laws to a situation where a seller has first elected to acquire a federal cause of action, thereby rejecting his common law right of action, and thereafter has enforced this federal right against competitors. Then, when the federal cause of action disappears because the patent is held invalid, is it proper for the seller to turn to the here-

tofore rejected common law right based on unfair competition?

This Court has not ruled on the question of whether an act that would be infringement of a design patent, if valid, can, just by itself, also constitute unfair competition. Here, a distinction is set up between a design patent and a mechanical patent. A design patent is granted only on the ornamental, i.e., identifying, nonfunctional features of a product—those same features which are relied upon in an action for unfair competition based upon confusion of the public. It will be seen that, in electing design patent coverage, respondent obtained shorter but surer coverage than that available through the doctrine of unfair competition.

Once having made this election and having enforced the patent, respondent cannot wipe the slate clean and ask for relief, under the guise of unfair competition, for an act that would constitute only design patent infringement. Just how the joinder of these actions arose is not clear, but it is clear that it has no sanction either in the statutory law or the decisions of this Court, the last design patent case decided by this Court being *Smith* v. *Whitman Saddle Co.*, 148 U.S. 672 (1892).

2. The decision in this case is in conflict with the applicable decisions of this Court, as derived from considerations of the anti-trust and patent laws. The anti-trust laws condemn a monopoly such as granted here, save only as it is within the protection of a lawfully granted patent monopoly. *Sola Electric Company* v. *Jefferson Electric Company*, 317 U.S. 173 (1942). Holding otherwise frustrates the basic purpose of the anti-trust laws.

> "The general objective of the anti-trust laws is the promotion of competition in the open markets." Report of the Attorney-General's National Committee to Study the Anti-Trust Laws, March 31, 1955, page 1.

The anti-trust laws condemn monopolies, and the only monopoly standing by itself (without attendant questionable behavior) which is free of challenge, is a patent. This stems from the fact that patents spring from the Constitution (Article I, Section 8, clause 8), and only because of this are exempt from the all-pervasive inquiry of the anti-trust laws. Chief Justice Hughes remarked that the Sherman Anti-Trust Act:

> "As a charter of freedom . . . has a generality and adaptability comparable to that found to be desirable in Constitutional provisions." *Appalachian Coals, Inc.* v. *United States*, 288 U.S. 344, 359 (1933).

The exception to the anti-trust inquiry is justified, since the monopoly is limited in time and limited in scope. Neither is the case here, since the injunction is in perpetuity and covers reflectors "identical to or confusingly similar to plaintiff's reflector."

The decisions of this Court on patents hold that, upon expiration of a patent, the subject matter is free to the public to use. In *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111 (1938), the design patent on the shredded wheat biscuit was held invalid, this Court saying at pp. 119-120:

> "Upon expiration of the patents, the form as well as the name was dedicated to the public. . . . The Kellogg Company was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of plaintiff."

Later, this Court went even further in defining the rights accruing to the public upon expiration of a patent, saying in *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U.S. 249, 256 (1945):

> "By force of the patent laws, not only is the invention of a patent dedicated to the public upon its expiration, but the public thereby becomes entitled to share in the good will which the patentee has built up in the patented article or product through the enjoyment of his patent monopoly. Here, we have held that the patentee may not exclude the public from participating in that good will or secure, to any extent, a continuation of his monopoly. . . ."

The justification for this exclusion is clear. Either the patentee has benefited from his patent in driving others from the field, as here, or has benefited from the deterrent to others to enter the field because of the patent. Respondent, throughout the trial and appeal of this case, relied heavily on the respect accorded the patent, introducing as evidence the consent decrees and documents relative to competitors leaving the field because of the threat of patent litigation.

The decision of the Court of Appeals held that the Illinois interest in "freedom from confusion" was controlling, ignored the clear-cut statement of this Court in *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U.S. 249, 256 (1945):

> "The nature and extent of the legal consequences of the expiration of a patent are federal questions, the answers to which are to be derived from the patent law and the policies which they adopt."

To the federal law and policy, conflicting state law and policy must yield. Constitution, Article VII, clause 2; *Sola Electric Co.* v. *Jefferson Electric Co.*, 317 U.S. 171,

176 (1943). Also, the Illinois law has nothing to do with design patents, this being reserved to the federal courts.

The holding that only the freedom from confusion is to be considered in an unfair competition action on the sale of a product covered by an expired design patent, affects every segment of the economy.

a. The Judiciary now has to decide whether anyone is likely to be confused rather than employing the objective test of whether invention is present in a patented structure.

b. The Bar now has to investigate the marketing practices of a patentee to determine whether liability will result rather than looking to the patent and prior art.

c. A competitor of the patentee cannot now challenge the validity of a patent by marketing the identical structure covered, notwithstanding careful identification so that there is no passing off.

d. The public in general is deprived of competition which tends to drive the price down while maintaining the quality high.

3. The decision in this case has become the established law in the Seventh Circuit, being followed in a later case decided by the Court of Appeals, *Stiffel Co.* v. *Sears, Roebuck & Co.*, ... F.2d. ...., 136 U.S.P.Q. 292 (1963). This rule is in conflict with the decisions of the other Circuits.[1]

---

[1] Lucien Lelong, Inc. v. Lander Co., Inc., 164 F. 2d 395 (CA 2, 1947); West Point Mfg. Co. v. Detroit Stamping Co., 222 F. 2d 581 (CA 6, 1955); Daniel v. Electric Hose and Rubber Co., 231 Fed. 827 (CA 3, 1916); Goodyear Tire and Rubber Co. v. Robertson, 18 F. 2d 639 (D. Md., 1927), aff'd 25 F. 2d 833 (CA 4, 1928); Lenox v. Jones, McDuffee and Stratton, 271 Fed. 511 (D. Mass., 1921). Most of the design patent-unfair competition cases appear to be tried in New York and Chicago.

As pointed out above, the origin of the joinder of patent infringement and unfair competition causes of action is unclear. Nonetheless, until the advent of this case, all of the Circuits have held that the expiration of a design patent throws the construction into the public domain, the interest of the public in free competition being paramount. Characteristic of the attitude of the other Circuits is the latest statement of the Second Circuit, in *Hygienic Specialties Co.* v. *H. T. Saleman, Inc.*, 302 F. 2d 614, 619 (1962):

> "This initial response (intolerability of copying) to the problem has been curbed in deference to the greater public good, apparently on the principle that limitation is the lifeblood of competition." (Parenthetical remarks added)

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this petition for a writ of certiorari should be granted.

Respectfully submitted,

HORACE DAWSON
Attorney for Petitioner.

APPENDIX.

OPINION.

IN THE

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

SEPTEMBER TERM, 1962—SEPTEMBER SESSION, 1962

No. 13699
DAY-BRITE LIGHTING, INC.,
Plaintiff-Appellee,
v.
COMPCO CORPORATION,
Defendant-Appellant.

No. 13700
DAY-BRITE LIGHTING, INC.,
Plaintiff-Appellant,
v.
COMPCO CORPORATION,
Defendant-Appellee.

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

December 14, 1962

Before HASTINGS, *Chief Judge*, and KNOCH and CASTLE, *Circuit Judges*.

KNOCH, *Circuit Judge*. Plaintiff, Day-Brite Lighting, Inc., brought suit against defendant, Compco Corporation, for infringement of plaintiff's design patent and unfair competition.

The District Judge found that the patent was invalid and not infringed. He found the defendant was guilty of unfair competition, granted an injunction and ordered an accounting for damages. The defendant appealed this latter part of the judgment. The plaintiff cross-appealed the finding of invalidity and non-infringement of the patent.

The design of the patent concerns reflectors in commercial fluorescent lighting fixtures. The fixtures here involved are of the "uplight" type; 48 inches long; made of a housing, a ballast (transformer), a reflector, sockets and wiring for long lighting tubes; all sold, not in component parts but as a unit, ready for ceiling installation. The reflector, sandwiched, as indicated, between the housing and the light tubes, has elongated slots to allow light from the tubes to be directed upward against the ceiling as well as down toward the floor. The fixtures may be positioned end to end in a continuous line.

This type of fixture, popular in the early 1950's and marketed by a number of companies, including plaintiffs', used cross ribs between the elongated slots, the housings and over-all fixtures being similar in general appearance and size.

In 1954, after complaints of warpage in the reflectors, which caused the porcelain reflective coatings to chip, plaintiff altered its design by extending the cross ribs down the sides of the U-shaped reflector. Although this also presented an attractive appearance, it served to strengthen the reflector. The changed design was embodied in fixtures which the plaintiff began selling in or about October, 1954. These are sold under the name "C F I-10." The new appearance of the plaintiff's fixtures was the subject of its Patent No. Des. 176,367, issued December 13, 1955, which plaintiff sought to enforce in this action. Styling is considered important in the industry and such styling does provide product identification which increases salability of products.

In 1955, Mitchell Manufacturing Company manufactured fixtures with reflectors under the names "Mitchell" and "Dynalite," which were almost exact copies of plaintiff's

C F I-10 design. On or about December 31, 1955, the plaintiff gave notice of infringement to Cory Manufacturing Company, which had then acquired Mitchell Manufacturing Company and was advertising the reflectors. On or about March 9, 1956, defendant acquired certain of the Mitchell assets from Cory, and defendant then manufactured the Mitchell and Dynalite reflectors, using the same advertising and promotional literature put out by Mitchell and Cory.

On or about March 30, 1956, the plaintiff gave notice of infringement to the defendant. Defendant denied both infringement and the validity of the plaintiff's patent. Two of the plaintiff's other competitors who were offering reflectors having the overall appearance of C F I-10 entered into consent judgments holding the patent valid and infringed. Others discontinued manufacturing such reflectors on notice of infringement.

The District Judge held that plaintiff's patent was invalid. He specifically found that the function of the cross ribs was to strengthen against warp and twist, to minimize distortion due to the heat of the porcelain enameling process, and to prevent chipping of the finish after cooling; that the size, shape and length were dictated by the manufacturing process. He also found that had plaintiff's patent been valid, it would have been infringed by the defendant's reflectors.

The evidence of infringement presents no substantial issue. We cannot agree with the District Court that if the plaintiff's patent is valid, it is also infringed.

The evidence clearly indicates that the change of design as shown in the patent in suit arose out of a need to meet complaints of warping. While a choice of ribbing to meet the need was available, any particular choice had to be made from those types of ribbing which would be suitable to the functional requirement. The rib design had to be of a type to strengthen the reflector against warp and twist. The plaintiff's Manager of Tools and Dies, Bert A. Kaeppel, testified that the depth and shape of the ribbing

was dictated by production requirements. He stated that drawing the ribs "too deep" or making the side of the ribs "much more nearly parallel" would create a "problem of tearing the metal."

A design patent covering mere functional configuration does not meet the standard of invention for a design patent. *Spaulding* v. *Guardian Light Co.*, 7 Cir., 1959, 267 F. 2d 111, 113, cert. den. 361 U. S. 883; *Hopkins* v. *Waco Products, Inc.*, 7 Cir., 1953, 205 F. 2d 221, 224.

The District Court's decision that the design of the cross ribs was functional and dictated by the limitations of the manufacturing process is fully supported by the evidence. The Trial Judge also had before him prior art which had not been considered by the Patent Office. The Abernathy Mechanical patent (No. 2,332,770, October 26, 1943), the only reference cited, does not show cross ribs. The prior art reflectors listed by the Trial Judge in his Finding of Fact No. 7 do show transverse ribs. Thus the presumption of validity otherwise attaching to a patent was weakened here. *Senco Products, Inc.* v. *Fastener Corp.*, 7 Cir., 1959, 269 F. 2d 33, 34, cert. den. 361 U. S. 932 (1960); *Hobbs* v. *Wisconsin Power & Light Co.*, 7 Cir., 1957, 250 F. 2d 100, 105, cert. den. 356 U. S. 932.

It is the plaintiff's contention that the Trial Court decided the question of validity purely on the premise that certain individual elements in the design were old, and failed to consider the "over-all appearance" with its subtle changes and arrangements of old lines and shapes. We cannot agree.

In *Amerock Corporation* v. *Aubrey Hardware Mfg., Inc.*, 7 Cir., 1960, 275 F. 2d 346, Chief Judge Hastings examined the entire line of decisions in this Court respecting design patents. At page 348 of that opinion, he said:

> It is settled beyond dispute that "[a] design patent, in order to be valid, must disclose a design that is new, original and ornamental, unanticipated and inventive in character, and beyond the skill of the ordinary designer or draftsman." [Citing cases.]

We are satisfied that the District Court applied the proper criteria and correctly found that the design patent in suit was invalid.

This brings us to the question of unfair competition. While the District Judge did not specifically find "secondary meaning" identifying the reflectors with the plaintiff as a source, he did find that the appearance of the C F I-10 has the capacity to identify the plaintiff in the trade and does, in fact, so identify the plaintiff to the trade. He found that concurrent sale of C F I-10 and Mitchell-Dynalite fixture reflectors was likely to cause confusion in the trade, and that actual confusion had occurred. Therefore, although he dismissed the Complaint insofar as patent infringement was concerned, he did find the defendant guilty of unfair competition. He granted an injunction against unfair competition by sale or attempted sale of reflectors identical with or confusingly similar to the C F I-10 or the Mitchell "Dynalite," and ordered an accounting for damages resulting from such unfair competition.

Defendant contends that confusion of purchasers is impossible because those who buy this type of comparatively expensive produce (which is always shipped in clearly marked containers) are skilled, experienced and discriminating purchasers. However, the District Court did find confusion likely, and there is substantial evidence in the record to support that finding. We cannot characterize the finding as "clearly erroneous" and may not set it aside. Federal Rules of Civil Procedure, Rule 52.

The defendant argues that in the absence of a finding of either "secondary meaning" or "palming off," there can be no holding of unfair competition; that the essence of unfair competition is fraud. Defendant relies on statements in the opinion on petition for rehearing in *Day-Brite Lighting, Inc.* v. *Sandee Mfg. Co.*, 7 Cir., 1961, 286 F. 2d 596, 600, and similar expressions from this and other Circuits. In the *Sandee* case, the plaintiff in its petition for rehearing had sought clarification of the decision on the issue of unfair competition, the plaintiff having presumed

that this Court intended to affirm the District Court on the issue of unfair competition, while holding that the patent in suit was invalid and not infringed. In clarification, the opinion on the petition for rehearing stated:

> We realize, of course, that a case of unfair competition may be made, separate and apart from that of infringement. In this case, however, we think the two issues were so closely allied that the former could not prevail in the absence of the latter and that holding the patent invalid and not infringed also disposed of the action for unfair competition adversely to plaintiff.

The opinion on petition for rehearing then cites *Zangele & Peterson Co.* v. *Venice Furniture Novelty Mfg. Co.*, 7 Cir., 1943, 133 F. 2d 266, 269; *General Time Instrument Corp.* v. *United States Time Corp.*, 2 Cir., 1948, 165 F. 2d 853, 854; and *Sinko et al.* v. *Snow-Craggs Corp.*, 7 Cir., 1939, 105 F. 2d 450, to the effect mere copying of the teaching of an invalid patent does not constitute unfair competition. This *was* the law in Illinois. It is not contested that Illinois law governs the case before us.

However, there has been a change in the law of Illinois on this subject, as analyzed by Judge Duffy in his opinion in *Independent Nail & Packing Co. Inc.* v. *Stronghold Screw Products, Inc.*, 7 Cir., 1953, 205 F. 2d 921. After stating the rule promulgated in earlier cases, Judge Duffy continues (at page 925):

> However, we think the rule announced in these cases is no longer the law of Illinois.
>
> In 1942 the Supreme Court of Illinois in *Investors Syndicate of America, Inc.* v. *Edward J. Hughes, Secretary of State*, 378 Ill. 413, at page 422, 38 N. E. 2d 754, at page 759, stated, "Even in injunction cases between competing corporations the trend of decision is to place less emphasis on competition and more on confusion, as is evidenced by the following cases: (citing) 'The test should be whether the public is likely to be deceived'."

The defendant would limit the holding in *Independent Nail* to such "protectable" rights as trademarks. The plaintiff's reflectors, as found by the Trial Court, in findings supported by the evidence, do have the capacity to identify the plaintiff and do so identify the plaintiff in the trade. The capacity of the plaintiff's design to serve the plaintiff in somewhat the manner of a trademark does constitute a "protectable" right.

As noted, several choices of ribbing were apparently available to meet the functional needs of the product. The defendant did not avail itself of the other types but instead chose precisely the same design used by the plaintiff and followed it so closely as to make confusion likely. We are constrained to agree with Judge Duffy's statement in *Radio Shack Corp* v. *Radio Shack*, 7 Cir., 1950, 180 F. 2d 200, 206, as cited with approval so recently as November 21, 1962, in Judge Hastings' opinion in *G. Leblanc Corp.* v. *H. & A. Selmer, Inc.*, Appeal No. 13232-13233: The essence of "unfair competition" is that it be unfair, that "in all cases of unfair competition, it is principles of old-fashioned honesty which are controlling."

We have examined all the arguments advanced by both parties and have concluded that the judgment of the District Court must be affirmed.

AFFIRMED.

UNITED STATES COURT OF APPEALS

For The Seventh Circuit

Chicago 10, Illinois

Friday, December 14, 1962

Before

Hon. John S. Hastings, Chief Judge
Hon. Win G. Knoch, Circuit Judge
Hon. Latham Castle, Circuit Judge

No. 13699

DAY-BRITE LIGHTING, INC.,
Plaintiff-Appellee,

v.

COMPCO CORPORATION,
Defendant-Appellant.

No. 13700

DAY-BRITE LIGHTING, INC.,
Plaintiff-Appellant,

v.

COMPCO CORPORATION,
Defendant-Appellee.

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, AFFIRMED, with costs, in accordance with the opinion of this Court filed this day.

UNITED STATES COURT OF APPEALS

For The Seventh Circuit

Chicago 10, Illinois

Friday, January 18, 1963

Before

Hon. John S. Hastings, Chief Judge
Hon. Win G. Knoch, Circuit Judge
Hon. Latham Castle, Circuit Judge

DAY-BRITE LIGHTING, INC.,
Plaintiff-Appellee,
(Cross-Appellant),
Nos. 13699-13700 vs.
COMPCO CORPORATION,
Defendant-Appellant.
(Cross-Appellee).

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

It Is Ordered by the Court that defendant-appellee's (Compco Corporation) petition for rehearing in the above-entitled matter, as well as petition for clarification, and petition for modification of decision of December 14, 1962, be, and the same are hereby DENIED.

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No. 106

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

COMPCO CORPORATION,

Petitioner,

vs.

DAY-BRITE LIGHTING, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1962

No. 1010

COMPCO CORPORATION,

Petitioner,

vs.

DAY-BRITE LIGHTING, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

To the Honorable Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Respondent Day-Brite Lighting, Inc., opposes the Petition herein for a Writ of Certiorari for the reasons hereinafter stated.

OPINIONS BELOW

The opinions of the Court of Appeals for the Seventh Circuit are correctly set forth in the Appendix to the Petition except for the following clear error. In Petitioner's Appendix, page 3A, 11th line from the bottom of the page,

the sentence reading "We cannot agree with the District Court * * *" should be—"We *must* agree with the District Court * * *". (Emphasis ours.).

QUESTION PRESENTED

The "Question Presented" by Petitioner suggests that this Court should reverse the Court of Appeals and thereby nullify the Illinois law of unfair competition, because it is in some undefined conflict with Federal law on patents. It is submitted however, that the only "Question Presented" is—

Where Petitioner has copied a product which has acquired a secondary meaning, was it not proper for a Court of Equity to enjoin Petitioner even though Respondent was unsuccessful in a second cause of action for design patent infringement.

STATEMENT

Petitioner's statement of the case is inadequate, but can be supplemented by quotations from the opinion of the Court of Appeals for the Seventh Circuit, as follows:

> "In 1954, after complaints of warpage in the reflectors, which caused the porcelain reflective coatings to chip, plaintiff altered its design by extending the cross ribs down the sides of the U-shaped reflector. Although this also presented an attractive appearance, it served to strengthen the reflector. The changed design was embodied in fixtures which the plaintiff began selling in or about October, 1954. There are sold under the name 'CFI-10'. The new appearance of the plaintiff's fixtures was the subject of its Patent No. Des. 176,367, issued December 13, 1955, which plaintiff sought to enforce in this action. Styling is considered important in the industry and such styling does provide product identification which increases salability of products.

In 1955 Mitchell Manufacturing Company manufactured fixtures with reflectors under the names 'Mitchell' and 'Dynalite', which were almost exact copies of plaintiff's CFI-10 design. On or about December 31, 1955, the plaintiff gave notice of infringement to Cory Manufacturing Company, which had then acquired Mitchell Manufacturing Company and was advertising the reflectors. On or about March 9, 1956, defendant acquired certain of the Mitchell assets from Cory, and defendant then manufactured the Mitchell and Dynalite reflectors, using the same advertising and promotional literature put out by Mitchell and Cory." (App. 2a-3a)

• • •

The evidence of infringement presents no substantial issue. We must agree with the District Court that if the plaintiff's patent is valid, it is also infringed." (App. 3a)

• • •

"This brings use to the question of unfair competition. While the District Judge did not specifically find 'secondary meaning' identifying the reflectors with the plaintiff as a source, he did find that the appearance of the CFI-10 has the capacity to identify the plaintiff to the trade. He found that concurrent sale of CFI-10 and Mitchell-Dynalite fixture reflectors was likely to cause confusion in the trade, and *that actual confusion had occurred.* Therefore, although he dismissed the Complaint insofar as patent infringement was concerned, he did find the defendant guilty of unfair competition. He granted an injunction against unfair competition by sale or attempted sale of reflectors identical with or confusingly similar to the CFI-10 or the Mitchell 'Dynalite', and ordered an accounting for damages resulting from such unfair competition." (Emphasis ours.) (App. 5a)

Petitioner has not at any time controverted any of the significant findings relating to unfair competition.

ARGUMENT

The litigation below is a typical case of two separate and distinct causes of action (unfair competition and design patent infringement) in one suit. Each cause of action depending for decision entirely upon its own facts. Since two courts below have unanimously resolved questions of fact and the applicable law in favor of Respondent, the Petition for Writ of Certiorari should be denied.

In view of the Question Presented, there is no validity and/or interpretation of statutes involved; there is no conflict between the decisions of the courts below; and no special and important reasons are presented why the Petition for a Writ of Certiorari should be granted in view of the concurrent findings of fact and conclusions of law by the courts below.

Petitioner asserts two points in support of its Petition which are answered by Respondent in the order presented.

1. Petitioner's first point essentially is that a complainant cannot seek relief for a cause of action under the federal patent laws and in the same suit a cause of action for unfair competition. Petitioner states (Brief p. 5) "Just how the joinder of these actions arose is not clear, but it is clear that it has no sanction either in the statutory law or the decisions of this Court, the last design patent case decided by this Court being *Smith* v. *Whitman Saddle Co.*, 148 U.S. 672 (1892)."

Petitioner is confused and in error both as to the joinders of causes of action and the application of statutory law and decisions of this Court. Respondent's cause of

action arose under the federal laws when its design patent issued. Its common law cause of action for unfair competition began when it introduced its product to the public so that its appearance became sufficiently identifiable as to acquire a secondary meaning to support suits against subsequent competitors who cause confusion in the trade. In the present case, "actual confusion".

The joinder of both of respondent's causes of action were and are sanctioned in a long line of cases of this Court including *Hurn* v. *Oursler*, 289 U.S. 238 (1933); *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111 (1938) and *Mazer* v. *Stein*, 347 U.S. 201 (1954).

Furthermore, Federal Statute, 28 U.S.C. 1338 (b) provides that unfair competition may be joined with a substantial and related claim under the patent laws. The Federal Rules of Civil Procedure suggests a form for joining a federal statutory monopoly (copyright) with a cause of action for unfair competition. (Form 17).

Petitioner cites no case in support of its contention that a party forfeits his rights under the common law when a patent is declared invalid. Petitioner cites no authority that a person must irrevocably choose between the common law and the patent law at some particular time. Indeed, the cases cited by petitioner (Brief p. 8, footnote and p. 9) are authority for precisely the opposite propositions.

Furthermore, this Court, in upholding a statutory copyright claim for 28 years (renewable for a similar period) stated in *Mazer* v. *Stein*, 347 U.S. 201 (1954 at page 217):

> "We do hold that the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art. Neither the copyright statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold."

Certainly a nonstatutory common law right for unfair competition should not be cast in a more unfavorable position. The cases and authority are to the contrary. This reason for granting Petitioner's Writ is wholly unsupportable. Neither does the fact that this Court has not heard a design patent case since *Smith* v. *Whitman Saddle Co.*, 148 U. S. 672 (1892) lend any credence to the Petition.

2. The second reason asserted by Petitioner for granting the writ is that a court of equity is without power or right to issue an injunction, regardless of how reprehensible the conduct of a defendant may be, where a patent right has been or is involved. Petitioner states (Brief p. 5) "The anti-trust laws condemn a monopoly such as granted here, save only as it is within the protection of a lawfully granted patent monopoly. *Sola Electric Co.* v. *Jefferson Electric Co.*, 317 U.S. 173 (1942)."

Again Petitioner has misconstrued the relief granted Respondent, by attaching the heinous tag "monopoly" to the injunction granted to Respondent for Petitioner's palpable deeds of business misconduct which caused *actual confusion* between the products of the parties. As we have pointed out, the subject action does not involve the exclusive application of the federal patent laws. Furthermore, the anti-trust laws are not involved or applicable. The Courts below did not at any time have any question of violation of the anti-trust laws before it and Petitioner's assertion now, together with the "monopoly" label, is merely a belated effort by Petitioner to find some vehicle or compelling reason for granting of the writ.

The cases referred to by Petitioner, as will be more fully pointed out hereinafter, are those dealing with the "expiration" of a patent. That problem is not presented

here inasmuch as a design patent was granted to Respondent in December 1955 and the subject law suit was filed in July 1958. The District Court found Respondent's patent invalid but held that Respondent was entitled to an injunction because of the unfair competitive practices of Petitioner. There is therefore no need to consider or be misled by Petitioner's statement that either "the patentee has benefited from his patent in driving others from the field, as here, or has benefited from the deterrent to others to enter the field because of the patent" (Brief p. 7). Respondent did not have the benefit of his patent monopoly.

If Petitioner's reasoning were followed to its logical conclusion, every injunction issued by a court would be a "monopoly", regardless of the subject matter involved. Further, the law of unfair competition would be completely emasculated where any statutory protection might be sought such as by way of trademarks, copyrights and patents. This novel theory is completely contrary to the decisions of this Court in *Hurn* v. *Oursler; Kellogg* v. *National Biscuit Co.*, and *Mazer* v. *Stein* (*supra*). It also runs directly contrary to statutory law which provides for the joinder of a cause for unfair competition with a cause for patent infringement (28 U.S.C. 1338 (b)).

Petitioner relies upon the case of *Lucien Le Long* v. *Lander*, 164 F. 2d 395 (CA2, 1947) in support of its reasoning which, however, supports the Courts below and Respondent. In that case the Court of Appeals in an action for unfair competition based upon a perfume bottle, filed after the design patents thereon had expired, found sufficient differences in appearance between the bottles so as to preclude confusion by reasonably prudent purchasers. Furthermore the Court stated that the "plaintiff may prevail only if it proves that its style of bottle has ac-

quired a secondary meaning". The Court also differentiated between expired patents and those patents which have been held invalid and stated "If in return for the statutory monopoly or a term the patentee is held thereafter to dedicate his invention to the public, it would naturally follow that where he had never had this monopoly he has nothing to give up. The situation is one where no patent has ever existed" (p. 398). Based upon this Court's statements a cause of unfair competition is available if "secondary meaning" is shown (even after the expiration of the patent monopoly) and a patentee whose patent has been declared invalid has not had the benefit of the so-called "monopoly".

Petitioner's concluding quote on page 9 of its brief is not a direct quote by the Court in *The Hygienic Specialty Co.* v. *H. T. Salzman, Inc.*, 302 F.2d 614, 619 (C.A. 2 1962) but is a quote by that court of the case of Judge Medina in *American Safety Table Co.* v. *Schreiber*, 269 F.2d 272. Despite this lifted portion from the context of Judge Medina's decision, Judge Medina did grant injunctive relief and damages for defendant's unfair competition; even though the Court did find a patent invalid.

In the *Hygienic* case, the Court found on the merits that the design patent therein was invalid and that the plaintiff was also not entitled to relief for unfair competition, because the facts did not support such a cause of action. The court did state, however (p. 619): "On the other hand, competition must be 'fair' both to the consumer, and so far as possible, to the trade. Consumer protection has been limited (in this context) to the prevention of confusion, *i.e.*, the customer should not be misled into purchasing an article from one producer in the belief that it was made by some one else or emanates from some other (but

unidentified) source." This is precisely the application of Illinois law granted Respondent by the Courts below where "actual confusion" occurred.

The decision in *Goodyear Tire and Rubber Co.* v. *Robertson*, 18 F. 2d 639, 641, merely stands for the proposition, upon the facts in that case, that a design patent did not operate as a trademark. We do not have that proposition before this Court.

The decision in *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111; 59 S.Ct. 109, has been much relied upon by defendants sued for design patent infringement. While the pillow shaped form of the "shredded wheat" biscuit was covered by a design patent the patent was declared invalid and the dispute between the parties therefore resolved itself into a matter of avoiding confusion in the market place. The court found that defendant Kellogg was free to use the pillow shaped form subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff. The Court stated at page 120:

> "The question remains whether Kellogg Company in exercising its right to use the name 'shredded wheat' and the pillow shaped biscuit, is doing so fairly. Fairness requires that it be done in a manner which reasonably distinguishes its product from that of the plaintiff."

The decision in *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U.S. 249 (1945), stands for the authority that a patentee may not recapture any part of the patent monopoly after expiration of a patent, since the law dedicates to the public the subject matter embodied in expired patents. The case at bar did not involve an expired patent, nor does it involve extension of patent monopoly.

Sola Electric Company v. *Jefferson Electric Company*, 317 U.S. 173 (1942) involved a question of whether a patent licensee is estopped to challenge a price fixing clause in the license agreement by showing that the patent is invalid. The Court concluded that local rules of estoppel will not be permitted to thwart the purposes of statutes of the United States. The facts of this case are obviously different from the case at bar.

The citation of *Stiffel Co.* v. *Sears Roebuck & Co.*, 313 F.2d 115, only reaffirms the decisions by the Court of Appeals for the Seventh Circuit that they will find a Defendant guilty of unfair competition, even though a patent may be involved, where the "principles of old fashioned honesty" are not found. *Radio Shack Corp.* v. *Radio Shack*, 180 F.2d 200, 206 (CA7, 1950). The Court of Appeals also repeated the holding of the Court of Appeals in the case at bar and pointed out that proof of "palming off" or "secondary meaning" is no longer required by the Illinois law, so that likelihood of confusion is all that is required. (Although actual confusion was found in the present case) In both the *Stiffel* case and the case at bar the Trial Court found evidence to support unfair competition and the Court of Appeals for the Seventh Circuit agreed.

No sound or logical reason has been asserted for applying the anti-trust laws to the subject matter of the cause herein. Certainly not by calling Respondent's "injunction" a "monopoly". A Court of Equity should not be so shackled or hamstrung, nor should misconduct be allowed to run rampant in the market place, by emasculating the common law right of unfair competition whenever a patent is present. The anti-trust law requires no such application and none is contemplated by decision or statutory law.

CONCLUSION

What Petitioner is erroneously trying to accomplish in this case is:

a) Reverse the sound holding of the Courts below and perpetuate tortious activity in cases of unfair competition by obtaining a ruling that "principles of old-fashioned honesty are no longer controlling".

b) Obtain exclusive federal jurisdiction for tortious acts of unfair competition and remove it from the realm of state law in spite of the long recognized decision that the federal courts must recognize local law under *Erie* v. *Tompkins*, 304 U.S. 64, and *Hurn* v. *Oursler*, 289 U.S. 238.

c) Obtain by judicial decision what is not in the statutory law, namely, that unfair competition is a matter completely subject to federal jurisdiction and statutory law.

There is no basis for the petition and the same should be denied.

Respectfully submitted,

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No. 106

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963.

COMPCO CORPORATION,
Petitioner,

vs.

DAY-BRITE LIGHTING, INC.,
Respondent.

BRIEF FOR PETITIONER

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IN THE

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OCTOBER TERM, 1963.

No. 106

COMPCO CORPORATION,

Petitioner,

vs.

DAY-BRITE LIGHTING, INC.,

Respondent.

BRIEF FOR PETITIONER

OPINION BELOW

The findings of fact, conclusions of law and judgment order (R. 297-303) of the District Court of the United States for the Northern District of Illinois were entered without opinion. The opinion of the United States Court of Appeals for the Seventh Circuit (R. 323) is reported at 311 F. 2d 26.

JURISDICTION

This Court's jurisdiction is founded under 28 U.S.C. 1254(1).

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

Article I, Section 8, clause 8, provides:

> "The Congress shall have Power To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . ."

Article VI, clause 2, provides, in pertinent part:

> "This Constitution and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding."

The statutes involved include the pertinent sections of the Patent Act of 1952, Title 35 U.S.C.:

> "171. Patents for Designs.
>
> Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this Title.
>
> "The provisions of this Title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.
>
> "154. Contents and term of patent.
>
> Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of 17 years, of the right to exclude others from making, using or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of

the specification and drawings shall be annexed to the patent and be part thereof.

"173. Term of Design Patent.

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

"281. A patentee shall have remedy by civil action for infringement of his patent."

Also involved is 28 U.S.C., Section 1338:

"(a) The District Courts shall have original jurisdiction of any civil action arising under any act of Congress relating to patents . . .

"(b) The District Courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent or trademark laws."

QUESTIONS PRESENTED

1. Is the freedom from confusion required by the Illinois law of unfair competition more important than the freedom of competition required by the United States patent and anti-trust laws so as to justify enjoining the selling, in properly marked containers, of the precise light fixtures of an invalid design patent?

2. Whether a longer reinforcing rib which is merely structural and functional, lacking in ornamental distinctiveness, can be raised to the level of a trade symbol under the guise of unfair competition to grant the maker a permanent monopoly?

3. Whether there can be unfair competition in design duplication without first a showing of (a) a second mean-

ing to the purchaser of that specific design, and (b) likelihood of actual purchaser confusion as to the source of the product?

4. Where a manufacturer elects to obtain a design patent on an industrial product and operates with the benefit of the patent although the patent is later invalidated, can the mere copying of the design give rise to a cause of action under the common law of unfair competition without (a) violating the doctrine of federal supremacy which requires that the federal patent and anti-trust laws supersede any conflicting state law, and (b) producing the anomalous situation that the subject matter of an invalid design patent can be freely used by competitors in most of the United States but not in Illinois?

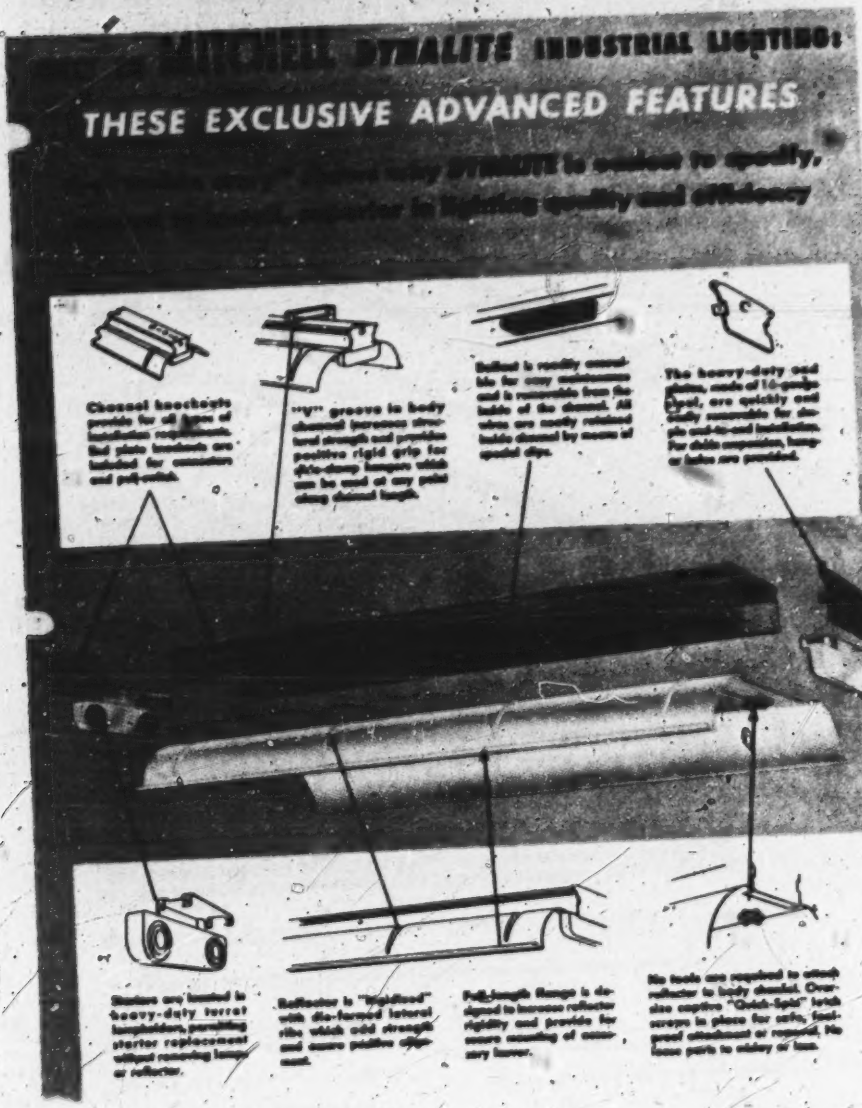
STATEMENT

1. Generally

In July, 1958, respondent Day-Brite Lighting, Inc. sued petitioner Compco Corporation for infringement of design patent 176,367 covering only the *reflector* portion of a fluorescent light fixture. Coupled with the claim of patent infringement was a claim of unfair competition for making and selling the same reflector.

2. The Product Involved

Day-Brite's real complaint is against the sale of fluorescent lighting fixtures by Compco, the reflectors never being sold separate from the complete fixture (R. 204-205). The picture below is of the accused fixture (Pl. Ex. 36, R. 223) — Mitchell being the predecessor of Compco.



The fixtures, including the reflector of the design patent, are intended for ceiling installation and are standardized at lengths of 48", 72" or 96", being made up of a housing, a ballast (transformer), a reflector, and the sockets and wiring for the long lighting tubes. The fixture is sold as a unit, complete for installation. The invalid design patent has to do only with the reflector, which is sandwiched between the housing above and the light tubes below (R. 205). The picture opposite is of the invalid design patent (Pl. Ex. 1; R. 23; 54).

United States Patent Office

Des. 176,367
Patented Dec. 13, 1955

176,367

REFLECTOR FOR TUBULAR LAMP LIGHTING FIXTURES

Carl E. Mayer, St. Louis County, and Lee G. Robillard, Kirkwood, Mo., assignors to Day-Brite Lighting, Inc., St. Louis, Mo., a corporation of Missouri

Application January 17, 1956, Serial No. 34,627
Term of patent 14 years
(Cl. D48—39)

FIG. 1

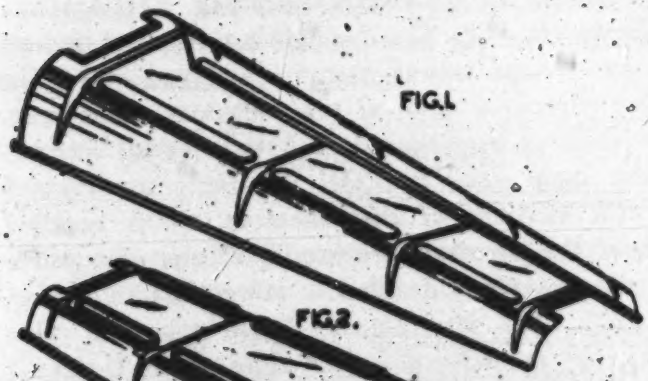


FIG. 2.

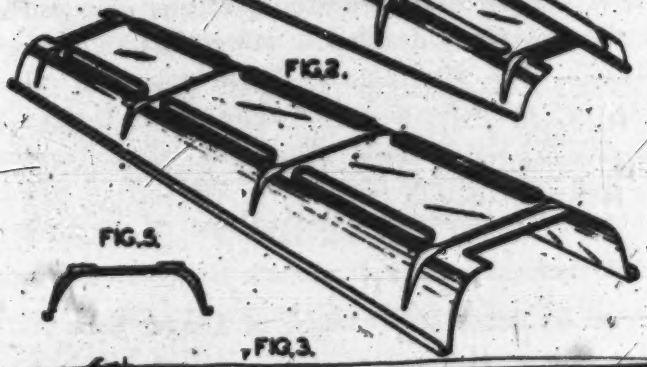


FIG. 5.

FIG. 3.

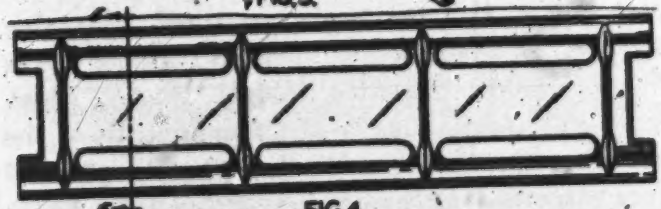


FIG. 4.

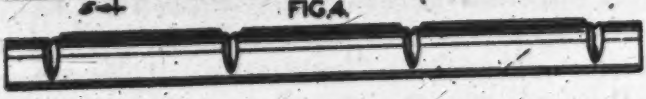


Fig. 1 is a perspective view, as seen from below, of the reflector for tubular lamp lighting fixtures, showing our new design.

Fig. 2 is a perspective view, as seen from the top, of the same.

Fig. 3 is a top plan view of the reflector shown in Fig. 1.

Fig. 4 is a side elevational view of the reflector, and

Fig. 5 is a sectional elevational view of the same as seen along line 5—5 in Fig. 3.

We claim:

The ornamental design for a reflector for tubular lamp lighting fixtures, substantially as shown.

References Cited in the file of this patent

UNITED STATES PATENTS

2,332,770 Abernathy ..... Oct. 26, 1943

3. Product Background

The fluorescent light fixtures involved here are of the "uplight" type. The reflectors have elongated slots so that the light from the tubes can be directed upwardly against the ceiling, as well as downwardly—to eliminate shadows and unlighted areas. This particular type of fixture became popular in the early 1950's and was marketed by a number of companies, including Westinghouse and Day-Brite (R. 83). The "uplighting" type of fixture marketed by various manufacturers employed cross ribs between the elongated slots of the reflectors. The housings were alike in appearance, and the overall fixtures were of the same size. In 1954, Day-Brite experienced difficulty with warpage of the reflectors, which resulted in chipping of the porcelain coating. Customer complaints were received, so it was decided to strengthen the reflector (R. 31-32). This was done by lengthening the cross ribs so that they extended down the sides of the U-shaped reflector to correct the warping. Thus, the *only* difference between Day-Brite's earlier fixture and the CFI-10 which included the design patented reflector, was in the longer ribs (R. 89).

4. Trial Evidence on Function of Longer Ribs

The trial Judge had the background and reasoning behind this change explained in detail. Testimony was given by five technical witnesses, Hodges, Blazey, Kaeppel, Hammer and Gearing, as to the functionality of the rib design (R. 100, 165, 192, 243 & 262). Hodges and Blazey were witnesses retained by Day-Brite, while Kaeppel and Gearing were Day-Brite's employees involved in the original engineering and production. Hammer was Compco's witness. The District Court Judge entered a specific finding to summarize all of this testimony on why the cross ribs were lengthened:

"15. The function of the cross ribs in the reflector is to strengthen and stiffen the reflector against warp and twist, to fix the spacing of the side surfaces in fixed relationship, to minimize distortion and warpage due to the heat of porcelain enameling process and thereby prevent the chipping of the porcelain enamel finish after cooling." (R. 299)

This finding was followed by yet another finding dealing with the precise character of the rib upon which the design patentability was based:

"16. The design of the cross ribs, particularly the size, shape and length, is dictated by the limitations of the manufacturing process." (R. 299)

This was specifically considered and affirmed by the Court of Appeals for the Seventh Circuit (R. 325-326).

Day-Brite recognized the importance of the strengthening character of the ribs by filing a mechanical patent application which used drawings identical to those in the design patent. In an effort to obtain favorable action on the mechanical application, Day-Brite's President presented an affidavit stating that the increased sales of the fixtures resulted from the correction of the faults of Day-Brite's prior art unit:

"(In the Day-Line, there was) an excessive rate of factory rejects attributable to warpage of the reflector unit during burning of the coating and chipping of this coating in the packages . . . (When the ribs were extended, there was increased sales) which to Day-Brite indicated correction of the faults found in the Day-Line units and customer acceptance of the CFI." (Parenthetical words added) (R. 322).

Notwithstanding an extensive prosecution of the mechanical application, it was abandoned after the Examiner's final rejection was affirmed by the Board of Appeals of the Patent Office.

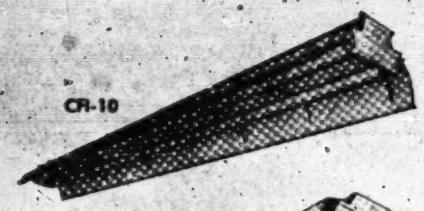
The strengthening character and Day-Brite's reliance on it is seen in its advertisement reproduced opposite (Def. Ex. O-2; R. 44, 234), which the trial court Judge recalled:

> "Mr. Mullin: No. Now we are going into the admissions by the Plaintiff that the ribs are for strengthening purposes or functional. That also we have some marks on that the Court may see the particular pertinent parts.
>
> Mr. Ooms: We have already had testimony on it counsel.
>
> Mr. Mullin: This is Defendants' Exhibit O-2.
>
> The Court: This is the 380 pounder?
>
> Mr. Mullin: Yes." (R. 234)

Here's a rugged test for any reflector. Supported only at the ends, the 8-foot CFI-25 reflector supports the weight of a 658-pound man—no sag, no spread, it remains rigid.

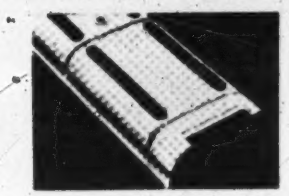
When you buy Industrial Lighting, look for...

STRENGTH!

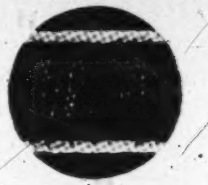


Industrial lighting, besides providing good illumination for a great variety of production seeing tasks, must be constructed for maximum strength. Like presses, lathes and other tools of industry, factory lighting requires ruggedness. CFI* Industrial Fixtures are especially designed to withstand the rigors of factory installation because each component part is engineered for strength and durability. Heavy-duty steel, die-forming, and a lifetime finish of porcelain enamel on each reflector are just a few of the many features which make CFI the best lighting for industrial use everywhere.

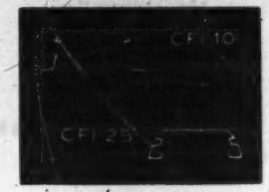
STRENGTH-DESIGNED CFI IS YOUR BEST LIGHTING BUY



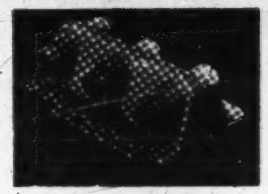
All CFI reflectors are reinforced by die-embossed ribs located between the apertures. Ribs are a Day-Brite *First*, to add lateral stability to prevent the reflector from spreading, help maintain straight fixture edges. Apertures are die-embossed too, for increased reflector rigidity.



Lifetime vitreous porcelain enamel is used as a finish on all CFI reflectors. As shown in the microphoto, rocklike minerals are actually melted and fused to the base metal under extremely high temperature to form a glasslike, snow-white surface with a reflection factor of 85% or more. Porcelain enamel does not decay nor change with age and is unaffected by time, heat, moisture or other harmful elements.



Truslike CFI channel is all steel, die-formed, and features a ribbed top section so that sliding clamp hangers may be positioned anywhere along the run. All units are equipped with CBM Certified ballasts and are individually wired for single unit or continuous installations. Approved by Underwriters' Laboratories. Engineered to deliver a *Lifetime* of service.



CFI-10 sockets like the ones shown above are metal clad, for positive alignment and protection against breakage. Heavy-duty spring-loaded sockets are a feature on all CFI units. Push-pull type sockets assure firm lamp contact for positive lamp operation, firm seating to eliminate possibility of lamp falling out because of vibration.

Don't forget these added CFI features:

- A choice of the CFI-10 or the CFI-25. 10% or 25% Uplighting, according to your needs.
- Full 8-foot one-piece reflectors.
- Sections for 8-foot Slimline lamps, 4-foot Rapid-Start lamps and 8-foot High-Output Rapid-Start lamps.
- A full line of Day-Brite hanging devices including A-J Adjustable or Twin-Stem hangers, the Hydee hanger, messenger cable clamp, ice tong or chain hangers.

* means Comfort For Industry.

5. Activity Prior to the Patent

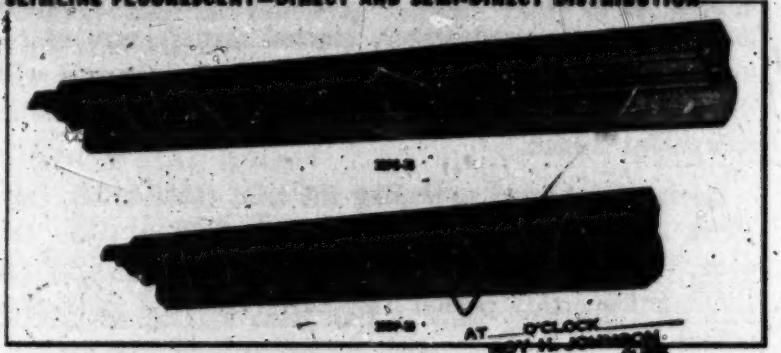
The design patent was invalid in not possessing the requisite ornamentality. The prior art undisclosed to the Patent Office had every element of the reflector design in suit (R. 299). Typical of the prior competitive fixtures is the Westinghouse fixture shown in the advertisement reproduced opposite. (Def. Ex. L; R. 44, 232).

The Court recognized that the Day-Brite reflector was old and not an inventive step forward in the art:

> 7. The DayBrite CFI DayLine reflector, comprising an arcuate reflector with uplight slots and ribs across the top (Def. Exh. 4), the Guth Mazelite reflector with ribs extending down into the sides of the reflector (Plf. Exh. 6), the Guth catalog nos. 44, 44a and sheet no. 889-151 showing the Guth Mazelite and Quick-liter reflectors (Def. Exhs. E, F and G), and the Westinghouse catalog section 61-230, pages 11-14, dated September 1, 1953, and showing Westinghouse fixture type 2 SDP-58 reflector with uplight slots and cross ribs extending across the top of the reflector between adjacent uplight slots (Def. Exh. L), comprise prior art which plaintiff did not disclose to the Patent Office until after the design patent in suit had been issued.
>
> 14. The prior art disclosed reflectors of arcuate cross-section with uplight slots encircled by upstanding flanges, and cross ribs, some extending down into the slides of the reflector. Every element of the reflector design in suit is disclosed in the prior art.
>
> (R. 298, 299)

SPG AND SSP DESIGN • **81-230**

SLIMLINE FLUORESCENT—DIRECT AND SEMI-DIRECT DISTRIBUTION



WESTINGHOUSE SPECIAL FEATURES

- **LENS-LAR BALLAST**—Remove full rated lamp life, eliminate shield about lamp terminals, provided maximum electromagnetic cancellation.
- **ONE PIECE CHANNEL**—Assures rigidity and minimum number of mechanical connections. One channel type for normal or attachment row mounting.
- **EASY INSTALLATION**—Completely wired luminaires are factory-assembled and thus operations made before suspension are added. Provision for variety of mounting methods.
- **HEAVY DUTY LAMPHOLDERS**—Steel enclosed shockless bendings. Push pull principle for easy lamp replacement, removable threaded grommets maintaining high voltage. Lamps locked in by designed spring locked contacts.
- **REMOVABLE REFLECTORS**—Lamps spring locked using leads many ends of each reflector requires only quarter turn to release reflector. No loose parts to handle, and no tools required to install or remove reflector.

INDUSTRIAL SLIMLINE LUMINAIRES are designed to operate 4', 6', and 8' T-12 Slimline lamps at 430 ma and are available in the following types:

TYPE	MOUNTING	LENS FINISH			
		WL	WR	WAFFLE	PRIS
DIRECT DISTRIBUTION					
SEMI-DIRECT DISTRIBUTION					

DAYBRITE VS. COMPCO STUDY

DEPT'S. EXH. L

COMPLETE LUMINAIRE—Consists of a channel assembly and reflector or reflectors. Necessary end plates and connectors must be ordered separately.

CHANNEL ASSEMBLY—One piece, formed steel channel with ballasts and lampholders wired. Design incorporates provisions for several types of mounting. Combinations "A" groove in each side provides shielding permitting accessory of any point along channel length. Ballasts are Lens-Lamp lead-free HAM factory ballasted, [illegible] type. [illegible] equipped with UL Rated.

REFLECTORS—Formed steel with white enamel and reflecting diffusing surface. Reflectors are 4 [illegible] and 8 [illegible] and are plain [illegible] rounded ends. Reflectors are 8 foot lengths are composed of two 4' sections ready with easy assembled and are separated end. Two alignment clips supplied with 8' luminaires to align butt joint of the two sections. Reflectors are easily fitted with provided equivalent arrangement of every 20 ft.

LAMPHOLDERS, SOCKETS—Are lampholders as designated—to be formed from steel to a [illegible]

LAMPS—Not included. Requirements in table.

ACCESSORIES—Hangers and clamps for outlets, suspension, wire support cables, or chain mounting (listed below). 3 and 5 wire feeder cord and plug sets, chain sets, [illegible] and ordering information in Catalog Section SL-230, page 10.

Dept's Ex 60 L

6. Day-Brite's Aggressive Use of the Patent Against Others

The design patent issued December 13, 1955, Day-Brite having been in production of the new fixture for about a year previous to this. Mitchell Manufacturing Company, Compco's predecessor, started manufacture of the longer-ribbed fixture early in 1955 and was charged with infringement on December 31, 1955—just a few days after the patent issued.

During the period preceding the trial (1955-1960), Day-Brite increased in leadership in this field, sharing this with Westinghouse, Sylvania and General Electric (R. 123). During this period Day-Brite enforced its design patent against:

Planned Lighting, Inc., Philadelphia, Pa.
Ender Monarch Corp., Long Island, N. Y.
Harvstone Mfg. Co. Inc., Chicago, Ill.
All Bright Fluorescent Fixtures, Inc., San Francisco, Calif.
Gibson Mfg. Co., Atlanta, Ga.
Wm. Penn Fluorescent Co., Philadelphia, Pa.
Globe Lighting Products, Inc., New York, N. Y.
Ruby Philite Corp., Long Island, N. Y.
Smoot-Holman Company, Inglewood, Calif.

and others subsequent to the filing of this suit (R. 110-112). This was recognized by the trial court as follows:

> "22. Within several years after plaintiff came on the market with its CFI-10 reflectors, a large number of competitors were offering fixtures with reflectors having the overall appearance of plaintiff's CFI-10 reflector design." (R. 301).

7. Unfair Competition Evidence

Purchasers were not confused, there being no *customer testimony* on the question of unfair competition, and very little from the witnesses who were there, as can be appreciated from the following colloquy right at the outset of the trial (R. 52):

> "The Court: I understand the crux of this litigation is the patentability and the prior art of the, you call it what, design?
>
> Mr. Ooms: Design patent.
>
> The Court: How much time would be saved if we tried that issue alone?
>
> Mr. Ooms: I think that is what the primary issue will be in this case, and I think practically all our time will be directed to that.
>
> The Court: All right."

Then, after the trial was over, right after both sides had rested their cases, the trial Judge, with the testimony fresh in mind, engaged in the following conversation (R. 294):

> "The Court: . . . you are touching, also, upon the question of unfair competition.
>
> Mr. Kraus: We have no proof here.
>
> The Court: *I haven't gone into that phase of it.* I haven't heard any arguments on it. I don't know how much unfair competition has been proven or disproven—hardly any, because I do know that there are numerous other companies on the market making it, some in suit, some not in suit, some who have been sued and some who have discontinued it . . ." (emphasis supplied)

The witnesses mainly were employees of the parties. One of Day-Brite's sales engineers said that a distributor asked him to service some defective fixtures in a local plant that had both types of fixtures, and that he found

some defective Compco sockets (R. 66). A consulting industrial designer employed by Day-Brite said that purchasers could be confused (R. 181). On the other hand, Thomas Humphreyville, manager of interior lighting and engineering at Westinghouse, in testifying for Day-Brite, stated that the usual customers could distinguish between the two products (R. 78, 88). Humphreyville had previously testified for Day-Brite in another light fixture case, *Day-Brite Lighting, Inc. v. Sandee Manufacturing Co.*, 286 F. 2d 596 (CA 7, 1961); cert. den. 366 U.S. 963 (1961).

One of the applicants for the patent in suit, in talking about the commercial acceptance of the Day-Brite fixture, stated (R. 120):

> "Well, we felt that we had gained an identity with our product design. We felt that we had lost it in 1958, due to all of the people with similar design reflectors, so that we had dissolution of identity."

The testimony, other than the opinion testimony on whether or not customers would be confused, was unanimous and uncontradicted in that the fixtures were sold to well-informed, discriminating buyers such as contractors and purchasing agents (R. 82, 204). Further, the units sell for upwards of $20 apiece, and orders range from a dozen to hundreds or thousands of units (R. 206). Further, Compco's product was clearly marked, bearing petitioner's identifying red logo (R. 210).

SUMMARY OF ARGUMENT.

The argument is presented in the light of the three aspects of the principal question: (1) anti-trust; (2) design patent; and (3) unfair competition.

The monopoly sought by Day-Brite is on a functional or strengthening feature of the reflector. Historically, the only monopoly available for a structural improvement was a mechanical patent—here such a patent was denied by the Patent Office, the denial being affirmed on appeal to the Board of Appeals. In such a case, the improvement is available to all, and throttling of competition in this improvement is contrary to the basic philosophy of the anti-trust laws.

By electing to obtain a design patent on merely lengthening the ribs, any unfair competition ground for relief was waived, since the precise features which make for design patentability—the uniqueness or ornamentality of design—have to be relied upon in a suit for unfair competition. And when a patent expires, the subject matter (the ornamentation) is available to all—holding otherwise would say that the federal laws are not supreme in an area clearly reserved to the federal government by the Constitution.

The Illinois law of unfair competition, notwithstanding its objective of eliminating confusion, still requires that the thing attempted to be monopolized, point to a single source, *i.e.*, possess "secondary meaning". When this is present, a monopoly is justified since the mark or symbol represents the good will of the maker, the "probability that the old customers will resort to the old store." Here, the strengthening ribs do not even meet the requirements of the Illinois law of unfair competition, since (1) the clear labeling of the products constitutes a superior mark

pointing to different sources; and (2) a large number of manufacturers all make the same product having elongated ribs, so that it was impossible for a customer to use any symbology connected with the longer ribs to think in terms of only a single source.

Disregarding the underlying purpose of the anti-trust laws to promote competition, and further disregarding the rule of federal supremacy which requires giving to the public that which is no longer patented, and still further disregarding the need for clear showing of secondary meaning in a product design, yields a permanent monopoly that affects every segment of the economy:

a. The Judiciary now has to decide whether a structural change has sufficient aesthetic properties to attribute a source identification to the goods rather than comparing the patented article with the prior art.

b. The Bar now, to determine whether liability will result, has to investigate the generally unascertainable marketing practices of a patentee rather than looking to the readily available patent and prior art.

c. A competitor of the patentee cannot now challenge the validity of a patent by marketing the identical structure covered, notwithstanding careful identification so that there is no passing off.

d. The public in general is deprived of competition which tends to drive the price down while maintaining the quality high.

ARGUMENT

I. Anti-Trust Aspect.

This case deals with a court-created monopoly in an *industrial* product, and the question is whether this monopoly is consistent with Federal law. On questions of monopoly, the Federal anti-trust laws are absolutely controlling. Chief Justice Hughes remarked that the Sherman Anti-Trust Act:

> "as a charter of freedom . . . has a generality and adaptability comparable to that found to be desirable in constitutional provisions." *Appalachian Coals, Inc.* v. *United States*, 288 U.S. 344, 359 (1933).

The general objective of the anti-trust laws is the promotion of competition in the open market.[1] The competition fostered by the anti-trust laws "keeps the game honest." Otherwise the public can suffer through the manufacturer's power to raise the price or lower the quality of the monopolized product. *Standard Oil Co.* v. *United States*, 221 U.S. 1, 52 (1910); *Northern Pacific Co.* v. *United States*, 356 U.S. 1, 4 (1958).

The only exception is the constitutionally based patent right, and even this is strictly confined. *United States* v. *Loew's, Inc.*, 371 U.S. 28 (1962).

Patents are justified as exceptions to the all-pervasive inquiry of the anti-trust laws only because the monopolies created thereby are reasonably limited in both time and scope. At the very outset, this policy was established that the grant to the inventor of the exclusive right for a limited time is in consideration of the benefits which the

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[1] *Report of the Attorney-General's National Committee to Study the Anti-Trust Laws*, March 31, 1955, page 1.

public will derive from the invention after the expiration of the term. *Grant, et al* v. *Raymond*, 6 Pet. (U.S.) 218, 241-242 (1832).

Here, a mechanical patent was refused, yet a perpetual monopoly on the precise product was granted. The longer ribs in the product make the reflector stronger—better able to resist warping even when cheaper, lightweight metal is employed.

The only type of monopoly available on such a structural improvement is through a mechanical patent. A mechanical patent justifies the limited life of the twin evils of monopoly, since there has been a meritorious contribution to the mechanical arts.[1] Here, the Patent Office Board of Appeals approved the Primary Examiner's holding that the improvement was not the kind to merit even the limited monopoly.

There is no doubt that Day-Brite itself recognized functional aspect by filing for a mechanical patent, and Day-Brite's advertising emphasized the strengthening features of the longer rib design (see page 11 of this brief).

In the instant case, the approval of Day-Brite's unlimited monopoly will have the effect of driving numerous small competitors out of the business. As such, it is distinctly contrary to the underlying principles of anti-trust

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[1] "The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures." *Atlantic Works* v. *Brady*, 107 U.S. 192, 199 (1882).

law set forth in *Brown Shoe Co.* v. *United States*, 370 U. S. 294, 344 (1962):

> "It is competition, not competitors, which the Act protects. But we cannot fail to recognize Congress' desire to promote competition through the protection of viable, small, locally owned businesses."

Compco was not one of the leaders in the field, nor were the other companies already driven from the field by Day-Brite's patent leverage when the design patent was still in effect. In fact, none of the small competitors driven out of the business by Day-Brite was a leader in the "Twelfth Biennial Brand Preference Study" (Pl. Ex. 2, R. 39, 125) which was introduced to demonstrate commercial success of the Day-Brite construction.

If Day-Brite is not checked by this Court, there is the danger that all that is needed to buy a monopoly is a large budget for advertising and litigation. The trial court recognized how Day-Brite had "bootstrapped" itself into a dominant position (R. 301):

> "23. . . . plaintiff has introduced no evidence showing that its commercial success was the result of the design in suit rather than of its functional improvements or plaintiff's advertising and marketing efforts."

Further, Day-Brite has no recourse to the doctrine of unfair competition, since this doctrine is based on features opposite to structural features, namely, ornamental, artistic or distinctive features. Where a product is superior because of a functional or structural feature, customers buy it because of that—because it is a better (here, a stronger) product. Thus the motivation for the purchase is not the manufacturer, but the superiority of the product. In this case, therefore, there is no right possessed by the manufacturer on which to sue.

"Unfair competition is not established by proof of similarity of form, dimensions or general appearance alone. Where such similarity consists in constructions common to or characteristic of the articles in question, and especially where it appears to result from an effort to comply with physical requirements essential to commercial success, and not to be designed to misrepresent the origin of such articles, the doctrine of unfair competition cannot be successfully invoked to abridge the freedom of trade competition." *Marvel Co.* v. *Pearl*, 133 Fed. 160, 161-2 (CA 2, 1904); quoted with approval in *West Point Mfg. Co.* v. *Detroit Stamping Co.*, 222 F. 2d 581, 591 (CA 6, 1955).

Here what was used by Compco was the idea of the longer reinforcing rib, not the exact rib itself (R. 208-209).

Because of the evils attendant on monopolies, no industrial product monopolies are tolerated by the antitrust laws except those limited monopolies permitted under the patent laws. Thus, there is no right to a monopoly on a structurally improved product under the common law of unfair competition.

II. Design Patent Aspect

Day-Brite thoroughly enjoyed its patent monopoly and, according to the long-established law, is obliged to turn the patented matter over to the public. Patent enjoyment: three suits were filed on the design patent, and at least six other manufacturers were threatened with suit. Some of these manufacturers, under the threat of suit, discontinued the manufacture, while others changed their construction, going to expensive retooling of dies. All of this competitor oppression was done under the design patent.

During the period the patent was in effect, Day-Brite completely ignored its alleged common law right of unfair competition, relying on the patent to threaten competitors. There was sole reliance on the patent, with distinct benefits to Day-Brite. Once having made its election and having enforced the patent against all these competitors, Day-Brite cannot wipe the slate clean. It cannot ask for relief, under the guise of unfair competition, for an act that would constitute only design patent infringement—now that the patent is finished.

> ". . . Any attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, *whatever the legal device employed*, runs counter to the policy and purpose of the patent laws." (Emphasis supplied) *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U.S. 249, 256 (1945).

In the instant case, Compco's predecessor started manufacturing the accused reflectors early in 1955 and for the space of almost a year was unchallenged by respondent Day-Brite. A challenge was only sent after the design patent issued. If unfair competition is to exist, it exists at the very beginning of competitive manufacture and the cause of action must accrue at that time.

If a cause of action for unfair competition did not lie prior to the issuance of the design patent, the patent could not create it. Rather, the issuance of the patent destroyed any claim for unfair competition, since a design patent is granted only for the ornamental, *i.e.*, identifying, nonfunctional features of a product—those identical features which are relied upon in an action for unfair competition. Here, therefore, Day-Brite elected to obtain shorter but surer coverage than that available through the doctrine of unfair competition.

But, disregarding, for the sake of argument, the fact that the structural nature of the improvement absolutely precludes resort to unfair competition law, there is another basis for refusal of the monopoly: failure to rely on the unfair competition cause of action prior to design patent issuance constitutes an absolute waiver of that right.

The decisions of this Court on patents hold that, upon expiration of a patent, the subject matter is free for the public to use. In *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111 (1938), the design patent on the Shredded Weat biscuit was held *invalid*, this Court saying at pp. 119-120:

> "Upon expiration of the patent, the form as well as the name was dedicated to the public . . . The Kellogg Company was free to use the pillow-shaped form, subject only to the obligation to identify its products lest they be mistaken for that of plaintiff."

Here, the product is distinctively packaged and marked, and this was specifically noted by the Court of Appeals below (R. 327):

> "Defendant contends that confusion of purchasers is impossible because those who buy this type of comparatively expensive product (which is always shipped in clearly marked containers) are skilled, experienced and discriminating purchasers." (See also Finding 11, R. 299)

This is all that is required to meet the standard laid down by this court in the *Kellogg* case. Aside from the requirement that a competitive product be marked suitably, the respondent manufacturer has no right left in the product since the expiration of the patent automatically terminates all rights to exclusivity. The language of this Court in 1895 could not be more explicit:

> "It is self-evident that on the expiration of a patent the monopoly created by it ceases to exist and the right to make the thing formerly covered by the patent becomes public property. *It is upon this condition that the patent is granted.* It follows that as matter of course that, on the termination of the patent, there passes to the public the right to make the machine in the form in which it was constructed during the patent." (Emphasis supplied). *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U.S. 169, 185 (1895).

Later this court went even further in defining the rights accruing to the public upon the expiration of a patent, saying in *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U.S. 249, 256 (1945):

> "By force of the patent laws, not only is the invention of a patent dedicated to the public upon its expiration, but the public thereby is entitled to share in the good will which the patentee has built up in the patented article or product through the enjoyment of his patent monopoly. Here we have held that the patentee may not exclude the public from participating in the good will or secure, to any extent, a continuation of his monopoly by resorting to the *trademark law* . . ."

Day-Brite here grasped for any straw to get a monopoly—first a mechanical patent, then a design patent, and finally unfair competition. In the trial court, Day-Brite limited the evidence to the design patent, the trial judge remarking at the end of the trial:

> "I haven't gone into that phase of it (unfair competition)." (Parenthetical remarks added). (R. 294)

When the design patent failed, Day-Brite shifted ground—saying that the longer, stronger rib had a *trademark* quality and that this was justification for extending the patent monopoly.

What is sought for here is in distinct contradiction of all this well-established federal policy so clearly set forth in the *Scott* case, since the injunction granted is in perpetuity and covers reflectors "identical to or confusingly similar to plaintiff's reflector" (R. 303). Holding the unfair competition law superior to the patent law not only gives a longer monopoly on the particular product in question, but extends this monopoly through a wide range of products *not even contemplated* in the first instance by the monopolist.

This mischief is avoided by holding that the expiration of a patent ends the limited product monopoly and the product goes into the public domain. Since this is a purely federal matter, it is unaffected by any state law of unfair competition. U. S. Constitution, Articles I and VI.

III. Unfair Competition Aspect

From the anti-trust discussion and the patent discussion, it is seen that the principal question presented must be answered in the negative—the state law of unfair competition cannot dominate the federal laws on patent and anti-trust matters, since these are absolute. The instant case was thus a misapplication of the state law of unfair competition—confusing the state law having to do with indicia of source (the essential origin of unfair competition) with product copying, i.e., using the idea of longer ribs for strengthening, everything else being old.

Insofar as unfair competition in product duplication is concerned, the *Kellogg*[8] case is still the law, there being nothing to the contrary in the latest unfair competition case decided by this Court, *Champion Spark Plug Co.* v. *Sanders*, 331 U.S. 125 (1946). The *Champion Spark Plug* case involved use of the technical trademark

[8] 305 U.S. 111 (1938).

"Champion" on the spark plugs reconditioned by another. It was held that the only responsibility on the reconditioner was to bring home to the purchaser that the spark plug was used, as by appropriate stamping.

A prior case on unfair competition, *Hurn* v. *Oursler*, 289 U.S. 238 (1932) held at page 247:

> "It is entirely plain that the holding of the trial court disposing of the claim of infringement on the merits also disposed of the claim of unfair competition in respect of the copyrighted play, since both depended upon the same allegations of wrongful appropriation of certain parts of and conceptions embodied in, petitioners' play."

Thus, this Court has already recognised that the adverse holding on a Federally-created exemption to monopoly is decisive on the common law right based on the same allegations.

The instant case, like the *Kellogg*[4] case, involves the shape of a product, not a technical trademark. The function of a technical trademark and the difference between that and what we have here is summarized in Oppenheim, Cases on Unfair Competition (1948) at page 230:

> "In the case of a technical trademark, the uniqueness or arbitrariness of the mark or device itself constitutes an identifying symbol . . . Unlike the arbitrary name or device in technical mark cases, the features relied upon in the unfair competition suit are identifying symbols only when they have acquired secondary meaning and hence confusion of source must be proved without benefit of a presumption."

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[4] 305 U.S. 111 (1938).

The need for showing secondary meaning was recognised in the *Kellogg* case, defining this heavy duty on the claimant as:

> "It must show that the primary significance of the term in the minds of the consuming public is not the product, but the producer." *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 118 (1938).

What Day-Brite has done here is to use the patent monopoly to gain a degree of exclusivity and then attribute this exclusivity to the product design. Then, to make out a colorable case in unfair competition, Day-Brite argued that this design functions in the manner of a "trademark".

The opinion of a court 80 years ago in denying exclusivity to the use of the letter "G" as part of a sewing machine frame after the patent had expired, is particularly apt today, *Wilcox & Gibbs Sewing Machine Co.* v. *The Gibbens Frame*, 17 Fed. 623, 625 (S.D. N.Y., 1883):

> ". . . It is claimed that as the orator's machines are somewhat known by this frame, and other shapes easily distinguishable from this might equally be useful, . . . All the effect which these frames have in representing the machines to be those of orator, appears due to the monopoly enjoyed under the patent; to give the orator the benefit of the effect by calling this frame a trademark, would continue the monopoly indefinitely, when under the law it should cease."

The Illinois cases have not abdicated from the requirement of "secondary meaning". The latest case and the one most referred to as representing a change in approach is *Lady Esther, Ltd.* v. *Lady Esther Corset Shoppe, Inc.*, 317 Ill. App. 451 (1943). There, the trademark "Lady

Esther" was widely known and long used[6], and it was held unfair competition to trade upon this name even though the parties were not in the same business—that "palming off" (impossible because of the absence of direct competition) was not the only basis for relief, but that unfair competition could be found where there was just a likelihood of confusion.

Based upon that holding, the Illinois federal courts have taken the attitude that direct competition (palming off) is not a *sine qua non* for finding unfair competition. From that proper premise, the federal courts have fallen into the error of extending this doctrine to say that confusion is the only thing to be considered. It is one thing to say that direct competition is not essential to the granting of relief, and quite another to say that the consequences of eliminating direct competition are to be ignored.

Properly stated, the Illinois law (which is to be applied here—assuming some residual right not extinguished by the controlling federal law) does not ignore competition, but holds in trademark cases that likelihood of confusion is the test for violation of a protectable right in a trade identity case. This is the modern test for protectable rights in identifying indicia, and applies almost universally today under federal and state law.

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[6] Lady Esther was first used in 1913 and by 1936 the annual advertising budget was over $1,500,000. About its right to sue, based on "secondary meaning", the court said at page 453:

> "The trademark or trade name, Lady Esther, has become and now is a symbol and name for cosmetics, toilet goods and preparations of high quality and excellence, and the trademark or tradename Lady Esther, has become and now is identified with the plaintiff's products, and said designation, Lady Esther, has been, for many years, and now is, known in the City of Chicago, Illinois, and throughout the United States, as belonging to the plaintiff and its predecessors."

However, the Illinois cases do not support the position that product simulation is actionable merely because there is likelihood of confusion, either as to the goods themselves or as to the manufacturer. *Such a doctrine would convert the test for violation of a protectable right into a test for determining the existence of the right itself.*

The fact that likelihood of confusion is not enough is made clear by the comment of the Court of Appeals on the *Lady Esther* case, *Independent Nail and Packing Co. v. Stronghold Screw Products, Inc.*, 205 F. 2d 921, 926 (CA 7; 1953):

> "Of course that Lady Esther case did not turn on the use of similar names alone; it was a case of similar names plus a *secondary meaning* attached to one of them." (Emphasis supplied)

The Illinois law of unfair competition, in fact, poses no conflict with the Federal anti-trust and patent laws. The Illinois state courts, in preventing a corsetier from trading on the good will of a cosmetician,[6] have not said that competition is unimportant, but merely that the common law can deal with wrongdoers who are not direct competitors through the doctrine of "likelihood of confusion." There has been no change in the common law relative to first showing "secondary meaning", irrespective of whether the parties are in competition.

It is to be appreciated that there is no Illinois state court case in point, i.e., a design copying case.[7] Also, there can be no Illinois case strictly in point as to the

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[6] *Lady Esther, Ltd.* v. *Lady Esther Corset Shoppe, Inc.* 317 Ill. App. 451 (1943).

[7] "The Law of Unfair Competition in Illinois, A Study by the Special Sub-committee on Illinois Antitrust Laws of the Chicago Bar Association", University of Illinois Legal Series (1962).

copying of a design when coupled with a patent infringement action, since these are limited to the federal courts.

The Court of Appeals for the Seventh Circuit erred in this case in holding:

> "The capacity of the plaintiff's design to serve the plaintiff in somewhat the manner of a trademark does constitute a 'protectable' right." (R. 328)

This is contrary to the supremacy of federal law as set forth in the *Scott* case.* The court below erred in extending the state law to a point where it would conflict with Federal law. *Sperry* v. *State of Florida*, 371 U.S. 875 (1963).

The Court followed the correct rule in a similar case a year before—also involving one of Day-Brite's lighting fixtures, there the Court of Appeals found the design patent invalid and no secondary meaning attached to the patented device. *Day-Brite Lighting, Inc.* v. *Sandee Mfg. Co.*, 286 F. 2d 596 (CA 7, 1961), cert. den. 366 U.S. 963 (1961). In that case, there was no structural aspect of the design to preclude the finding of secondary meaning.*

The ribs made longer to prevent warping do not make one think of a trademark. Whatever is relied upon to serve as a trademark is essentially a summary of the good will of the manufacturer. Lord Eldon, in *Cruttwell* v. *Lye*, 3 Ves. 335 (1810), defined good will as "the probability that the old customers will resort to the old place." What is offered here is not a *fanciful* trademark reminding old customers to return to the old place, but rather a slightly better product which is sold because of its superior strength.

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*326 U.S. 249, 255 (1945).

*Secondary meaning can only reside in a non-functional feature. Derenberg "Trade-Mark Protection and Unfair Trading" p. 113 (1936).

The fact that the extended strengthening ribs cannot serve as a trademark (an exclusive symbol) is clearly supported by the lower court's finding (R. 301):

> "22. Within several years after plaintiff came on the market with its CFI-10 reflectors, a large number of competitors were offering fixtures with reflectors having the overall appearance of plaintiff's CFI-10 reflector design."

This negatives the existence of secondary meaning since the authorities are unanimous that *exclusivity* is a *sine qua non* for secondary meaning:

> "It (secondary meaning) contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market, because geographically or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in the trade and to that branch of the purchasing public, the word or phrase had come to mean that the article was his product, in other words, had come to be, to them, his trademark." Nims, "Unfair Competition and Trade Marks, page 154-155 (1947).[10]

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[10] Secondary meaning has been defined in Illinois as follows:

> "To acquire a secondary meaning in the minds of the buying public, an article of merchandise, when shown to a prospective customer, must prompt the affirmation, 'This is the article I want because I know its source.'" *Zangerle & Peterson Co.* v. *Venice Furn. Novelty Mfg. Co.*, 133 F. 2d 266, 270 (CA 7, 1943).

This is the same as that embodied in the general law of unfair competition. *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 118 (1938).

The *Lady Esther* case found secondary meaning, so there is no Illinois decision stating that secondary meaning with its necessary exclusivity is out and that as a test for the existence of unfair competition we merely look to whether the product design has the "capacity to identify" the maker.

Without a finding of secondary meaning, the holding of unfair competition is unsupported.

Even in the *Kellogg* case, there was no consideration of the product itself as performing the trademark function, this being long understood to be merged in the dedication of the product shape to the public by virtue of the expiration of the patent grant. All that was required on the part of the subsequent user was:

> ". . . not to insure that every purchaser will know it to be the maker, but use every reasonable means to prevent confusion." *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 121 (1938).

What the court did say in the *Kellogg* case about functionality is particularly pertinent (p. 122):

> "Moreover, the pillow shape must be used for another reason. The evidence is persuasive that this form is functional—that the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow shape.
>
> "The Kellogg Company is undoubtedly sharing in the good will of the article known as 'Shredded Wheat'; and thus is sharing in a market which was created by the skill and judgment of plaintiff's predecessor and has been widely extended by vast expenditures in advertising persistently made. But that is not unfair. Sharing in the good will of an article unprotected by patent or trademark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested. There is no evidence of passing off or deception on the part of the Kellogg Company; and it has taken every reasonable precaution to prevent confusion or the practice of deception in the sale of its product."

The type of sale here involves hundreds and perhaps thousands of dollars, and is made to skilled purchasers,

purchasing agents, contractors, etc. (R. 82, 206). This effectively eliminates any misunderstanding as to source on the part of purchasers. Such sales are made after demonstrations to the discriminating purchasers (R. 205-206) and the orders are on purchase orders, not the "impulse" type buying associated with unfair competition.

It will be immediately recognized that Day-Brite has attempted to preempt a purely utilitarian feature of the reflector, since the ribs are the longest possible and positioned at every possible place they could, *i.e.*, between each of the the longitudinally-extending slots. To contend that the number and placement of these strengthening ribs is nonfunctional and therefore serves as a trademark, when in fact it maximizes the strength of the reflector, is asking the judiciary to participate in the creation of an illegal monopoly.

Until the advent of this case, all the Circuits have held that the expiration of a design patent throws the construction into the public domain, the interest of the public and free competition being paramount, so that mere duplication alone is not unfair competition. Characteristic of the attitude of the other Circuits[11] is the latest statement

---

[11] In *Bliss* v. *Gotham Industries, Inc.*, ... F. 2d ....., 137 U.S.P.Q. 189 (CA 9, 1963), the holding invalid of the design patent on a pitcher (because the design was dictated primarily by the functional or mechanical requirements and ornamental or so-called pleasing aspect was merely a by-product) dictated that the accompanying claim of unfair competition also fail. This case is interesting because, in the absence of diversity, the Court held that the law of the forum was not applicable but turned to the general law of unfair competition as set out in the Seventh Circuit decision of *Day-Brite Lighting, Inc.* v. *Sandee Mfg. Co.*, 286 F. 2d 596 (1961), cert. den. 366 U.S. 963 (1961).

of the Second Circuit in *Hygienic Specialties Co. v. H. T. Saleman, Inc.*, 302 F. 2d 614, 619 (1962):

> "The initial response (intolerability of copying) to the problem has been curbed in deference to the greater public good, apparently on the principle that imitation is the lifeblood of competition." (Parenthetical remarks added)[12].

CONCLUSION

For the reasons stated, it is respectfully requested that that portion of the opinion below affirming the District Court's judgment of unfair competition be reversed.

Respectfully submitted,

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Attorney for Petitioner.

Of Counsel:
JEROME F. FALLON

[12] Here the Court said that federal and state law on unfair competition are "not essentially different", so it would follow the "indeterminate general law." Each of the federal, state, and general laws of unfair competition thus argues for reversal here.

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No. 106

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963.

COMPCO CORPORATION,
Petitioner,

vs.

DAY-BRITE LIGHTING, INC.,
Respondent.

BRIEF FOR RESPONDENT.

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The Scheffer Press, Inc.—ANdover 3-6850

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vs.

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Respondent.

BRIEF FOR RESPONDENT.

QUESTION PRESENTED.

Where Petitioner has deliberately copied the functional and non-functional features of a product which has acquired a secondary meaning, was it not proper for a Court of Equity to enjoin Petitioner even though Respondent was unsuccessful in a separate cause of action for design patent infringement?

STATEMENT.

Petitioner's Statement is inadequate with respect to the basic findings of the lower Court's findings of unfair competition, as is the Government's Statement. A clear understanding can be obtained by setting out several of the Findings of Fact of the District Court, which clearly satisfy the requirements for unfair competition under Federal or state law:

> "19. The overall appearance of defendant's Mitchell 'Dynalite' fixture reflectors is the same, to the eye of the ordinary observer, as the overall appearance of plaintiff's CFI-10 reflectors which embody the design of the patent in suit.
>
> "20. Purchasers of lighting fixture reflectors of the type here involved are likely to be confused between the Mitchell 'Dynalite' reflector and the CFI-10 reflector.
>
> "21. Actual confusion has occurred. One user of fixtures of the type here involved, having an installation of plaintiff's CFI-10 fixtures and an installation of the defendant's Mitchell 'Dynalite' fixtures, requested plaintiff to service some defective Mitchell 'Dynalite' fixtures because they thought all of their fixtures were plaintiff's fixtures.
>
> "24. The appearance of plaintiff's CFI-10 reflector design has the capacity to identify plaintiff in the trade and does in fact so identify plaintiff to the trade.
>
> "25. The concurrent sale of plaintiff's CFI-10 fixture reflectors and defendant's Mitchell 'Dynalite' fixture reflectors is likely to cause confusion in the trade." (R. 300-1)

The Court of Appeals, in rendering its decision affirming unfair competitive acts of Petitioner, stated:

"This brings us to the question of unfair competition. While the District Judge did not specifically find 'secondary meaning' identifying the reflectors with the plaintiff as a source, he did find that the appearance of the CFI-10 has the capacity to identify the plaintiff in the trade and does, in fact, so identify the plaintiff to the trade. He found that concurrent sale of CFI-10 and Mitchell-Dynalite fixture reflectors was likely to cause confusion in the trade, and that actual confusion had occurred. Therefore, although he dismissed the Complaint insofar as patent infringement was concerned, he did find the defendant guilty of unfair competition. He granted an injunction against unfair competition by sale or attempted sale of reflectors identical with or confusingly similar to the CFI-10 or the Mitchell 'Dynalite,' and ordered an accounting for damages resulting from such unfair competition.

"Defendant contends that confusion of purchasers is impossible because those who buy this type of comparatively expensive product (which is always shipped in clearly marked containers) are skilled, experienced and discriminating purchasers. However, the District Court did find [fol. 378] confusion likely, and there is substantial evidence in the record to support that finding. We cannot characterize the finding as 'clearly erroneous' and may not set it aside. Federal Rules of Civil Procedure, Rule 52." (R. 326-7)

Neither Petitioner, nor the Government, has controverted any of these significant findings relating to unfair competition.

That Petitioner's deliberate copying occurred is clearly shown by the statement of one of its former employees who stated,

"I told him that if we're going to copy, we might as well copy the best." (R. 58)

ARGUMENT.

Generally.

The litigation in this cause was a typical case of joinder of two separate and distinct causes of action. One cause of action was for unfair competition. The other was for design patent infringement. Each cause of action depended for decision entirely upon its own facts. The two courts below have unanimously resolved the questions of fact and the applicable law in favor of Respondent with respect to unfair competition.

The Government in its brief concurred with the District Court and the Court of Appeals, except as to the nature of the remedy given Respondent. We quote from the Government's brief (p. 14):

> "Under the foregoing standards, we conclude: (1) that the District Court's findings in the *Compco* case, upheld by the Court of Appeals, justified relief against the unfair competition found, but that the case should be remanded to provide less stringent relief than the broad injunction entered, such as requiring Compco clearly to label its products; * * *"

Significantly the Government completely concurred with the law applied by the District Court and the Court of Appeals for the Seventh Circuit under the mandate of this Court in *Erie* v. *Tompkins*, 304 U.S. 64 (1938).

> "C. STATE UNFAIR COMPETITION LAWS MAY PROHIBIT THE COPYING OF UNPATENTED GOODS ONLY IF THE PUBLIC IS LIKELY TO BE CONFUSED AS TO THEIR SOURCE, *i.e.*, IF THE GOODS OF ONE PRODUCER ARE LIKELY TO BE PURCHASED IN THE BELIEF THAT THEY ARE THE GOODS OF ANOTHER.

> "The Federal Patent Laws do not bar the states from applying their laws of unfair competition to grant relief against copying where necessary to prevent deception. Even in the case of an expired patent, the laws of unfair competition may be applied to require the new manufacturer 'to identify its own products lest it be mistaken for that of the (former patentee)'."

The Findings of Fact of the District Court which we have set forth above in our Statement and the lucid statement of the Court of Appeals amply demonstrates that the Court below have applied the proper law to the facts in this case to the same degree and in the same manner that the Government contends is appropriate law. Respondent therefore sees no need or necessity for this Court to balance patent law of the Federal Government versus state law of unfair competition. The facts of this case just do not require the strained application Petitioner contends for under the antitrust laws (pp. 19-22).

The Courts Below in Finding that Respondent's Product had the Capacity to Identify Respondent and Did, in Fact, Identify Respondent, Properly Enjoined Petitioner's Slavish Copying Thereof because of the Paramount Public Interest in Preventing Deception.

Petitioner asserts time and time again, and the Government assumes for the most part, that Respondent's product is comprised wholly of functional features. Even though a rib or aperture may be functional to some degree, nonetheless the arrangement, size and configuration can and does render the product identifiable. In other words, the particular arrangement, size and configuration of the ribs and apertures perform in a non-functional manner to identify the originator.

Petitioner's reliance upon functional aspects of a single rib or aperture considered in and of itself, is of no help at all on the question of non-functionality of the overall appearance of the design. After all, in reflectors of this type the reflectors might have 20 apertures and one or two ribs, or the reflectors might have 20 ribs and two or three apertures. In any such arrangement, the ribs and apertures might have a wide variance in form. Ribs in and of themselves and apertures in and of themselves can have many different styles as was shown by Respondent's expert and Exhibits 28, 29, 30 and 31 (R. 165-167).

Petitioner could have availed itself to meet the functional requirements of its reflector of a wholly different arrangement of the ribs and apertures. The Court of Appeals so stated when it said:

> "As noted, several choices of ribbing were apparently available to meet the functional needs of the product. The defendant did not avail itself of the other types but instead chose precisely the same design used by the plaintiff and followed it so closely as to make confusion likely." (R. 328)

Such conduct by Petitioner is conceded by the Government to be actionable under Illinois law which "concededly controlled" (p. 8). There is no suggestion by the Government or Petitioner that Illinois law is different from the laws of any other States of the Union or from that body of undefined Federal law with respect to unfair competition. As the Court of Appeals stated in its decision "The essence of 'unfair competition' is that it be unfair, that 'in all cases of unfair competition, it is principles of old-fashioned honesty which are controlling.'" (R. 329).

The Finding of Unfair Competition Against Petitioner in no way Invades, Impinges upon or is in Conflict with Federal Law Relating to Patents.

The Government concedes in its brief that Respondent is entitled to relief for the unfair competitive acts of Petitioner. It therefore must conclude that with respect to Respondent and the relief granted to it, that the state law applied by the Courts below under *Erie* v. *Tompkins* was not in conflict with nor did it invade nor impinge upon the paramount Federal law relating to patents. Consequently the basic theme of the Government's brief (p. 14-33) is not applicable to Respondent but to *Sears, Roebuck & Co.* v. *The Stiffel Company*, No. 108, also pending before this Court.

The thrust of Petitioner's brief is that once Respondent's design patent was held invalid under the Federal patent laws that thereafter Respondent was precluded from any other relief because any other relief would be to give Respondent a monopoly for the same product denied under the patent laws. According to Petitioner, this would, in some undefined way, violate the antitrust laws.

If Petitioner's contentions are correct, it would completely emasculate our body of law relative to the joinders of causes of action. The joinder of both of Respondent's causes of action (namely design patent infringement, and the other for unfair competition) were and are sanctioned in a long line of cases of this Court including *Hurn* v. *Oursler*, 289 U.S. 238 (1933); *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111 (1938) and *Mazer* v. *Stein*, 347 U.S. 201 (1954).

In *Vacheron & Constantin-Le Coultre Watches, Inc.* v. *Benrus Watch Company, Inc.*, 155 F.Supp. 932, 936 (1957),

in dealing with plaintiff's attempt to cover the same article both by a design patent and a copyright, the Court stated the logical action of a manufacturer in endeavoring to protect himself as broadly as possible as follows:

> "I see nothing reprehensible about concurrent reliance upon both claims. The law as to the relationship between copyright and design patent claims is in an unsettled state, *Mazer* v. *Stein*, 347 U. S. 201, 74 S.Ct. 460, 98 L.Ed. 630, and patent counsel are to be commended in seeking for their clients protection under both heads upon the theory that protection under one or the other may be upheld by the courts."

Furthermore, Federal statute 28 U.S.C. 1338 (b) provides that unfair competition may be joined with a substantial and related claim under the patent laws:

> "(b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and unrelating claim under the copyright, patent or trademark laws. June 25, 1948, c. 646, 62 Stat. 931."

The Federal Rules of Civil Procedure suggest a form for joining a Federal statutory monopoly (copyright) with a cause of action for unfair competition (form 17).

Furthermore, this Court in upholding a Federal statutory copyright claim for 28 years (renewable for a similar period) stated in *Mazer* v. *Stein*, 347 U.S. 201 (1954):

> "We do hold that the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art, neither the copyright statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold." (p. 17)

Certainly a non-statutory common law right for unfair competition should not be cast in a more unfavorable position.

Respondent's cause of action with respect to design patent infringement arose under the Federal law when its design patent issued. Respondent's common law cause of action for unfair competition began when it introduced its product to the public so that its appearance became sufficiently identifiable (as the District Court and the Court of Appeals specifically found) as to identify Respondent in the trade to support a separate and distinct cause of action against subsequent competitors who caused confusion in the trade by copying. In the present case, the District Court found that "actual confusion" was created by Petitioner (Finding 21, R. 301).

Respondent's Reflector Acquired a Secondary Meaning to the Public and so Identified Respondent.

Petitioner asserts that there was no finding by the trial court of "secondary meaning" with respect to Respondent's reflector. Further, Petitioner argues (Brief, pp. 28-33) that without a finding of secondary meaning Respondent is not entitled to relief under the laws of the State of Illinois although Petitioner states that he can find no case in point (p. 30).

The Court of Appeals for the Seventh Circuit has consistently held that the law of the State of Illinois for findings of unfair competition is that there need only be "likelihood of confusion". The Government states that "unfair competition laws may prohibit the copying of unpatented goods only if the public is likely to be confused as to their source." (p. 29).

The District Court held "Purchasers of lighting fixture reflectors of the type here involved are likely to be

confused between the Mitchell "Dynalite" reflector and the CFI-10 reflector." (R. 301). The District Court also made the finding: "The concurrent sale of plaintiff's CFI-10 fixture reflectors and defendant's Mitchell 'Dynalite' fixture reflectors is likely to cause confusion in the trade." (R. 301). The Court of Appeals affirmed these findings. (R. 327).

Furthermore, the District Court found that there was actual confusion. (Finding 21, R. 301). The Court of Appeals affirmed this finding. (R. 327).

Whether one applies the doctrine of likelihood of confusion or actual confusion is of no moment in the present case. Both of these elements were present and there were specific findings in this regard.

Petitioner's statement that the Courts below did not find that Respondent's reflector had acquired a "secondary meaning" is equally groundless. The District Court made the specific finding "The appearance of plaintiff's CFI-10 reflector design has the capacity to identify plaintiff in the trade and does in fact so identify plaintiff to the trade." (R. 301). It is apparent that this finding of the trial court, without engaging in an exercise of semantics, is in fact a finding of secondary meaning. The Court of Appeals stated it this way:

> "While the District Judge did not specifically find 'secondary meaning' identifying the reflectors with the plaintiff as a source, he did find that the appearance of the CFI-10 has the capacity to identify the plaintiff in the trade and does, in fact, so identify the plaintiff to the trade. He found that concurrent sale of CFI-10 and Mitchell-Dynalite fixture reflectors was likely to cause confusion in the trade, and that actual confusion had occurred." (R. 326-327).

This finding is completely supported by the evidence. The American Brass Company personnel identified the appearance with Respondent (R. 66); the witness Humphreville testified that the appearance identified Respondent (R. 79); Mr. Blazey testified that the very purpose of the design was to create identity in the trade (R. 163, 169); the witness Ferneau testified that the appearance of Petitioner's reflector was such that it could be sold as Respondent's reflector (R. 62). Respondent's president, Mr. Whitehead, and the head of its new Product Division, Mr. Stahlhut, both testified that the design was created so as to provide this identity in the trade (R. 47, 102, 120); plaintiff sold millions of dollars worth of these reflectors (Respondent's Exhibit 23) which was a tremendous exposure of Respondent in its design to the trade.

Petitioner presented no testimony refuting this identity of the design appearance and Respondent in the trade. There is no doubt but that plaintiff's fixture acquired a "secondary meaning", and as such was protectable.

The Decisions by this Court Do Not Hold that a Manufacturer of His Product Cannot Protect It Except Under the Patent Laws.

It would appear that it is Petitioner's contention that a manufacturer, once having obtained a patent, is forever foreclosed from protecting its product if the patent expires or is judicially invalidated. In other words, once the cloak of immunity given by the patent laws is gone, that product can be slavishly copied whether fairly or unfairly, the non-functional as well as the functional features and whether or not they apply name tags to the product.

At the outset the Court must be reminded that this is not the position of the Government.

Petitioner relies on the decision of this Court in *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111 (1938) (p. 24). This decision has been much relied upon by defendants sued for design patent infringement. While the pillow shaped form of the 'shredded wheat' biscuit was covered by a design patent the patent was declared invalid and the dispute between the parties therefore resolved itself into a matter of avoiding confusion in the market place. The court found that defendant Kellogg was free to use the pillow shaped form subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff. The Court stated at page 120:

> "The question remains whether Kellogg Company in exercising its right to use the name 'shredded wheat' and the pillow shaped biscuit, is doing so fairly. Fairness requires that it be done in a manner which reasonably distinguishes its product from that of the plaintiff."

As stated by Callman in his treatise "Unfair Competition and Trademarks", Second Edition, Volume 3, 1950, Callaghan & Company, "However, this right to copy must not be exercised so as to deceive the public concerning the origin of the goods." (p. 1255).

It is submitted that the public interest is not furthered one bit by conduct that is "likely" to confuse" or deceive the public as to source of goods. The Government suggests less stringent relief to Respondent such as requiring Compco clearly to label its products.

Respondent asserts that it is entitled to its injunctive relief because Petitioner has already created public confusion and mere labeling at this late date would not dissipate the acts and effects of the unfair competition which

Petitioner itself created. No oppressive act was required by the District Court except for Petitioner to change the design of its reflector so that the public would not be confused. A wrongdoer is under a greater duty to distinguish than the public at large. *Independent Nail & Packing Co.* v. *Stronghold Screw Products, Inc.*, 215 F.2d 434 (CA 7, 1954); *Eskay Drugs* v. *Smith Kline and French Laboratories*, 188 F.2d 430 (CA 5, 1951); *Broderick & Bascom Rope Co.* v. *Manoff*, 41 F.2d 353 (CA 6, 1930); *Coca Cola Co.* v. *Gay-Ola*, 200 Fed. 720 (CCA 6, 1912).

Petitioner has not been enjoined from infringing but merely from competing unfairly with Respondent.

CONCLUSION.

Petitioner is erroneously attempting to reverse the sound holding of the two Courts below and perpetuate its tortious activity and unfair competition by obtaining a ruling that "principles of old-fashioned honesty are no longer controlling". This Court should not be "reluctant to conclude that what is morally reprehensible is legally impermissible". This Court should affirm the holdings of the two Courts below.

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COMPCO CORPORATION,

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vs.

DAY-BRITE LIGHTING, INC.,

Respondent.

REPLY BRIEF FOR PETITIONER.

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REPLY BRIEF FOR PETITIONER.

This reply brief is prompted by the *amicus curiae* brief filed by the Solicitor General of the United States.

Passing Off.

The *amicus curiae* brief suggests that this case should be remanded to determine whether Compco's product is properly labelled. The Solicitor General quite rightly appreciates that the only requirement in making the product formerly patented by another is to label properly so as to preclude "passing off". In this case, remand is unnecessary, as can be appreciated from the prominent labelling employed by Compco. The carton is clearly identified by the Mitchell "logo" (Def. Ex. EE, R. 210, 238). The same characteristic printing is used on the fixture itself (R. 209-210; Def. Ex. OO, R. 207, 238).

Carton

Fixture Labels.

The clear marking was recognized by the respondent Stiffel in the companion case (No. 108). At page 8 of the Stiffel brief in opposition to the petition for a writ of *certiorari*, we read in Footnote 6:

> "In the *Day-Brite* case, unlike the instant case, defendant 'clearly marked' its products as its own."

Further, the Court of Appeals for the Seventh Circuit specifically noted that petitioner's product was "always shipped in clearly marked containers", having before it defendant's carton, Exhibit EE. *Day-Brite Lighting, Inc. v. Compco Corporation*, 311 F. 2d 26, 29 (1962).

Secondary Meaning.

The *amicus curiae* brief succinctly sets forth the evidence in Case No. 106 in Footnote 15 at pages 34 and 35, stating that:

"(no) prospective purchaser had in fact been deceived",

and that:

"no identifying 'secondary meaning' is legally cognizable in such an article".

The matter of secondary meaning was squarely presented to the District Court in a motion for an order clarifying Finding of Fact 24. On March 7, 1962, the late Judge Miner denied Day-Brite's motion which would have Finding of Fact 24 read:

"The appearance of plaintiff's CFI-10 reflector is so unique and distinctive and has become so closely associated with plaintiff by purchasers that it has acquired a secondary meaning identifying plaintiff to the trade."[1]

Purchaser Confusion.

The statement in the *amicus curiae* brief quoted above on the lack of deception of any prospective purchaser of the fluorescent light fixtures highlights the test to be employed in unfair competition cases—that of purchaser confusion. In this case, there was no testimony from or about purchasers. What Day-Brite did base its case on was the mistake of a workman viewing fixtures installed in a twenty-two foot high ceiling (R. 71). Contending that the test should be confusion of any casual viewer goes far beyond the requirement in the *Kellogg* case:

---

[1] Finding of Fact 24 currently in the case and which was sought to be clarified, reads:

"The appearance of plaintiff's CFI-10 reflector design has the capacity to identify plaintiff to the trade and does in fact so identify plaintiff to the trade."

The Solicitor General states that this Finding is legally objectionable (page 34, f.n. 15).

". . . not to insure that every purchaser will know it to be the maker, but use every reasonable means to prevent confusion." *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 121 (1938).

The *Kellogg* doctrine is followed in contemporary decisions on unfair competition, a representative holding being of the Ninth Circuit in 1963. *Intricate Metal Products, Inc.* v. *Schneider*, ... F. 2d ....., 139 U.S.P.Q. 231, 235:

> "The only evidence of confusion to which we are referred is testimony of furniture manufacturers to the effect that upon being invited to examine the accused sofa mechanism, they could not tell it from Signal's, and thought that it was Signal's. There is no testimony that anyone ever *bought* the accused mechanism mistaking it for Signal's. An inference of such a result would follow from similarity of appearance, while perhaps appropriately applied in the case of a housewife in a supermarket, is completely inappropriate in a case of such knowledgeable customers as furniture manufacturers. The workmen might well be confused, but hardly the purchaser." (Emphasis supplied)

Respectfully submitted,

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RESPONDENT'S PETITION FOR REHEARING

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RESPONDENT'S PETITION FOR REHEARING

Respondent, Day-Brite Lighting, Inc., respectfully petitions the Court for a rehearing and reconsideration of the Court's Decision and Opinion of March 9, 1964 for the reasons which follow.

THE COURT'S DECISION, PAGE 3, CONTAINS A CLEAR MISSTATEMENT OF FACT WHICH PETITIONER URGED UPON THE COURT BY IMPROPERLY BRINGING TO THE ORAL ARGUMENT ON JANUARY 16, 1964 AN EIGHT FOOT FIXTURE AND CONTAINER OF AN ACCUSED DEVICE.

The Compco fixture and container displayed to this Court during argument, which carried identifying marks, were not exhibits in the case. At no time was an accused

eight foot fixture or container introduced into evidence or made part of the record. The smaller four foot reflector introduced as Plaintiff's Exhibit five (5) had no label or other identifying marking thereon. The photographs in defendant's own catalogs (Pl. Exhs. 35, 36 and Def. Exhs. U-1, U-2) of the accused fixture show no label or other identifiable markings on their lighting fixtures. The Court, therefore, is not correct in stating that there was ". . . care taken by Compco to prevent customer confusion, including clearly labeling both the fixtures and the containers . . ."

The record admittedly shows certain testimony and a fixture which did bear a label identifying the accused fixture. Day-Brite has never asserted that there were no labels or identification on *any* of the accused fixtures, but Day-Brite has asserted that some of the accused fixtures bore no identification marks.

The Court's statement (p. 3) that "The Compco fixtures —hung at least fifteen feet above the floor and arranged end to end in a continuous line so that the identifying marks were hidden—" simply does not square with the facts. *If there were any identifying marks at all* on Compco fixtures, they would have been on the side of the fixtures (R. 209). However, the plant manager of the company purchasing the accused Compco fixtures took care to view the fixtures by getting on a lift truck to look at them (R. 69) and even after this close visual inspection still requested plaintiff, Day-Brite, to replace defective parts of the accused fixtures with Day-Brite fixtures. Obviously, these fixtures were either not marked or else were not sufficiently labeled by the copier "to prevent confusion of customers as to source of goods", which this Court states may be in violation of "valid state statutory or decisional law" (p. 5).

The fact that the containers in which the fixtures are shipped bear defendant's name or trade name does not constitute proper labeling or marking of the fixtures, since fixtures are not initially sold in the containers. The fixtures are sold by looking at them in displays or as installed and not while in containers. After an order for the fixtures has been placed, they are shipped directly from the factory to the customer in containers which are then discarded. Therefore, labeling the container of itself does not affect the decision to purchase the fixture and does not prevent confusion thereafter.

It is submitted that the courts below did take into account the lack of or the inadequate labeling or marking in rendering their decisions finding defendant guilty of unfair competition. However, if there be any doubt regarding whether defendant properly or improperly labeled or marked or in fact did not label or mark its fixtures, then this case should be remanded to the District Court to make appropriate findings in accordance with this Court's opinion.

THE COURT'S DECISION IN THIS CASE GOES EVEN FURTHER THAN THE COPIER COMPCO OR THE GOVERNMENT HAD URGED IN ITS BRIEF AS AMICUS CURIAE.

The government's Brief urged that Compco be required to identify its products to prevent deception. Both the government and Day-Brite brought out that at least some of the accused fixtures contained no identification whatever. The government Brief stated as a conclusion on page 14:

> "That the district court findings in the Compco case, upheld by the court of appeals, justified relief against the unfair competition found, but that the case should

be remanded to provide less stringent relief than the broad injunction, *such as requiring Compco to clearly label its products.*" (emphasis added)

The government conceded that there was (1) a valid and proper law of unfair competition in the State of Illinois, and (2) that state unfair competition laws may prohibit copying if the public is likely to be confused as to the source.

From the oral argument in this case on January 16, 1964 and the Court's Decision, it is apparent that a state may have "valid statutory or decisional law requiring the copier to label or take other precautions to prevent confusion of customers as to the source of the goods." (p. 5) This is precisely Day-Brite's position. Day-Brite seeks to have Compco identify its fixtures or to take precautions to prevent confusion of customers as to the source of said goods. Both lower courts found a secondary meaning or a protectable right on behalf of Day-Brite and that confusion had taken place. These decisions were based on decisional law of the State of Illinois recited in the Court of Appeals decision.

Compco implied to this Court that all of its fixtures and containers were marked, but in fact they were not. Page 2 of Petitioner's Reply Brief shows certain pictures which may have misled this Court just as Compco has misled the public as to the source of its fixtures.

Accordingly, Day-Brite requests, at least, that which the government itself had urged; namely, that the injunction at least require Compco to label its fixtures so that they will clearly and unmistakably indicate that they are made by Compco and not Day-Brite. This is also in accordance with the decision of this Court in the *Singer* case, 163 US 169 (1896).

THE COURT'S DECISION HAS NO PRECEDENT IN ITS OWN PRONOUNCEMENTS AND IS AT VARIANCE WITH ITS OWN PRIOR DECISIONS.

There is no fundamental right, constitutional or otherwise, of a manufacturer to copy a device to the last detail and sell such goods without clearly and unmistakably identifying the manufacturer. Nor can this Court point to any "patent laws" requiring or even inferring the application of this new and unprecedented decisional law. This Court cannot and does not support its statement "Here Day-Brite's fixture has been held not to be entitled to a design or mechanical patent. Under the patent laws it is, therefore, in the public domain and can be copied in every detail by whoever pleases." (p. 4) The Court's decision ignores completely the federal law of trademarks where goods have been held to be protectable under the Trademark Act of 1946 (*Lanham Act*, 15 USC 1051), even though the identical product is also covered by a design patent. The holding of the latest case on this point in the highest administrative tribunal is found in *In re Mogen David Wine Corporation*, 140 USPQ 575 (CCPA, March 12, 1964), where the Court stated that a wine bottle was protectable under the trademark laws (Principal Register) regardless of whether or not a design patent also covered the identical wine bottle.

The Court of Appeals below stated that the right of Day-Brite under the law of unfair competition in Illinois was akin to that of a "trademark" which is a "protectable right" (R. 328). Even this Court repeated the finding of the trial court "that the configuration of Day-Brite's fixture identified Day-Brite to the trade because the arrangement of the ribbing had, *like a trademark*, acquired a 'secondary meaning' by which that particular design was asso-

ciated with Day-Brite" (p. 4, emphasis added). Despite this statement, the Court nonetheless failed to apply the federal statutory and decisional law of trademarks when substantive trademark rights accrue through adoption and use and not by registration. *Armstrong* v. *Nu Enamel*, 305 US 315 (1938).

There has been no decision nor pronouncement by this Court that the application of federal statutory or decisional trademark law is in conflict with federal statutory patent or copyright law. As a matter of fact, it would appear from the *rationale* of *Mazer* v. *Stein*, 347 US 201 (1954), that there would be no conflict inasmuch as that Court held that there was no conflict between the overlapping of protection under the copyright and design patent laws.

This Court, in its decision, has not touched upon this important consideration. Since the courts below have seen fit to treat the protection of Day-Brite's design like a trademark and have applied under the doctrine of unfair competition this "protectable" right to Day-Brite, this Court should grant this Petition for Rehearing to settle what is an apparent oversight by the Court in its decision.

This Court would be in conformity with its earlier prior decision in affording this protectable right where it stated in *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 120 (1938), that the defendant Kellogg was

> "free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff".

It would seem only fair and equitable that the closer the copy the greater the duty to mark the goods clearly and unmistakably. Unmarked goods are capable of being

passed or palmed off[1] without any verbal statement, since the public upon seeking the identical goods simply assumes that they are the original and not the copy. Confusion is especially prevalent in cases, such as the present case, wherein the original design of the goods has acquired a "secondary meaning" to the public.

THE COURT'S DECISION EMASCULATES THE DOCTRINE OF UNFAIR COMPETITION RELATIVE TO PATENTS, TRADEMARKS, AND COPYRIGHTS.

Compco admits that "The Kellogg case is still the law", Brief for Petitioner, p. 26. In the *Kellogg* case, 305 U.S. 111 (1938), the original defendant Kellogg was held "free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff" (p. 120). Requiring Compco to clearly and unmistakably identify its goods would simply follow the decisions of this Court. *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U.S. 169 (1896); and *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111 (1938).

In effect, the Court's decision wipes out the law of unfair competition relative to patents, trademarks and copyrights. This Court, until now, and numerous lower courts have all recognized the existence of unfair competition even though honest men may differ as to what constitutes unfair competition in a particular case. No case has to our knowledge gone so far as to hold that because the goods were patented or might be patented that exclusive federal jurisdiction attaches so as to preclude completely the application of any state law of unfair competition. Even the Federal Rules of Civil Procedure recognize that in statutory federal matters there can be unfair competition. Complaint Form No. 17 of the

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[1] "palming off" is not required under the laws of the State of Illinois, as the Court of Appeals below clearly pointed out (R. 327, 328).

Federal Rules is entitled "Complaint for Infringement of Copyright and Unfair Competition". Under the present decision, a copyright holder must prevail on his copyright or else he has no complaint whatever. The mere obtaining of a copyright should not of itself wipe out the copyright owner's common law rights against unfair competition. The same rationale applies to patents and trademarks.

We find it hard to believe that this Court meant to abolish the laws of unfair competition painstakingly built up over several centuries under common law. Unless this Court's decision is clarified it will be used as the stepping stone for unethical and sharp business practices or what has been referred to in publications since this decision as abetting "knock-off" artists.

THE COURT'S DECISION INDICATES THAT NO INVENTOR IS INVOLVED HEREIN, SO THE GRANT FROM THE STATES TO THE FEDERAL GOVERNMENT OF THE RIGHT TO ISSUE PATENTS SHOULD NOT BE CONSTRUED AS A DEDICATION OF A STATE'S RIGHT TO PREVENT UNFAIR COMPETITION.

There are numerous property rights under the common law which courts protect even in the absence of a copyright patent. For example, courts have protected trade secrets and have prevented the passing-off of goods. In the present case, there was more than the manufacture of a fixture which fell within the scope of a design patent. Admittedly, if only a design patent were involved, which was declared invalid, then Day-Brite would have no complaint at this time against Compco. However, Count II relating to unfair competition was completely independent of Count I and stood on its own feet, namely, a showing of a product with built-in identification which had acquired a similar meaning and actual confusion in the trade.

Had there been no design patent, Count II would have stated a claim upon which relief could have been granted in a state court under the doctrine of unfair competition. However, because there was a design patent involved which was presumed to be valid and which others had respected, suit was filed against this defendant, Compco, on both design patent infringement and unfair competition. The unfair competition arose because the particular design was original (although subsequently held not to involve patentable invention), had acquired a secondary meaning, and upon which actual confusion had resulted (even though likelihood of confusion is all that is required under Illinois law).

It should be obvious why Compco wants to make a copy and have the "right" not[1] to apply labels to its fixtures. Manufacturers of cheap brake linings, safety equipment, gas and electrical equipment, and thousands of other manufacturers of inferior or potentially dangerous goods are happy to learn that they can now make their goods appear to be identical "in every detail" with quality goods and be able to sell such inferior and dangerous goods side by side with the quality goods without having to identify their goods in any way.

Until the present Decision, the law of unfair competition would prevent this, or at least, makers of inferior goods were deterred in their action because of the possibility that they might be held accountable for their wrong doing. The present Decision relieves their minds and opens the flood gates for inferior goods which are unmarked and impossible to detect from quality goods, except by experts or after the inferior goods have broken down.

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[1] This is the clear inference of this Court's decision since Illinois does not have any law requiring applicable labeling.

CONCLUSION

It is submitted that the breadth of the Court's Decision should be reconsidered and the Court's Decision should be modified to make it clear and unmistakable that the common law doctrine of unfair competition has not been emasculated and that copiers at least are required to clearly and unmistakably label their products. The Court's Decision should be modified accordingly and cause remanded to require Compco, as the government contends, to clearly and unmistakably label its fixtures.

Respectfully submitted,

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CERTIFICATE

Owen J. Ooms certifies that the foregoing Petition is presented in good faith and not for the purposes of delay, and that he believes it to be well founded in fact.

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Owen J. Ooms